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No. (1) 09-326

SUPREME COURT, U.S.
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In The
Supreme Court of the United States

SUZAN S. HARJO, *ET AL.*,
Petitioners,

v.

PRO-FOOTBALL, INC.,
Respondent.

ON PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT

PETITION FOR WRIT OF CERTIORARI

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QUESTION PRESENTED

The United States District Court for the District of Columbia reversed the Trademark Trial and Appeal Board's order scheduling cancellation of the disputed marks and granted summary judgment to Pro-Football, Inc., finding that the doctrine of laches precluded consideration of Petitioners' cancellation petition brought pursuant to Section 14(3) of the Lanham Act, 15 U.S.C. § 1064(3). On appeal, a panel of the District of Columbia Circuit agreed and, after a remand, ultimately affirmed the District Court's decision in full. The District of Columbia Circuit's decision and the Federal Circuit's decision in *Bridgestone/Firestone Research, Inc. v. Auto. Club De L'Ouest De La France*, 245 F.3d 1359, 1360-61 (Fed. Cir. 2001), are in conflict with the holding of the Court of Appeals for the Third Circuit in *Marshak v. Treadwell*, 240 F.3d 184 (3d Cir. 2001) (Alito, J.), that petitions made pursuant to Section 14(3) may be filed "at any time," rendering defenses such as laches and statutes of limitation inapplicable.

A single question is presented for review:

1. Whether the doctrine of laches is applicable to a cancellation petition filed pursuant to Section 1064(3) of the Lanham Act despite the plain meaning of the statutory language stating that such a petition may be filed "at any time."

PARTIES TO THE PROCEEDING

Parties currently before this Court and previously before the United States Court of Appeals for the District of Columbia Circuit are Petitioners Suzan Shown Harjo, Raymond D. Apodaca, Norbert S. Hill, Jr., Mateo Romero, William A. Means, and Manley A. Begay, Jr.,[1] and Respondent Pro-Football, Inc. The InterFaith Conference of Metropolitan Washington, National Congress of American Indians, National Indian Education Association, National Indian Youth Council, and Tulsa Indian Coalition Against Racism appeared as *amicus curie* before the District of Columbia Circuit. This petition is timely filed on September 14, 2009.

CORPORATE DISCLOSURE STATEMENT

Pursuant to Supreme Court Rule 29.6, undersigned counsel states that Petitioners Suzan Shown Harjo, Raymond D. Apodaca, Norbert S. Hill, Jr., Mateo Romero, William A. Means, and Manley A. Begay, Jr. (the "Native Americans") are individuals and are not a corporation engaged in business. The Native Americans have no parent corporation and none of them owns 10% or more of the stock of a publicly-held corporation.

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[1] Vine Deloria, Jr., an original Petitioner and a party before the Court of Appeals, is now deceased. Accordingly, the undersigned do not seek a writ of certiorari on his behalf.

TABLE OF CONTENTS

Page

QUESTION PRESENTED i

PARTIES TO THE PROCEEDING ii

CORPORATE DISCLOSURE STATEMENT ii

TABLE OF CONTENTS iii

TABLE OF AUTHORITIES vi

OPINIONS BELOW 1

STATEMENT OF JURISDICTION 1

STATUTORY AND REGULATORY PROVISIONS 2

STATEMENT OF THE CASE 2

REASONS FOR ALLOWANCE OF THE WRIT 8

I. The Doctrine Of Laches Is Inapplicable To Registrations Challenged Pursuant To Section 14(3) Of The Act 10

II. The D.C. Circuit's Interpretation Of The Act Contravenes Important Public Interest Concerns Protected By Congress 16

CONCLUSION 20

APPENDIX:

ORDERS ON APPEAL

Pro-Football, Inc. v. Harjo,
565 F.3d 880
(D.C. Cir. 2009) ..... App. 1

Pro-Football, Inc. v. Harjo,
415 F.3d 44
(D.C. Cir. 2005) ..... App. 15

OTHER RELEVANT ORDERS

Pro-Football, Inc. v. Harjo,
567 F. Supp. 2d 46
(D.D.C. 2008) ..... App. 27

Pro-Football, Inc. v. Harjo,
284 F. Supp. 2d 96
(D.D.C. 2003) ..... App. 65

Harjo v. Pro-Football, Inc.,
50 U.S.P.Q.2d 1705
(T.T.A.B. 1999) ..... App. 181

ORDERS ON REHEARING

Order of
The United States Court of Appeals for
The District of Columbia
Re: Denying Petition for Rehearing
entered September 5, 2005 ..... App. 337

Order of
The United States Court of Appeals for
The District of Columbia
Re: Denying Petition for
Rehearing En Banc
entered September 5, 2005 ..... App. 338

STATUTES

15 U.S.C. § 1052 ..... App. 340

15 U.S.C. § 1064 ..... App. 344

15 U.S.C. § 1069 ..... App. 348

OTHER PERTINENT MATERIAL

Bridgestone/Firestone Research, Inc. v. Auto. Club De L'Ouest De La France,
245 F.3d 1359 (Fed. Cir. 2001) ..... App. 349

Marshak v. Treadwell, 240 F.3d 184
(3d Cir. 2001) ..... App. 360

TABLE OF AUTHORITIES

Page(s)

FEDERAL CASES

Bausch & Lomb, Inc. v. Leupold & Stevens Inc.,
1 U.S.P.Q.2d 1497 (T.T.A.B. 1986) 12

Bridgestone/Firestone Research, Inc. v.
Auto. Club De L'Ouest De La France,
245 F.3d 1359 (Fed. Cir. 2001) ..... i, 2, 9, 16

Cluett, Peabody & Co. v. Hartogensis,
17 C.C.P.A. 1166, 41 F.2d 94 (1930) 12-13

Conopco, Inc. v. Campbell Soup Co.,
95 F.3d 187 (2d Cir. 1996) 19

Day v. McDonough,
547 U.S. 198, 126 S. Ct. 1675,
164 L. Ed. 2d 376 (2006) 13

Dodd v. United States,
545 U.S. 353, 125 S. Ct. 2478,
162 L. Ed. 2d 343 (2005) 17

Dwinell-Wright Co. v. Nat'l Fruit Prod. Co.,
129 F.2d 848 (1st Cir. 1942) 12

Emmpressa Cubana Del Tabaco v. Culbro Corp.,
No. 97 Civ. 8339,
2002 U.S. Dist. LEXIS 21731
(S.D.N.Y. Oct. 8, 2002),
rev'd on other grounds,
399 F.3d 462 (2005) 11

Gasser Chair Co., Inc. v.
Infanti Chari Manuf. Corp.,
60 F.3d 770 (Fed. Cir. 1995) 19

Harjo v. Pro-Football, Inc.,
30 U.S.P.Q.2d 1828 (T.T.A.B. 1994) 4, 12, 18

Harjo v. Pro-Football, Inc.,
50 U.S.P.Q.2d 1705 (T.T.A.B. 1999) 5

Hartford Underwriters Ins. Co. v.
Union Planters Bank, N. A.,
530 U.S. 1, 120 S. Ct. 1942,
147 L. Ed. 2d 1 (2000) 17

Heflin v. United States,
358 U.S. 415, 79 S. Ct. 451,
3 L. Ed. 2d 407 (1959) 13

In re Hines,
31 U.S.P.Q.2d 1685 (T.T.A.B. 1994),
rev'd on other grounds,
32 U.S.P.Q.2d 1376 (T.T.A.B. 1994) 3

In re In Over Our Heads Inc.,
16 U.S.P.Q.2d 1653 (T.T.A.B. 1990) 3

The Int'l Assoc. of Fire Chiefs, Inc. v.
The H. Marvin Ginn Corp.,
225 U.S.P.Q. 940 (T.T.A.B. 1985),
rev'd on other grounds,
782 F.2d 987 (Fed. Cir. 1986) 11

Jarrow Formula, Inc. v. Nutrition Now, Inc.,
304 F.3d 829 (9th Cir. 2002) 19

Marshak v. Treadwell,
240 F.3d 184 (3d Cir. 2001) ..... *passim*

Maryland-National Capital Park and Planting Comm'n v. U.S. Postal Serv.,
487 F.2d 1029 (D.C. Cir. 1973) 19

McLean v. Fleming,
96 U.S. (6 Otto.) 245,
24 L. Ed. 828 (1877) 13

Menendez v. Holt,
128 U.S. 514, 9 S. Ct. 143,
32 L. Ed. 526 (1888) 13

Nat'l Serv. Indus., Inc. v. Turtle Wax, Inc.,
154 U.S.P.Q. 68 (T.T.A.B. 1967) 11

The Ohio State Univ. v. Ohio Univ.,
51 U.S.P.Q.2d 1289 (T.T.A.B. 1999) 10

Park 'N Fly, Inc. v. Dollar Park and Fly, Inc.,
469 U.S. 189 (1985) 9

Pro-Football, Inc. v. Harjo,
284 F. Supp. 2d 96 (D.D.C. 2003) 6

Pro-Football, Inc. v. Harjo,
415 F.3d 44 (D.C. Cir. 2005) ..... *passim*

Pro-Football, Inc. v. Harjo,
567 F. Supp. 2d 46 (D.D.C. 2008) 7

Robinson v. Shell Oil Co.,
519 U.S. 337, 117 S. Ct. 843 (1997) 11

Saxlehner v. Eisner & Mendelson Co.,
179 U.S. 19, 21 S. Ct. 7,
45 L. Ed. 60 (1900) 13

Schenley Indus., Inc. v. Sterling Brewers, Inc.,
157 U.S.P.Q. 593 (T.T.A.B. 1968),
rev'd on other grounds,
441 F.2d 675 (C.C.P.A. 1971) 11

SunAmerica Corp. v.
Sun Life Assurance Co. of Canada,
77 F.3d 1325 (11th Cir. 1996) 19

Tbc Corp. v. Grand Prix Ltd.,
12 U.S.P.Q.2d 1311 (T.T.A.B. 1989) 12

White House Milk Prods. Co. v.
Dwinell-Wright Co.,
27 C.C.P.A. 1194, 11 F.2d 490 (1940) 12

DOCKETED CASES

Blackhorse, et al. v. Pro-Football, Inc.,
No. 92/046,185 (T.T.A.B. Aug. 11, 2006) 7

FEDERAL STATUTES

15 U.S.C. § 93 12

15 U.S.C. § 1052 ..... 2, 10

15 U.S.C. § 1052(a) 3, 5, 10, 11

15 U.S.C. § 1052(d) 15

15 U.S.C. § 1052(e) 15

15 U.S.C. § 1064 ..... 2, 10, 11, 13

15 U.S.C. § 1064(3) ..... *passim*

15 U.S.C. § 1069 ..... *passim*

15 U.S.C. § 1071(a)(4) 5

15 U.S.C. § 1071(b)(1) 5, 7

28 U.S.C. § 1254(1) 1

28 U.S.C. § 1291 8

RULE

Sup. Ct. R. 14.1(f) 2

OPINIONS BELOW

The opinions of the United States Court of Appeals for the District of Columbia Circuit are reported at 565 F.3d 880 (D.C. Cir. 2009) and 415 F.3d 44 (D.C. Cir. 2005).[2] (Reproduced at App. 1 and 15.) The opinion of the United States District Court for the District of Columbia granting Pro-Football, Inc.'s ("Pro-Football") initial motion for summary judgment is reported at 284 F. Supp. 2d 96 (D.D.C. 2003). (Reproduced at App. 65.) The District Court's subsequent decision on remand from the D.C. Circuit is reported at 567 F. Supp. 2d 46 (D.D.C. 2008). (Reproduced at App. 27.) The Trademark Trial and Appeal Board's ("T.T.A.B.") order scheduling the cancellation of Pro-Football, Inc.'s "redskins" marks is reported at 50 U.S.P.Q.2d 1705 (T.T.A.B. 1999). (Reproduced at App. 181.)

STATEMENT OF JURISDICTION

The jurisdiction of this Court is invoked under 28 U.S.C. § 1254(1). The Court of Appeals filed its final opinion on May 27, 2009. Petitioners did not seek a rehearing en banc. On July 31, 2009, The Honorable John G. Roberts, Jr., as Circuit Justice for the United States Court of Appeals for the District of Columbia Circuit, granted Petitioners' application for an extension of time within which to file a petition for a writ of certiorari, extending the time to

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[2] The Court of Appeals retained jurisdiction over the case while remanding to the District Court for further consideration of the applicability of laches to Petitioner Romero. The Court of Appeals denied a rehearing *en banc* regarding its first opinion in this case on September 9, 2005, in an unreported decision.

file this Petition up to and including September 14, 2009.

STATUTORY AND REGULATORY PROVISIONS

This Petition concerns the Circuit Court's interpretation and application of 15 U.S.C. § 1052, 15 U.S.C. § 1064, and 15 U.S.C. § 1069, which are set out in the Appendix pursuant to Supreme Court Rule 14.1(f). (App. 340, 344, 348.)

STATEMENT OF THE CASE

This case involves the question of whether the doctrine of laches is applicable to certain types of trademark cancellation petitions brought pursuant to Section 14(3) of the Lanham Act (the "Act"). As the D.C. Circuit acknowledged, its decision below and that of the Federal Circuit in *Bridgestone/Firestone Research, Inc. v. Auto. Club De L'Ouest De La France*, 245 F.3d 1359, 1360-61 (Fed. Cir. 2001), are in conflict with the Third Circuit Court of Appeals' holding in *Marshak v. Treadwell*, 240 F.3d 184 (3d Cir. 2001) (Alito, J.).

Petitioners are all Native American persons (collectively, "Native American Parties"), and each is a member of a different federally recognized Indian tribe. Each has a lengthy history of public service to the Native American community and all have held and currently hold positions of responsibility within or for their respective tribes, intertribal groups, and/or American Indian institutions and organizations. Throughout their lifetimes, all have been the target of insult, degradation, and

humiliation resulting from the use of the derogatory term "redskins."

Pro-Football is the Washington, D.C. professional football organization that has chosen this racial epithet as its team name. In September 1992, the Native American Parties filed a Petition seeking cancellation of Pro-Football's six federally-registered service marks that incorporate the term "redskins" or derivations of this word. Two of Pro-Football's marks also include additional graphic material making it abundantly clear that they (and the team) refer to, identify, or otherwise implicate Native Americans. Pro-Football registered these marks between 1967 and 1990.

The Native American Parties contend that these marks should never have been registered and that the registrations were therefore void *ab initio*, justifying immediate cancellation. Section 14(3) of the Act provides for cancellation of a registration "at any time," if the subject mark was registered "contrary to the provisions" of Section 2(a) of the Act. 15 U.S.C. § 1064(3). Pursuant to Section 2(a), no mark shall be registered if it consists of or comprises "matter which may disparage . . . persons, living or dead, . . . or bring them into contempt, or disrepute . . . ." 15 U.S.C. § 1052(a).[3]

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[3] Matter *may* "disparage" when it *may* "slight," or "dishonor," or "discredit" persons, *see In re Hines*, 31 U.S.P.Q.2d 1685, 1688 n.5 (T.T.A.B. 1994), *rev'd on other grounds*, 32 U.S.P.Q.2d 1376 (T.T.A.B. 1994), or when it *may* be considered "derogatory" toward persons. *See In re In Over Our Heads Inc.*, 16 U.S.P.Q.2d 1653, 1654 n.4 (T.T.A.B. 1990).

The Native American Parties successfully demonstrated before the T.T.A.B. that "redskins" is today and has been historically a disparaging racial epithet that brings them into contempt, ridicule, and disrepute. The evidence presented to the T.T.A.B. included, *inter alia*, (1) nineteenth- and twentieth-century American newspapers and popular literature containing examples of the use of "redskin(s)" as a term associated with violence, savagery, and racial inferiority; (2) use of the term in film, where it has often been used in a context of violence, savagery, and killing; (3) expert testimony from a linguist regarding the offensive and disparaging character of "redskin(s);" (4) detailed personal testimonials from the Native American Parties; and (5) survey evidence demonstrating that "redskins" is widely perceived as offensive, both among Native Americans and in the population as a whole. The Native American Parties went well beyond the required proof to facilitate the Board's ultimate conclusion that "redskins" *may* "disparage" Native American persons and that Pro-Football's use of the "redskins" marks, in fact, *does* so.

Before ruling on the merits, the T.T.A.B. ruled, in response to a motion by the Respondent to dismiss the petition, that laches was inapplicable to the petitioners' claim. *Harjo v. Pro-Football, Inc.*, 30 U.S.P.Q.2d 1828, 1830-32 (T.T.A.B. 1994).

On April 2, 1999, the T.T.A.B. issued an order scheduling the cancellation of Pro-Football's "redskins" marks. The T.T.A.B.'s decision was based on its finding that:

> [T]he evidence of record establishes that, within the relevant time periods, the derogatory connotation of the word "redskin(s)" in connection with Native Americans extends to the term "Redskins," as used in [Pro-Football's] marks in connection with the identified services, such that [Pro-Football's Redskins] marks may be disparaging of Native Americans to a substantial composite of [Native Americans].

Harjo v. Pro-Football, Inc., 50 U.S.P.Q.2d at 1748 (the "T.T.A.B. Decision") (interpreting Section 2(a) of the Lanham Act).

On June 1, 1999, Pro-Football filed a civil action in the District Court seeking review of the T.T.A.B. Decision.[4] Pro-Football's Complaint challenged the T.T.A.B. Decision in five (5) separate causes of action, asking the District Court to, *inter alia*, find (1) that the "redskins" marks do not disparage Native Americans [Count I]; (2) that the "redskins" marks do not bring Native Americans into contempt or disrepute [Count II]; and (3) that the cancellation petition was barred by the doctrine of

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[4] The Lanham Act permits parties aggrieved by a registration/cancellation decision of the T.T.A.B. to either (1) appeal the T.T.A.B.'s decision to the Federal Circuit; or (2) seek review of the T.T.A.B.'s decision by filing a civil action in District Court. *See* 15 U.S.C. §§ 1071(a)(4), 1071(b)(1).

laches [Count V]. *See Pro-Football, Inc. v. Harjo*, 284 F. Supp. 2d at 100.

Both sides filed summary judgment motions. The Native American Parties asked the District Court to, *inter alia*, (1) affirm the T.T.A.B. Decision and (2) dismiss Pro-Football's laches claim. *See id.* Pro-Football's motion for summary judgment made "two main arguments." *Id.* at 102. First, Pro-Football challenged the T.T.A.B.'s finding that the "redskins" marks "may disparage" Native Americans within the meaning of the Act, arguing that "the dispositive evidence before the T.T.A.B. was irrelevant." *Id.* Second, Pro-Football argued that the Native American Parties' petition for cancellation was barred by the doctrine of laches. *See id.*

In an opinion dated September 30, 2003, the District Court granted summary judgment for Pro-Football on Counts I and II, concluding that the T.T.A.B.'s finding of disparagement was "not supported by substantial evidence." *Id.* at 145. The court also held that "the doctrine of laches precludes consideration of the case." *Id.* The Native American Parties appealed to the Court of Appeals for the District of Columbia Circuit.

In its July 15, 2005, opinion, the District of Columbia Circuit agreed with the District Court that the doctrine of laches applied to the Native American Parties' Petition. *Pro-Football, Inc. v. Harjo*, 415 F.3d at 48. The Circuit Court held that the "at any time" language of Section 1064(3) applied only to statutes of limitations and not to the doctrine of laches. *Id.* The Circuit Court concluded, however,

that the District Court had misapplied the doctrine when it "started the clock for assessing laches in 1967 – the time of the first mark's registration – for *all* seven Native Americans, even though one, Mateo Romero, was at the time only one year old." *Id.* Holding that "laches runs only from the time a party has reached his majority," the D.C. Circuit, while retaining jurisdiction over the case, remanded to the District Court to reconsider the facts surrounding Mr. Romero's Petition. *Id.* at 48, 50.[5] The D.C. Circuit did not reach the merits of the T.T.A.B.'s original finding of disparagement.

On remand, the District Court issued a June 25, 2008 opinion finding that Mr. Romero's claim was barred by the doctrine of laches. *Pro-Football, Inc. v. Harjo*, 567 F. Supp. 2d at 47. The D.C. Circuit affirmed, issuing its final opinion in the case on May 27, 2009.

The District Court had jurisdiction over Pro-Football's civil action seeking review of the T.T.A.B.'s decision on Petitioners' Section 1064(3) Petition pursuant to 15 U.S.C. § 1071(b)(1). The Court of Appeals had jurisdiction to review the final

[5] On August 11, 2006, six Native Americans filed a joint petition with the T.T.A.B. for cancellation of the same Pro-Football trademarks that are in issue in this case. Petition for Cancellation, *Blackhorse, et al. v. Pro-Football, Inc.*, No. 92/046,185 (T.T.A.B. Aug. 11, 2006); JA 1047-52. Some of the Petitioners bringing this Petition to Cancel had just recently reached the age of majority at the time the petition was filed. *See* Pet. for Cancellation, *Blackhorse, et al. v. Pro-Football, Inc.*, No. 92/046,185 (T.T.A.B. Aug. 11, 2006); JA 1051. The U.S. Patent and Trademark Office has ruled that action on the petition will be suspended pending the results of this case.

judgment of the District Court pursuant to 28 U.S.C. § 1291.

REASONS FOR ALLOWANCE OF THE WRIT

This Court should issue a writ in order to resolve a split among the circuit courts and to clarify the applicability of the doctrine of laches to cancellation petitions brought pursuant to Section 14(3) of the Lanham Act. The present conflict among the circuit courts has significant implications, as Section 14(3) of the Lanham Act governs numerous types of cancellation petitions including, *inter alia*, claims that a trademark (1) is a generic name for goods or services, (2) has been abandoned, (3) was obtained fraudulently, or (4) is immoral or disparaging.[6]

As the D.C. Circuit acknowledged, its opinion that the doctrine of laches applies to Section 14(3) cancellation petitions conflicts with prior precedent from the Court of Appeals for the Third Circuit. *Harjo*, 415 F.3d at 48 (citing *Marshak*, 240 F.3d at 193-94 & n.4). In *Marshak*, writing for a unanimous panel, then-Judge Alito held that a counterclaim brought under Section 14(3) of the Act was not time-barred. *Marshak*, 240 F.3d at 192. The *Marshak* court held that "the meaning of the phrase 'at any time' in Section 14(3) is clear even if that particular subsection is viewed in isolation." *Id.* at 192-93. The Third Circuit wrote that Section 14(3) "means what it says: a petition falling within subsection (3) . . . is

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[6] The views of the United States may be helpful to the Court on this question.

not subject to any time limit but may be filed 'at any time.'" *Id.* at 193. The Third Circuit performed a thorough examination of the history of the "at any time" phrase in the context of federal trademark law, as well as a review of federal case law interpreting that phrase and held that a laches defense is not available in a case controlled by the "at any time" language of Section 14(3).

The D.C. Circuit acknowledged the *Marshak* decision in its 2005 opinion, but rejected the Third Circuit's comprehensive analysis. *Harjo*, 415 F.3d at 48. Instead, the D.C. Circuit held that the doctrine of laches was applicable to Petitioners' Section 14(3) cancellation petition. *Id.* The D.C. Circuit confined its analysis to its interpretation of the statutory language and did not address the history of the "at any time" language recounted in detail in *Marshak*. The court asserted that it would "join the Federal Circuit . . . in concluding that the statute does not bar the equitable defense of laches in response to section 1064(3) cancellation petitions." *Id.* (citing *Bridgestone*, 245 F.3d at 1360-61). The Federal Circuit's opinion in *Bridgestone* takes a third approach to the question of whether equitable defenses apply in such cases in that it did not consider the import of the "at any time" language of Section 14(3) in making its ruling.

The D.C. Circuit's decision below has deepened an already-existing split between the Third and Federal Circuits. Three circuit courts have now taken three different approaches in determining whether the doctrine of laches applies to cancellation petitions brought pursuant to Section

14(3) of the Act. There are no indications that this split will resolve itself and it has far-reaching implications in the field of trademark law. Accordingly, this issue merits review by this Court in order to provide a consistent interpretation of federal law.

Furthermore, the interpretation offered by the D.C. Circuit is inconsistent with the public interest concerns underlying relevant provisions of the Act. This interpretation of the statute would allow for the application of laches to precisely the types of cancellation petitions where the public interest and the integrity of the trademark registry are at stake. This case presents a powerful example of this flaw in the D.C. Circuit's reasoning and provides this Court with an opportunity to clarify the meaning of Section 14(3) of the Act and resolve a deepening split between the circuit courts.

I. The Doctrine Of Laches Is Inapplicable To Registrations Challenged Pursuant To Section 14(3) Of The Act.

Section 14 of the Act provides that a mark may be cancelled "at any time" if it were obtained contrary to Section 2(a). 15 U.S.C. § 1064(3); *Park 'N Fly, Inc. v. Dollar Park and Fly, Inc.*, 469 U.S. 189, 195 (1985) (recognizing that a registration "may be canceled at any time" if obtained contrary to the provisions of Section 2). *See also The Ohio State Univ. v. Ohio Univ.*, 51 U.S.P.Q.2d 1289, 1294 (T.T.A.B. 1999) (recognizing that equitable defenses should not preclude cancellation of registrations that are void *ab initio*). The plain meaning of the phrase

"at any time" dictates that laches is inapplicable to situations contemplated by Section 14(3), including registrations issued contrary to Section 2(a). As the Third Circuit concluded in *Marshak*, "the meaning of the phrase 'at any time' in Section 14(3) is clear even if that particular subsection is viewed in isolation." 240 F.3d at 192-93.[7]

In *Marshak*, then-Judge Alito conducted a thorough analysis of the relevant statutory language and its history within the context of trademark law. *See, e.g., Robinson v. Shell Oil Co.*, 519 U.S. 337, 341, 117 S. Ct. 843, 846 (1997) ("The plainness or ambiguity of statutory language is determined by reference to the language itself, the specific context

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[7] *See also Emmpressa Cubana Del Tabaco v. Culbro Corp.*, No. 97 Civ. 8339, 2002 U.S. Dist. LEXIS 21731, *14 (S.D.N.Y. Oct. 8, 2002) (following the decisions of the Trademark Trial and Appeal Board finding that the "any time" language in Section 14 "precludes a laches defense"), *rev'd on other grounds*, 399 F.3d 462 (2005); *The International Assoc. of Fire Chiefs, Inc. v. The H. Marvin Ginn Corp.*, 225 U.S.P.Q. 940, 947 (T.T.A.B. 1985) (noting that "the section [of the Lanham Act] which provides that [equitable] defenses may be considered and applied 'in all inter partes proceedings . . . where [they are] applicable' must be reconciled with other relevant statutory provisions, including the provision in Section 14(c)") (internal citation omitted) *rev'd on other grounds*, 782 F.2d 987 (Fed. Cir. 1986); *Schenley Indus., Inc. v. Sterling Brewers, Inc.*, 157 U.S.P.Q. 593, 595 (T.T.A.B. 1968) (determining that "the equitable defenses set forth in Section 19 of the [Lanham Act] are for obvious reasons inapplicable in a proceeding involving abandonment and/or any of the other grounds for cancellation enumerated in Section 14(c)") *rev'd on other grounds*, 441 F.2d 675 (C.C.P.A. 1971); *National Serv. Indus., Inc. v. Turtle Wax, Inc.*, 154 U.S.P.Q. 68, 70 (T.T.A.B. 1967) (finding that laches is not applicable to "situations envisioned" by Section 14(3) of the Lanham Act).

in which that language is used, and the broader context of the statute as a whole."). With regard to the plain language of the statute, the Third Circuit reasoned that "the language of subsection (3) means what it says: a petition falling within subsection (3) . . . is not subject to any time limit but may be filed 'at any time.'" *Marshak*, 240 F.3d at 193. With regard to both laches and the statute of limitations, "any time" meant "any time."

In support of its interpretation of the plain language of the statute, the *Marshak* court made several additional observations. First, the court noted that "the PTO has consistently held that the phrase 'at any time' precludes a laches defense to a cancellation action premised on fraudulent procurement," which comes under Section 14(3). *Id.* at 193 n.2. The Third Circuit cited approvingly the T.T.A.B.'s decision below, as well as other T.T.A.B. decisions addressing laches defenses. *Id.* (citing *Harjo*, 30 U.S.P.Q.2d at 1831; *Tbc Corp. v. Grand Prix Ltd.*, 12 U.S.P.Q.2d 1311, 1313 (T.T.A.B. 1989); *Bausch & Lomb, Inc. v. Leupold & Stevens Inc.*, 1 U.S.P.Q.2d 1497, 1499-500 (T.T.A.B. 1986)). Second, the opinion went back to the origins of the "at any time" language, observing that "[t]his language derives from Section 13 of the Trademark Act of 1905, 15 U.S.C. § 93," and that the accepted meaning of that phrase in the 1905 Act "was that it excluded the defense of laches in a cancellation proceeding." *Id.* at 193 n.4 (citing *Dwinell-Wright Co. v. National Fruit Prod Co.*, 129 F.2d 848, 853 (1st Cir. 1942); *White House Milk Prods. Co. v. Dwinell-Wright Co.*, 27 C.C.P.A. 1194, 11 F.2d 490, 493 (1940); *Cluett, Peabody & Co. v. Hartogensis*, 17 C.C.P.A. 1166, 41

F.2d 94, 97 (1930)). Third, the opinion went further into the history of the phrase "at any time," noting that the 1905 Act language "was derived from a line of Supreme Court precedent holding that laches would not bar an injunction against future infringement, but only an accounting for past profits." *Id.* (citing *Saxlehner v. Eisner & Mendelson Co.*, 179 U.S. 19, 21 S. Ct. 7, 45 L. Ed. 60 (1900); *Menendez v. Holt*, 128 U.S. 514, 9 S. Ct. 143, 32 L. Ed. 526 (1888); *McLean v. Fleming*, 96 U.S. (6 Otto.) 245, 24 L. Ed. 828 (1877)).[8]

The Third Circuit's decision is consistent with this Court's precedent construing "at any time" in other contexts as precluding defenses based upon the untimeliness of asserting a claim. *See Heflin v. United States*, 358 U.S. 415, 420 (1959) (Stewart, J., concurring) ("The words which Congress has used are not ambiguous . . . . This latter provision simply means that, as in habeas corpus, there is no statute of limitations, no res judicata, and that the doctrine of laches is inapplicable.").[9] *See also Day v. McDonough*, 547 U.S. 198, 214-215 (2006) (Scalia, J., dissenting).

In concluding that laches does apply to a claim brought pursuant to Section 14(3), the D.C. Circuit expressly rejected *Marshak*. The Circuit Court's conclusion relies on 15 U.S.C. § 1069, which

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[8] Underlying these decisions is the policy that "the interest vindicated by Section 14 is not just the injury to the challenging party, but the integrity of the register." *Id.* at 194.

[9] Justice Stewart's concurrence was joined by Justices Frankfurter, Clark, Harlan, and Whittaker.

provides: "In all inter partes proceedings equitable principles of laches, estoppel, and acquiescence, *where applicable* may be considered and applied." (emphasis added). The D.C. Circuit concluded that applying the "at any time" language to the defense of laches "would make section 1069, which explicitly permits consideration of laches and other equitable doctrines, meaningless as to cancellation petitions" brought under Section 14(3). *Harjo*, 415 F.3d at 48.

But this is exactly the point. Section 14(3) provides a carve out for particular kinds of cancellation petitions that may be brought "at any time." Congress was specific as to which types of cancellation petitions could be brought "at any time." These include instances when

> the registered mark becomes the generic name for the goods or services, or a portion thereof, for which it is registered, or is functional, or has been abandoned, or its registration was obtained fraudulently or contrary to the provisions of section 1054 of this title or of subsection (a), (b), or (c) of section 1052 of this title for a registration under this chapter, or contrary to similar prohibitory provisions of such prior Acts for a registration under such Acts, or if the registered mark is being used by, or with the permission of, the registrant so as to misrepresent the source of the goods or services on or in

> connection with which the mark is used.

15 U.S.C. § 1064(3). As the *Marshak* court observed, these enumerated petitions are unique in that they involve marks that bring "the integrity of the register" into question. 240 F.3d at 194.

In contrast, cancellation petitions brought on the grounds of confusion, likely mistake, mere description or functionality, or dilution, for example, are not included within the "at any time" carve out of Section 14(3), and are therefore subject to equitable defenses, including laches, pursuant to 15 U.S.C. § 1069. *See* 15 U.S.C. § 1052(d) & (e). Indeed, the D.C. Circuit's interpretation of the statute, which would apply equitable defenses to all cancellation petitions, including those listed in Section 14(3), ignores the plain language of Section 1069, which acknowledges that such defenses may be considered only "where applicable." 15 U.S.C. § 1069.

With regard to the specific kinds of petitions enumerated in Section 14(3), Congress meant what it said. This interpretation is consistent with the plain meaning of the statutory language and with decades of federal court precedent interpreting that phrase in the trademark context. *See Marshak*, 240 F.3d at 193 n.4. Indeed, the *Marshak* court acknowledged the language of 15 U.S.C. § 1069, noting that "[i]t is telling that although the Lanham Act now specifically provides that an infringement action is subject to equitable defenses the statute continues to provide that a mark is vulnerable to a cancellation proceeding 'at any time'" under Section

14(3). *Id.* at 193 n.4 (internal citation omitted). If Congress did not agree with the decisions of the federal courts interpreting the "at any time" language in the Trademark Act of 1905 to bar the defense of laches, it could have employed different language in the current Section 14(3).

The D.C. Circuit's decision below rejects this analysis and instead draws support for its position from the Federal Circuit's decision in *Bridgestone*, 245 F.3d at 1359. The *Bridgestone* court did not even consider the "at any time" language of Section 14(3) in making its ruling, relying solely on the language in Section 1069.

The holdings of the Third Circuit in *Marshak*, the Federal Circuit in *Bridgestone*, and D.C. Circuit below are in direct conflict on the question presented in this Petition. Given the different approaches taken by each of these circuit courts, this split is likely to expand and deepen absent guidance from this Court. This case presents an ideal opportunity for this Court to resolve this split and clarify the applicability of laches and other equitable defenses to numerous types of trademark cancellation petitions that fall under Section 14(3) of the Act.

II. The D.C. Circuit's Interpretation Of The Act Contravenes Important Public Interest Concerns Protected By Congress.

The Third Circuit properly held in *Marshak* that the plain language of Section 14(3) bars the application of the doctrine of laches to the case *sub*

judice. Not only is this reading the most logical interpretation of the statutory language, but the contrary interpretation offered by the D.C. Circuit would lead to absurd results that contravene the public interest. *See, e.g., Dodd v. United States*, 545 U.S. 353, 359, 125 S. Ct. 2478, 2483, 162 L. Ed. 2d 343, 350 (2005) ("[W]hen the statute's language is plain, the sole function of the courts – at least where the disposition required by the text is not absurd – is to enforce it according to its terms.") (quoting *Hartford Underwriters Ins. Co. v. Union Planters Bank, N. A.*, 530 U.S. 1, 6, 147 L. Ed. 2d 1, 120 S. Ct. 1942 (2000)).

The D.C. Circuit's interpretation would allow for the defense of laches in precisely the types of cancellation petitions where the public interest and the integrity of the registry are most often at stake – petitions to which laches has consistently been found to be inapplicable. This outcome is likely to be repeated under the D.C. Circuit's decision below and makes it imperative that this Court grant certiorari and clarify to applicability of laches in this context.

The "at any time" carve out of Section 14(3) applies to cancellation petitions involving claims that a trademark, *inter alia*, (1) is a generic name for goods or services, (2) has been abandoned, (3) was obtained fraudulently, or (4) is scandalous, immoral or disparaging. These are exactly the types of cancellation petitions that most often involve issues

concerning the public interest.[10] In these situations, the public interest in cancellation of the mark at issue transcends the defense of laches. Because these cases involve the public interest, including *inter alia* maintaining the integrity of the registry, there is less likely to be a private party constantly reviewing the Registry and promptly filing a petition than in other trademark cases. For this reason, it is likely that there will be more delay in the filing of petitions; the Act accommodates this situation by making defenses like statutes of limitation and laches inapplicable.

As the Third Circuit recognized in *Marshak*, "the interest vindicated by Section 14 is not just the injury to the challenging party, but the integrity of the register." 240 F.3d 194. In this regard, the Third Circuit again cited the T.T.A.B.'s *Harjo* decision holding laches inapplicable in the instant case and quoted language from the T.T.A.B.'s opinion emphasizing that the public interest in removing certain registrations from the registry mandates that a laches defenses cannot be available in such cases. *Id.*

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[10] Petitioners acknowledge that not every cancellation petition that falls under Section 14(3) has a substantial or overriding public interest component. For example, a trademark may only disparage an individual or entity as opposed to a group. Rather than carve out such individual claims, Congress chose to apply the "at any time" language of Section 14(3) to all disparagement claims, as well as the other types of cancellation petitions provided for in that Section. There is no reason for the courts to alter Congress' legislative decision.

Laches is an equitable – not a legal – defense. It is well settled that laches will not be relied upon where there are persuasive public policy reasons that can render it inapplicable. Indeed, the public interest historically has been the most important consideration in assessing the availability of equitable remedies such as laches. *See, e.g.*, *Jarrow Formula, Inc. v. Nutrition Now, Inc.*, 304 F.3d 829, 840 (9th Cir. 2002) ("because laches is an equitable remedy, laches will not apply if the public has a strong interest in having the suit proceed"); *Conopco, Inc. v. Campbell Soup Co.*, 95 F.3d 187, 193 (2d Cir. 1996) (requiring that public interests be considered in a laches analysis); *SunAmerica Corp. v. Sun Life Assurance Co. of Canada*, 77 F.3d 1325, 1337 (11th Cir. 1996) (rejecting the equitable defense of acquiescence because "[s]omeone must suffer the remedy, and law demands it not be the public"); *Gasser Chair Co., Inc. v. Infanti Chari Manuf. Corp.*, 60 F.3d 770, 773 (Fed. Cir. 1995) (recognizing that even where undue delay has been established, laches will not apply if it would result in inequity); *Maryland-National Capital Park & Planting Comm'n v. U.S. Postal Serv.*, 487 F.2d 1029, 1042 (D.C. Cir. 1973) ("[e]quitable remedies depend not only on a determination of legal rights and wrongs, but on such matters as laches, good (or bad) faith, and most important an appraisal of the public interest").

The D.C. Circuit's interpretation of 15 U.S.C. § 1069 as allowing the application of laches to a cancellation petition falling under the carve out in Section 14(3) creates the absurd result of overruling these well-established precedents without any

indication that Congress intended to do so. To the contrary, Congress' decision to apply the "at any time" carve out to the specific types of cancellation petitions enumerated in Section 14(3) reflects its understanding that these petitions are unique and should not be subject to defenses like laches and statutes of limitation. Congress concluded that cancellation petitions brought on these specific grounds should be considered "at any time," and this Court should grant certiorari to resolve the split between the circuit courts and clarify that Congress meant what it said.

CONCLUSION

For all of the forgoing reasons, Petitioners respectfully request that this Court grant review of this matter.

Respectfully submitted,

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No. _____

In The
Supreme Court of the United States

SUZAN S. HARJO, *ET AL.*,
Petitioners,

v.

PRO-FOOTBALL, INC.,
Respondent.

ON PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT

APPENDIX

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APPENDIX:

ORDERS ON APPEAL

Pro-Football, Inc. v. Harjo,
565 F.3d 880
(D.C. Cir. 2009) ..... App. 1

Pro-Football, Inc. v. Harjo,
415 F.3d 44
(D.C. Cir. 2005) ..... App. 15

OTHER RELEVANT ORDERS

Pro-Football, Inc. v. Harjo,
567 F. Supp. 2d 46
(D.D.C. 2008) ..... App. 27

Pro-Football, Inc. v. Harjo,
284 F. Supp. 2d 96
(D.D.C. 2003) ..... App. 65

Harjo v. Pro-Football, Inc.,
50 U.S.P.Q.2d 1705
(T.T.A.B. 1999) ..... App. 181

ORDERS ON REHEARING

Order of
The United States Court of Appeals for
The District of Columbia
Re: Denying Petition for Rehearing
entered September 5, 2005 ..... App. 337

Order of
The United States Court of Appeals for
The District of Columbia
Re: Denying Petition for
Rehearing En Banc
entered September 5, 2005 ..... App. 338

STATUTES

15 U.S.C. § 1052 ..... App. 340

15 U.S.C. § 1064 ..... App. 344

15 U.S.C. § 1069 ..... App. 348

OTHER PERTINENT MATERIAL

Bridgestone/Firestone Research, Inc. v. Auto. Club De L'Ouest De La France,
245 F.3d 1359 (Fed. Cir. 2001) ..... App. 349

Marshak v. Treadwell, 240 F.3d 184
(3d Cir. 2001) ..... App. 360

United States Court of Appeals

FOR THE DISTRICT OF COLUMBIA CIRCUIT

Decided May 15, 2009

Reissued May 27, 2009

No. 03-7162

PRO FOOTBALL, INC.,

APPELLEE

v.

SUZAN S. HARJO, ET AL.,

APPELLANTS

Appeal from the United States District Court

for the District of Columbia

(No. 99cv01385)

Philip J. Mause and *Jeffrey J. Lopez* were on the briefs for appellants.

Robert L. Raskopf and *Sanford I. Weisburst* were on the brief for appellee.

Before: SENTELLE, *Chief Judge*, TATEL, and HENDERSON, *Circuit Judges*.

Opinion for the Court filed by *Circuit Judge* TATEL.

TATEL, *Circuit Judge*: At bottom, this case concerns whether various trademarks related to the Washington Redskins football team disparage Native Americans within the meaning of the Lanham Trademark Act, § 2, 15 U.S.C. § 1052(a). But that question has since been overshadowed by the defense of laches, the basis on which the district court first entered judgment for the Redskins six years ago. We reversed that decision, finding that the district court had misapplied the law of laches to the particular facts of the case. *Pro-Football, Inc. v. Harjo* (*Harjo II*), 415 F.3d 44, 50 (D.C. Cir. 2005). On remand, the district court reconsidered the evidence in light of our instructions and again ruled for the team. *Pro-Football, Inc. v. Harjo* (*Harjo III*), 567 F. Supp. 2d 46, 62 (D.D.C. 2008). Now appealing that decision, the Native Americans who originally petitioned for cancellation of the mark argue only that the district court improperly assessed evidence of prejudice in applying laches to the facts at issue. Limited to that question, we see no error and affirm.

I.

Because previous opinions have already described the background of this case at length, *see Harjo II*, 415 F.3d at 46–47; *Harjo III*, 567 F. Supp. 2d at 48–51, we provide only the essentials. Appellants, seven Native Americans, filed a 1992 action before the Patent and Trademark Office seeking cancelation of six Redskins trademarks that were, they argued, impermissibly disparaging towards members of their ethnic group. Pro-Football, the Redskins' corporate entity and the owner of the marks, argued to the Trademark Trial and Appeal Board that its long-standing use of the name,

combined with petitioners' delay in bringing the case, called for application of laches, an equitable defense that applies where there is "(1) lack of diligence by the party against whom the defense is asserted, and (2) prejudice to the party asserting the defense," *Nat'l R.R. Passenger Corp. v. Morgan*, 536 U.S. 101, 121–22 (2002) (internal quotation marks omitted). The TTAB disagreed, observing that petitioners asserted an interest in preventing "a substantial segment of the population" from being held up "to public ridicule," and that insofar as that interest reached "beyond the personal interest being asserted by the present petitioners," laches was inappropriate. *Harjo v. Pro Football Inc.*, 30 U.S.P.Q. 2d 1828, 1831 (TTAB 1994). Finding on the merits that the marks were indeed disparaging, the TTAB cancelled them, *see Harjo v. Pro Football Inc.*, 50 U.S.P.Q. 2d 1705, 1749 (TTAB 1999), depriving Pro-Football of the ability to pursue infringers.

Pro-Football then exercised its option to dispute this holding by means of a civil action in the United States District Court for the District of Columbia. *See* 15 U.S.C. § 1071(b)(1), (4) (providing choice between district court action and Federal Circuit appeal). The district court sided with Pro-Football on the laches issue, holding that the 25-year delay between the mark's first registration in 1967 and the TTAB filing in 1992 indeed required dismissal of the action. *Pro-Football, Inc. v. Harjo*, 284 F. Supp. 2d 96, 144 (D.D.C. 2003). We reversed. "[L]aches," we said, "attaches only to parties who have unjustifiably delayed," *Harjo II*, 415 F.3d at 49, and the period of unjustifiable delay cannot start before a party reaches the age of majority, *id.* at 48–49. The youngest petitioner, Mateo Romero, was only

a year old in 1967. Because the correct inquiry would have assessed his delay and the consequent prejudice to Pro-Football only from the day of his eighteenth birthday in December 1984, we remanded the record to the district court to consider, in the first instance, the defense of laches with respect to Romero. *Id.* at 49–50.

On remand in this case, the district court again found the defense of laches persuasive. It held that the seven-year, nine-month "Romero Delay Period" evinced a lack of diligence on Romero's part, *Harjo III*, 567 F. Supp. 2d at 53– 56, and following our instructions to consider both trial and economic prejudice, *see Harjo II*, 415 F.3d at 50, it found that that delay harmed Pro-Football, *Harjo III*, 567 F. Supp. 2d at 56–62. Now appealing from that decision, Romero challenges neither the applicability of laches *vel non* nor the district court's finding of unreasonable delay. We thus confine our review to the only question Romero does raise: whether the district court properly found trial and economic prejudice sufficient to support a defense of laches.

II.

Before turning to that question, we must first resolve a preliminary matter flagged but left undecided by our previous opinion: the standard of review. In *Harjo II*, we noted an apparent conflict between *Daingerfield Island Protective Society v. Lujan*, 920 F.2d 32, 38 (D.C. Cir. 1990), and *CarrAmerica Realty Corp. v. Kaidanow*, 321 F.3d 165, 172 (D.C. Cir. 2003), over the standard for reviewing a laches determination made on summary judgment. 415 F.3d at 50. In *Daingerfield*, an appeal

from summary judgment, we applied abuse of discretion review, noting the consistent view of the courts that "[b]ecause laches is an equitable doctrine," it is "primarily addressed to the discretion of the trial court." 920 F.2d at 38 (internal quotation marks omitted); *see also Coalition for Canyon Preservation v. Bowers*, 632 F.2d 774, 779 (9th Cir. 1980). By contrast, *CarrAmerica* seems to have reviewed a laches determination *de novo*, *see* 321 F.3d at 172 ("The District Court held that laches did not apply because it determined that Appellants had suffered no prejudice from Appellee's delay. Upon our *de novo* review, we determine that Appellants did indeed suffer prejudice."), but it is unclear whether this represented a considered opinion on the appropriate standard for reviewing laches decisions or merely referred to the more general standard that typically applies on summary judgment, *see id.* at 170 (referring to general summary judgment standard). Indeed, both standards are relevant: we review the existence of material facts in dispute or the sufficiency of the evidence to support a legal proposition under the familiar *de novo* summary judgment standard, even while deferring to the district court's considerable discretion on the question of how to apply the equitable principles of laches to the undisputed facts. *See, e.g.*, *Hot Wax, Inc. v. Turtle Wax, Inc.*, 191 F.3d 813, 818–19 (7th Cir. 1999). We are thus bound by precedent to apply abuse of discretion review, at least where, as here, an appellant concedes that "the material facts are not in dispute," Appellants' Reply. Br. 2.

Reviewing the district court's analysis of prejudice in light of its considerable discretion, we see no reason to reverse. The district court carefully

followed our instruction to assess both trial and economic prejudice arising from the Romero Delay Period, finding both. Romero now challenges those determinations, and while his arguments are not without merit, the errors alleged cannot overcome our deferential standard of review.

The district court relied primarily on two factors in finding trial prejudice: (1) the death of former Redskins president Edward Bennett Williams during the Romero Delay Period; and (2) the delay period's general contribution to the time lapse from the date of registration. *Cf. Harjo*, 50 U.S.P.Q. 2d at 1773–75 (disparagement is analyzed at the time of registration). According to the district court, both factors limited Pro-Football's ability to marshal evidence supporting its mark: Williams had met with Native American leaders close to the time of registration to discuss their views, while the nearly eight years of further delay made it more difficult to obtain any other contemporaneous evidence of public attitudes towards the mark. *See Harjo III*, 567 F. Supp. 2d at 56–58. Romero mainly argues that this "lost evidence" would have had minimal value. He believes that Williams' testimony would have reflected only a narrow set of views on the disparaging nature of the Redskins marks, and that any possibility that 1967 attitudes could have been better surveyed at the time of an earlier suit is outweighed by other overwhelming evidence of disparagement. We needn't cast doubt on Romero's view of the evidence to hold that there was no abuse of discretion. The lost evidence of contemporaneous public opinion is surely not entirely irrelevant, and weighing the prejudice resulting from its loss falls well within the zone of the district court's discretion.

In reviewing that assessment, we cannot assume that legally relevant evidence possibly available in an earlier action would have lacked persuasive content.

Nor can we fault the district court's evaluation of economic prejudice. Undisputed record evidence reveals a significant expansion of Redskins merchandising efforts and sizable investment in the mark during the Romero Delay Period. Romero believes this investment is irrelevant absent some evidence that Pro-Football would have acted otherwise—by, say, changing the Redskins name—if Romero had sued earlier. But the district court repeatedly rejected this argument, citing the Federal Circuit's holding in *Bridgestone/Firestone Research, Inc. v. Automobile Club*, 245 F.3d 1359, 1363 (Fed. Cir. 2001), that "[e]conomic prejudice arises from investment in and development of the trademark, and the continued commercial use and economic promotion of a mark over a prolonged period adds weight to the evidence of prejudice." *See Harjo III*, 567 F. Supp. 2d at 59. The court thus thought it sufficient that the team deployed investment capital toward a mark Romero waited too long to attack, whether or not the team could prove that it would necessarily have changed its name or employed a different investment strategy had Romero sued earlier.

This was no abuse of discretion. To be sure, a finding of prejudice requires at least some reliance on the absence of a lawsuit—if Pro-Football would have done exactly the same thing regardless of a more timely complaint, its laches defense devolves into claiming harm not from Romero's tardiness, but

from Romero's success on the merits. But in contrast to the defense of estoppel—which requires evidence of specific reliance on a particular plaintiff's silence—laches requires only general evidence of prejudice, which may arise from mere proof of continued investment in the late-attacked mark alone. *See Automobile Club*, 245 F.3d at 1363 ("'[S]pecific' evidence of 'reliance' on the Automobile Club's silence could relate to proof of estoppel, but it does not apply to laches. When there has been an unreasonable period of delay by a plaintiff, economic prejudice to the defendant may ensue whether or not the plaintiff overtly lulled the defendant into believing that the plaintiff would not act, or whether or not the defendant believed that the plaintiff would have grounds for action."). We have thus described as sufficient "a reliance interest resulting from the defendant's continued development of good-will during th[e] period of delay," and treated evidence of continued investment as proof of prejudice sufficient to bar injunctive relief. *NAACP v. NAACP Legal Def. & Educ. Fund, Inc.*, 753 F.2d 131, 137–38 (D.C. Cir. 1985). Such continued investment was unquestionably present here. The district court thus acted well within our precedent—as well as the precedent of the Federal Circuit, which directly reviews TTAB decisions—in finding economic prejudice on the basis of investments made during the delay period. The lost value of these investments was sufficient evidence of prejudice for the district court to exercise its discretion to apply laches, even absent specific evidence that more productive investments would in fact have resulted from an earlier suit.

In so holding, we stress two factors. First, as the district court correctly noted, the amount of prejudice required in a given case varies with the length of the delay. "If only a short period of time elapses between accrual of the claim and suit, the magnitude of prejudice required before suit would be barred is great; if the delay is lengthy, a lesser showing of prejudice is required." *Gull Airborne Instruments, Inc. v. Weinberger*, 694 F.2d 838, 843 (D.C. Cir. 1982). This reflects the view that "equity aids the vigilant and not those who slumber on their rights," *NAACP*, 753 F.2d at 137, as well as the fact that evidence of prejudice is among the evidence that can be lost by delay. Eight years is a long time—a delay made only more unreasonable by Romero's acknowledged exposure to the various Redskins trademarks well before reaching the age of majority. *See Harjo III*, 567 F. Supp. 2d at 54–55. The second point follows the first: because laches requires this equitable weighing of both the length of delay and the amount of prejudice, it leaves the district court very broad discretion to take account of the particular facts of particular cases. We have no basis for finding abuse of that discretion where, as here, the claim of error ultimately amounts to nothing more than a different take on hypothetical inquiries into what might have been.

III.

A final issue concerns the trademark of the team's cheerleaders, the "Redskinettes," which Pro-Football first registered in 1990. As to this mark and only this mark, Romero argues that he acted with reasonable diligence by filing his action in 1992, only 29 months from the mark's registration. The district

court disagreed, finding even this short delay unreasonable given the relationship between the Redskinettes claim and the other claims on which Romero was already delaying. *See id.* & 54 n.5. This view followed from Romero's own litigation position. He argued to the district court, this Court, and the TTAB that the disparaging nature of the Redskinettes name derives from the disparaging nature of the Redskins name itself. *See, e.g.*, Appellants' Opening Br. 28 ("In considering the merits of the Redskinettes mark, this Court would necessarily have to examine the TTAB's analysis of the disparagement associated with the term 'redskin' . . . ."). The district court thus saw no reason why Romero, fully aware of both the team's name and the cheerleaders' name and six-years into his delay period on the former, failed to complain immediately about the registration of the Redskinettes.

While Romero delayed considerably less in attacking the Redskinettes mark, the district court did not abuse its discretion by analyzing the reasonableness of this delay in light of the delay in bringing the underlying claims regarding the name of the team itself. The Federal Circuit has at least suggested that a defense of laches as to a recently registered mark may be based on a failure to challenge an earlier, substantially similar mark, *see Lincoln Logs Ltd. v. Lincoln Pre-Cut Log Homes, Inc.*, 971 F.2d 732, 734 (Fed. Cir. 1992), as has the TTAB, *see Copperweld Corp. v. Astralloy-Vulcan Corp.*, 196 U.S.P.Q. 585, 590–91 (TTAB 1977). It is unclear to us how this rule interacts with the requirement to analyze disparagement at the time of registration, since the factual context may well have changed. But in any event and in the context of *this*

case, it is difficult to see how it could be inequitable to allow Romero to complain about the Redskins but equitable to allow his complaint about the particularly because the Redskinettes name had been in use well before the date of registration. Indeed, the registration of the Redskinettes mark reflects perhaps the greatest reliance on the absence of any previous complaints. Thus, without deciding whether Romero could have avoided laches by attacking the Redskinettes mark on the day of registration, we at least see no abuse of discretion in the district court's finding that the 29-month delay evinced a lack of reasonable diligence.

In fact, we think the Redskinettes issue best demonstrates the reasonableness of the district court's approach to this case as a whole. In 1990, six years into the Romero Delay Period, Pro-Football was not only investing in the Redskins mark, but seeking to expand legal protection of related marks, placing greater reliance on the continued validity of its underlying brand name. It would have been bold indeed for the team to have sought to register the Redskinettes under their existing name had the TTAB been considering revocation—or had the TTAB already revoked—the registration of the Redskins mark. We thus think it neither a stretch of imagination nor an abuse of discretion to conclude that Pro-Football might have invested differently in its branding of the Redskins and related entities had Romero acted earlier to place the trademark in doubt. We accordingly have no basis for questioning the district court's determination.

IV.

Deciding only the questions presented, and finding no abuse of discretion in the district court's resolution of them, we affirm.

So ordered.

United States Court of Appeals

FOR THE DISTRICT OF COLUMBIA CIRCUIT

No. 03-7162 September Term 2008

99cv01385

Filed On: May 27, 2009

Pro Football, Inc.,

Appellee

v.

Suzan S. Harjo, et al.,

Appellants

BEFORE: Sentelle, Chief Judge, and Henderson and Tatel, Circuit Judges

O R D E R

It is **ORDERED**, on the court's own motion, that the opinion issued May 15, 2009, be amended as follows:

Page 2, line 15: delete the word "plaintiffs" and insert in lieu thereof: "the Native Americans who originally petitioned for cancellation of the mark"

Page 2, line 31: delete the word "plaintiffs' " and insert in lieu thereof: "petitioners' "

Page 3, line 25: delete the word "plaintiff" and insert in lieu thereof: "party"

Page 3, line 26: delete the word "plaintiff" and insert in lieu thereof: "petitioner"

Per Curiam

FOR THE COURT:
Mark J. Langer, Clerk

BY: /s/
Michael C. McGrail
Deputy Clerk

United States Court of Appeals

FOR THE DISTRICT OF COLUMBIA CIRCUIT

Argued April 8, 2005

Decided July 15, 2005

Reissued September 13, 2005

No. 03-7162

PRO-FOOTBALL, INC.,

APPELLEE

v.

SUZAN S. HARJO, ET AL.,

APPELLANTS

Appeal from the United States District Court

(USDC) for the District of Columbia

(No. 99cv01385)

Philip J. Mause argued the cause for appellants. With him on the briefs was *Norm D. St. Landau*.

Thomas C. Morrison argued the cause for *amici curiae* National Congress of American Indians, et al. in support of appellants. With him on the brief was *Walter Echo-Hawk*.

Adam L. Barea and *Robert R. Vieth* were on the brief for *amicus curiae* InterFaith Conference of Metropolitan Washington in support of appellants.

Robert L. Raskopf argued the cause for appellee. With him on the brief were *Marc E. Ackerman*, *Carolyn B. Lamm*, and *Francis A. Vasquez, Jr.*

Before: SENTELLE, RANDOLPH, and TATEL, *Circuit Judges*.

Opinion for the Court filed PER CURIAM.

PER CURIAM: In 1992, seven Native Americans petitioned the Trademark Trial and Appeal Board ("TTAB") to cancel the registrations of six trademarks used by the Washington Redskins football team. After the TTAB granted their petition, the team's owner, Pro-Football, Inc., brought suit seeking reversal of the TTAB's decision. The district court granted summary judgment to Pro-Football on two alternate grounds, holding that the TTAB should have found the Native Americans' petition barred by laches and that in any event the TTAB's cancellation decision was unsupported by substantial evidence. The Native Americans now appeal. Because we find that the district court applied the wrong standard in evaluating laches as to at least one of the Native Americans, we remand the record for the district court to revisit this issue.

I.

The Lanham Trademark Act provides protection to trademark owners. *See generally* 15

U.S.C. §§ 1051-1127, 1141-1141n. To take advantage of many of its provisions, trademark owners must register their marks with the Patent and Trademark Office. Not all marks, however, can be registered. Under 15 U.S.C. § 1052, the PTO must deny registration to certain types of marks, including those which, in subsection (a)'s language, "may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute."

Another section, 15 U.S.C. § 1064(3), provides that if a mark is registered in violation of section 1052(a), "any person who believes that he is or will be damaged by the registration" may file a petition "[a]t any time" with the PTO to cancel the registration. This triggers a proceeding before the TTAB, *see* 15 U.S.C. § 1067, which takes evidence and determines whether to cancel the mark. Yet another provision, 15 U.S.C. § 1069, states that "[i]n all . . . proceedings equitable principles of laches, estoppel, and acquiescence, where applicable may be considered and applied."

This case concerns the registrations of six trademarks owned by Pro-Football, the corporate owner of the Washington Redskins football team, that include the word "Redskin." The first—"The Redskins" written in a stylized script—was registered in 1967, three more in 1974, another in 1978, and the sixth—the word "Redskinettes"—in 1990. Pro-Football uses all these marks in connection with goods and services related to its football team, including merchandise and entertainment services.

In 1992, seven Native Americans petitioned for cancellation of the registrations, claiming that the marks had disparaged Native Americans at the times of registration and had thus been registered in violation of section 1052(a). Pro-Football defended its marks, arguing among other things that laches barred the Native Americans' claim. Rejecting this argument, the TTAB found laches inapplicable due to the "broader interest—an interest beyond the personal interest being asserted by the present petitioners—in preventing a party from receiving the benefits of registration where a trial might show that respondent's marks hold a substantial segment of the population up to public ridicule." *Harjo v. Pro-Football Inc.*, 30 U.S.P.Q.2d 1828, 1831 (TTAB 1994).

On the merits, the parties presented the TTAB with a variety of evidence, including (1) dictionary entries for "redskin," some of which contained usage labels identifying the term as offensive and others of which did not; (2) book and media excerpts from the late nineteenth century through the 1940s that used the term "redskin" and portrayed Native Americans in a pejorative manner; (3) a study that found derogatory use of the term in Western-genre films from before 1980; (4) petitioners' testimony about their views of the term; (5) results from a 1996 survey of the general population and Native Americans that asked whether various terms, including "redskin," were offensive; (6) newspaper articles and game program guides from the 1940s onward using Native American imagery in connection with Washington's football team; and (7) testimony and documents relating to Native American protests, including one

in 1972, aimed specifically at the team. In a lengthy opinion, the TTAB concluded that a preponderance of the evidence showed the term "redskin" as used by Washington's football team had disparaged Native Americans from at least 1967 onward. *Harjo v. Pro-Football Inc.*, 50 U.S.P.Q.2d 1705 (TTAB 1999). The TTAB cancelled the registrations. Cancellation did not require Pro-Football to stop using the marks, but it did limit the team's ability to go after infringers under the Lanham Act.

Pursuant to 15 U.S.C. § 1071(b), Pro-Football filed suit in the U.S. District Court for the District of Columbia, seeking reinstatement of its registrations on the grounds that: (1) laches barred the Native Americans' petition; (2) the TTAB's finding of disparagement was unsupported by substantial evidence; and (3) section 1052(a) violates the First and Fifth Amendments to the U.S. Constitution both facially and as applied by the TTAB. Although in suits challenging TTAB decisions parties may introduce new evidence in the district court, *see Material Supply Int'l, Inc. v. Sunmatch Indus. Co.*, 146 F.3d 983, 989-90 (D.C. Cir. 1998), in this case the only such evidence of note related to laches. After discovery, the parties cross-moved for summary judgment. Without reaching the constitutional issues, the district court granted summary judgment to Pro-Football on the alternate grounds that laches barred the Native Americans' petition and that the TTAB's conclusion of disparagement was unsupported by substantial evidence. *Pro-Football, Inc. v. Harjo*, 284 F. Supp. 2d 96 (D.D.C. 2003). This appeal followed.

II.

An equitable doctrine, "[l]aches is founded on the notion that equity aids the vigilant and not those who slumber on theirrights." *NAACP v. NAACP Legal Def. & Educ. Fund, Inc.*, 753 F.2d 131, 137 (D.C. Cir. 1985). This defense, which Pro-Football has the burden of proving, *see Gull Airborne Instruments, Inc. v. Weinberger*, 694 F.2d 838, 843 (D.C. Cir. 1982), "requires proof of (1) lack of diligence by the party against whom the defense is asserted, and (2) prejudice to the party asserting the defense." *Nat'l R.R. Passenger Corp. v. Morgan*, 536 U.S. 101, 121-22 (2002) (internal quotation marks omitted). In this case, the Native Americans contend both that the statute bars the defense of laches and that even were laches an available defense, Pro-Football has failed to prove it.

The Native Americans' statutory argument runs as follows: because section 1064(3) permits petitions alleging wrongful registration under section 1052(a) to be filed "[a]t any time," laches is not a valid defense in cancellation proceedings. We disagree. The words "[a]t any time" demonstrate only that the act imposes no statute of limitations for bringing petitions. Those words have nothing to do with what equitable defenses may be available during cancellation proceedings. Indeed, under the Native Americans' logic, equitable defenses would never be available as long as cancellation petitions are brought within the specified statute of limitations—"[a]t any time" for petitions alleging wrongful registration under section 1052(a) or certain other grounds, *see* 15 U.S.C. § 1064(3)-(5), and "[w]ithin five years" of registration for petitions

brought for all other reasons, *see id.* § 1064(1). This would make section 1069, which explicitly permits consideration of laches and other equitable doctrines, meaningless as to cancellation petitions. For this reason, we disagree with the Third Circuit's suggestion that laches is not an available defense to cancellation petitions brought pursuant to section 1064(3), *see Marshak v. Treadwell*, 240 F.3d 184, 193-94 & n.4 (3d Cir. 2001). Instead, we join the Federal Circuit, *see Bridgestone/Firestone Research, Inc. v. Auto. Club de L'Ouest de la France*, 245 F.3d 1359, 1360-61 (Fed. Cir. 2001) (permitting the defense of laches to a cancellation petition brought under section 1064(3)), and our own district court, *see Pro-Football, Inc. v. Harjo*, 57 U.S.P.Q.2d 1140, 1145 (D.D.C. 2000), in concluding that the statute does not bar the equitable defense of laches in response to section 1064(3) cancellation petitions.

The Native Americans also offer several reasons why, in their view, the district court erred in its assessment of laches in this case. At this point, we need only consider one: their claim that the district court mistakenly started the clock for assessing laches in 1967 –the time of the first mark's registration—for *all* seven Native Americans, even though one, Mateo Romero, was at that time only one year old.

We agree with the Native Americans that this approach runs counter to the well-established principle of equity that laches runs only from the time a party has reached his majority. The Supreme Court first embraced this principle in 1792, holding in a case dealing with conflicting 1761 land grants that "*laches* cannot . . . be imputed" as the "rights do

not seem to have been abandoned; for in 1761, the children were infants, and were hardly of age, when this action was brought." *Gander's Lessee v. Burns*, 4 U.S. (4 Dall.) 122 (1792). The Court has since held to this principle. *See Hoyt v. Sprague*, 103 U.S. 613, 636-37 (1880) (evaluating laches "after [complainants] came of age"); *Wetzel v. Minn. Ry. Transfer Co.*, 169 U.S. 237, 240 (1898) (acknowledging "that the minors were not affected by laches until they became of age"); *cf. Wagner v. Baird*, 48 U.S. (7 How.) 234, 242 (1849) (noting that equity makes allowances for "circumstances to account for [a party's] neglect, such as imprisonment, infancy, coverture, or by having been beyond seas"); 2 Joseph Story, *Commentaries on Equity Jurisprudence, as administered in England and America* 844 n.(b) (photo. reprint 1988) (Melville M. Bigelow, ed., 13th ed. 1886) (stating that "[i]t is not laches to wait until one is in a legal condition to sue"); William MacPherson, *A Treatise on the Law Relating to Infants* 338-39 (Philadelphia, John S. Littel 1843) (observing that "[i]t is a maxim of law that laches is not to be imputed to an infant, because he is not supposed to be cognizant of his rights, nor capable of enforcing them").

Pro-Football asserts that were we to apply this principle here, it "would logically mean that trademark owners could never have certainty, since a disparagement claim could be brought by an as yet unborn claimant for an unlimited time after a mark is registered." Appellee's Br. at 48. At the least, this assertion is overstated—only owners of those trademarks that may disparage a population that gains new members (as opposed to one that disparages, say, a single corporate entity, *see, e.g.*,

Greyhound Corp. v. Both Worlds Inc., 6 U.S.P.Q.2d 1635 (TTAB 1988)), would face such a prospect. But even if registrations of some marks would remain perpetually at risk, it is unclear why this fact authorizes—let alone requires—abandonment of equity's fundamental principle that laches attaches only to parties who have unjustifiably delayed in bringing suit. Pro-Football forgets that "laches is not, like limitation, a mere matter of time," *Holmberg v. Armbrecht*, 327 U.S. 392, 396 (1946) (internal quotation marks omitted), but rather turns on whether the party seeking relief "delayed inexcusably or unreasonably in filing suit" in a way that was "prejudicial" to the other party, *Rozen v. District of Columbia*, 702 F.2d 1202, 1203 (D.C. Cir. 1983) (per curiam). Why should equity give more favorable treatment to parties that harm expanding numbers of people (in which case, under Pro-Football's theory, laches runs from the date of harm) than it gives to parties that harm only a few people (in which case laches runs from whenever those people are free of legal disabilities)? Why should equity elevate Pro-Football's perpetual security in the unlawful registration of a trademark over the interest of a Native American who challenged this registration without lack of diligence? Why should laches bar *all* Native Americans from challenging Pro-Football's "Redskins" trademark registrations because *some* Native Americans may have slept on their rights?

The fact that Pro-Football may never have security in its trademark registrations stems from Congress's decision not to set a statute of limitations and instead to authorize petitions for cancellation based on disparagement "[a]t any time." *See* 15

U.S.C. § 1064(3). Congress knew perfectly well how to set statutes of limitations—as noted earlier, it required that petitions for cancellations on many other grounds be brought "[w]ithin five years" of registration, *id.* § 1064(1)—but consciously declined to do so with respect to cancellation petitions based on disparagement. Indeed, Congress may well have denied companies the benefit of a statute of limitations for potentially disparaging trademarks for the very purpose of discouraging the use of such marks. *See id.* § 1065 (providing that marks "shall be incontestable" after five years "*[e]xcept* on a ground for which application to cancel may be filed at any time under paragraphs (3) and (5) of section 1064" (emphasis added)); *cf. In re Riverbank Canning Co.*, 95 F.2d 327, 329 (C.C.P.A. 1938) (noting that the "field is almost limitless from which to select words for use as trade-marks, and one who uses debatable marks does so at the peril that his mark may not be entitled to registration").

Here, Romero has brought his own claim, and there is no reason why the laches of others should be imputed to him. In accordance with the context-specific approach required by equity, the district court should have measured both his delay and the resulting prejudice to Pro-Football based on the period between his attainment of majority and the filing of the 1992 cancellation petition.

For several reasons, we prefer not to undertake our own analysis of Romero's laches. The district court never addressed this issue, the parties have briefed it minimally at best, and, most significantly, we may owe deference to the district court's assessment of laches. *Compare Daingerfield*

Island Protective Soc'y v. Lujan, 920 F.2d 32, 38 (D.C. Cir. 1990) (conducting abuse-of-discretion evaluation of laches in reviewing a district court's summary judgment ruling), *with CarrAmerica Realty Corp. v. Kaidanow*, 321 F.3d 165, 172 (D.C. Cir. 2003) (conducting de novo evaluation of laches in reviewing a district court's summary judgment ruling). Therefore, we shall remand the record for the district court to evaluate Romero's laches.

In assessing prejudice, the district court should address both trial and economic prejudice. As to trial prejudice, the court should consider the extent to which Romero's post-majority delay resulted in a "loss of evidence or witnesses supporting [Pro-Football's] position," *see Gull Airborne Instruments*, 694 F.2d at 844. As to economic prejudice, we express no view as to how such prejudice should be measured where, as here, what is at stake is not the trademark owner's right to use the marks but rather the owner's right to Lanham Act protections that turn on registration. We encourage the district court to take briefing on whether economic prejudice should be measured based on the owner's investment in the marks during the relevant years, on whether the owner would have taken a different course of action—e.g., abandoned the marks—had the petitioner acted more diligently in seeking cancellation, or on some other measure.

III.

While retaining jurisdiction over the case, we remand the record to the district court for the

purpose of evaluating whether laches bars Mateo Romero's claim.

So ordered.

LEXSEE 567 F. SUPP. 2D 46

PRO-FOOTBALL, INC., Plaintiff, v. SUZAN SHOWN HARJO, et al., Defendants.

Civil Action No. 99-1385 (CKK)

UNITED STATES DISTRICT COURT FOR THE DISTRICT OF COLUMBIA

567 F. Supp. 2d 46; 2008 U.S. Dist. LEXIS 52622; 87 U.S.P.Q.2D (BNA) 1891

June 25, 2008, Decided

SUBSEQUENT HISTORY: Affirmed by *Pro Football, Inc. v. Harjo, 2009 U.S. App. LEXIS 10295 (D.C. Cir., May 15, 2009)*

PRIOR HISTORY: *Pro-Football, Inc. v. Harjo, 2006 U.S. Dist. LEXIS 51086 (D.D.C., July 26, 2006)*

COUNSEL: [**1] For PRO FOOTBALL, INC., Plaintiff: Carolyn Beth Lamm, Francis A. Vasquez, Jr., LEAD ATTORNEYS, WHITE & CASE LLP, Washington, DC; Jack McKay, LEAD ATTORNEY, PILLSBURY WINTHROP SHAW PITTMAN LLP, Washington, DC; Marc E. Ackerman, LEAD ATTORNEY, WHITE & CASE, New York, NY; Robert Lloyd Raskopf, LEAD ATTORNEY, QUINN EMANUEL URQUHART OLIVER & HEDGES, LLP, New York, NY.

For SUZAN S. HARJO, RAYMOND D. APODACA, VINE DELORIA, JR., NORBERT S. HILL, JR., MATEO ROMERO, WILLIAM A. MEANS, MANLEY A. BEGAY, JR., Defendants: Brian Arthur Coleman, LEAD ATTORNEY, DRINKER BIDDLE & REATH LLP, Washington, DC; Jeffrey J. Lopez, Philip John Mause, DRINKER, BIDDLE & REATH, Washington, DC.

JUDGES: COLLEEN KOLLAR-KOTELLY, United States District Judge.

OPINION BY: COLLEEN KOLLAR-KOTELLY

OPINION

[*47] **MEMORANDUM OPINION**

This case began in 1992, when seven Native Americans ("Defendants") petitioned the Trademark Trial and Appeal Board ("TTAB") to cancel the registrations of six trademarks used by the Washington Redskins, a longtime professional football franchise, and owned by Plaintiff Pro-Football, Inc. ("Pro-Football"). After the TTAB granted Defendants' petition, Pro-Football brought this action, seeking to reverse the TTAB's decision. On September [**2] 30, 2003, this Court issued a Memorandum Opinion and Order granting summary judgment to Pro-Football on alternative grounds: first, that the TTAB's cancellation decision was not supported by substantial evidence, and second, that Defendants' [*48] suit was barred by laches. *See generally, Pro-Football, Inc. v. Harjo, 284 F. Supp. 2d 96 (D.D.C. 2003)* ("*Harjo* Summ. J. Op."). Defendants appealed that decision to the United States Court of Appeals for the District of Columbia Circuit, and on July 15, 2005, "[w]hile retaining jurisdiction over the case, [the D.C. Circuit] remand[ed] the record to [this Court] for the purpose of evaluating whether laches bars [Defendant] Mateo Romero's claim." *See Pro-Football, Inc. v. Harjo, 367 U.S. App. D.C. 276, 415 F.3d 44, 50 (D.C. Cir. 2005)* ("*Harjo* Appeal"). The D.C. Circuit did not address nor reach this Court's conclusion that the TTAB's cancellation decision was not supported by substantial evidence, or its finding of laches as to the other Defendants.

Following remand, the parties briefed renewed cross-motions for summary judgment, which are currently pending before the Court. In reviewing

those cross-motions, cognizant of the explicitly narrow nature of the remand in this [**3] case, the Court concludes that it lacks jurisdiction to--and therefore declines to--reconsider any factual and legal rulings contained in its September 30, 2003 Memorandum Opinion that are not specifically implicated by the D.C. Circuit's remand. The Court has thoroughly considered the parties' briefs in connection with their renewed cross-motions for summary judgment as well as the exhibits attached thereto, and concludes that Defendant Romero's claim is barred by laches. The Court shall therefore GRANT Plaintiff Pro-Football's [117] Motion for Summary Judgment and DENY Defendants' [112] Cross-Motion for Summary Judgment on the issue of the applicability of laches to Defendant Mateo Romero's claim. In so doing, the Court again reiterates-as it did in its September 30, 2003 Memorandum Opinion-that this "opinion should not be read as [] making any statement on the appropriateness of Native American imagery for team names." *Harjo Summ. J. Op., 284 F. Supp. 2d at 144-45.*

I: BACKGROUND

A. Factual and Procedural History of This Case

The factual and procedural history of this action is extensively discussed in the Court's September 30, 2003 Memorandum Opinion, *see generally Harjo Summ. J. Op., 284 F. Supp. 2d 96,* [**4] as well as the D.C. Circuit's remand opinion, *Harjo Appeal, 367 U.S. App. D.C. 276, 415 F.3d 44,* and this Court's July 26, 2006 Memorandum Opinion denying

Defendants' motion to conduct additional discovery on remand, *see Pro-Football, Inc. v. Harjo, Civ. A. No. 99-1385, 2006 U.S. Dist. LEXIS 51086, 2006 WL2092637 (D.D.C. Jul. 26, 2006)* ("*Harjo* Discovery Op."). The Court therefore assumes familiarity with those opinions, and repeats herein only such facts as are necessary to resolve the pending cross-motions for summary judgment.

Pro-Football, Plaintiff in the current action and Respondent in the trademark action before the TTAB, holds six trademarks containing the word, or a derivative of the word, "redskin(s)" that are registered with the Patent and Trademark Office ("PTO"). [1] In September 1992, seven Native Americans--Suzan Shown Harjo, Raymond D. Apodaca, Vine Deloria, Jr., Norbert S. Hill, Jr., Mateo Romero, William A. Means, and Manley A. Begay, Jr.--collectively petitioned the TTAB to cancel the six trademarks, arguing that the use of the word "redskin(s)" is "scandalous," [*49] "may . . . disparage" Native Americans, and may cast Native Americans into "contempt, or disrepute" in violation of *Section 2(a)* of the Lanham Trademark Act of [**5] 1946 ("Lanham Act"). Compl. P 13 (citing *15 U.S.C. § 1052(a)*). In a pretrial order issued in March of 1994, the TTAB struck all defenses raised by Pro-Football. *Harjo v. Pro-Football, Inc.*, 30 U.S.P.Q.2d 1828, 1833, 1994 WL 262249 (Trademark Tr. & App. Bd. 1994). The TTAB dismissed Pro-Football's constitutional defenses based on a determination that assessing the constitutionality of a statute is "beyond the Board's authority." *Id.* The TTAB also held that the laches defense advanced by Pro-Football was unavailing because Defendants

advocated on behalf of a broad public interest while Pro-Football's interests were distinctly private. *Id.* at 1831, 1994 WL 262249.

> 1 The first of these trademarks, "'The Redskins' written in a stylized script-was registered in 1967, three more in 1974, another in 1978, and the sixth-the word 'Redskinettes'-in 1990." *Harjo Appeal, 415 F.3d at 46.* The Redskins started using the "Redskinettes" mark in commerce in connection with its cheerleaders in or about 1962. *Harjo Summ. J. Op., 284 F. Supp. 2d at 105.*

On April 2, 1999--five years after issuing its pretrial order--the TTAB issued a cancellation order in which it scheduled the cancellation of the six contested [**6] "redskin(s)" trademarks. *Harjo v. Pro-Football, Inc.*, 50 U.S.P.Q.2d at 1748, 1999 WL 375907. The TTAB concluded that the trademarks "may be disparaging of Native Americans to a substantial composite of this group of people," and "may bring Native Americans into contempt or disrepute." *Id.* Thereafter, on June 1, 1999, Pro-Football filed its Complaint in this action, seeking "*de novo* review, pursuant to *15 U.S.C. § 1071(b)*, of [the TTAB's] unprecedented administrative decision." Compl. P 1. Following a period in which Defendants filed a motion to dismiss certain claims, which was denied by this Court, *see Pro-Football v. Harjo, 57 U.S.P.Q.2d 1140, 1142-43, 2000 WL 1923326 (D.D.C. 2000)*, and a protracted period of discovery around the issue of laches, both parties filed cross-motions for summary judgment before the Court. As noted above, on September 30, 2003, this

Court issued an extensive Memorandum Opinion and Order granting Pro-Football's motion for summary judgment on alternative grounds. *See Harjo generally Summ. J. Op, 284 F. Supp. 2d 96.*

As also noted above, Defendants promptly appealed that decision to the D.C. Circuit, which chose to focus solely upon the issue of laches, leaving [**7] the Court's first, and primary, holding regarding the "lack of substantial evidence" for another day. *See Harjo Appeal, 415 F.3d at 47-50.* The D.C. Circuit agreed with this Court that a defense of laches was available to Pro-Football against Defendants' trademark cancellation claims. *Id. at 47-48.* The D.C. Circuit noted, however, that the doctrine of laches "runs only from the time a party has reached his majority," *see id. at 48* (citing cases), and that this Court had assessed laches as to all Defendants beginning in 1967, the time of the first mark's registration. *Id.* Therefore, "[w]hile retaining jurisdiction over the case," the D.C. Circuit remanded the record to this Court to "address both trial and economic prejudice" with respect to the claim of Defendant Romero, who was born in 1966 (and therefore reached the age of majority in 1984). *See id. at 48-50.* The D.C. Circuit instructed that "[i]n accordance with the context-specific approach required by equity, the district court should have measured both [Defendant Romero's] delay and the resulting prejudice to Pro-Football based on the period between his attainment of majority and the filing of the 1992 cancellation petition [before [**8] the TTAB]." *Id. at 49-50.* [2] The D.C. Circuit further encouraged this Court, on remand, "to take briefing on whether economic prejudice should be measured

based on [Pro-Football's] investment [*50] in the marks during the relevant years, on whether [Pro-Football] would have taken a different course of action--e.g., abandoned the marks--had the petitioner acted more diligently in seeking cancellation, or on some other measure." *Id. at 50.*

> 2 The Court shall refer to the period of time between Defendant Romero's majority on December 9, 1984 and Defendants' filing of the cancellation petition on September 10, 1992 as the "Romero Delay Period."

Rather than brief the laches issue, Defendants filed a Motion to Conduct Limited Discovery Related to Laches. The Court issued a Memorandum Opinion and Order denying that motion, and setting forth some considerations relevant to the laches evaluation on remand. *See generally Harjo Discovery Op., 2006 U.S. Dist. LEXIS 51086, 2006 WL 2092637.* Thereafter, Pro-Football filed its Memorandum of Points and Authorities in Further Support of its Motion for Summary Judgment (hereinafter "Pro-Football MSJ"), and Defendants filed their renewed Motion for Summary Judgment and Opposition to Pro-Football's [**9] Motion (hereinafter "Defs.' Cross-MSJ"). [3] Pro-Football filed its combined Reply in support of its own Motion for Summary Judgment and Opposition to Defendants' Cross-Motion (hereinafter "Pro-Football Reply"), and Defendants filed their Reply in support of their Cross-Motion for Summary Judgment. Accordingly, the parties' renewed cross-motions for summary judgment are ripe for review.

3 In their Cross-Motion for Summary Judgment/Opposition, Defendants suggest that the Court find Pro-Football's Motion for Summary Judgment "procedurally defective" because it is not accompanied by a Local Rule 7.1(h) Statement of Material Facts. *See* Defs.' Cross-MSJ at 2 n.1. Defendants' suggestion is misplaced because the parties' summary judgment briefing on remand essentially amounts to supplemental briefing on their original cross-motions for summary judgment, necessitated by the D.C. Circuit's instructions on remand, rather than new cross-motions for summary judgment. The Court therefore does not find procedural defect in Pro-Football's failure to provide a new Local Rule 7.1(h) Statement. Moreover, it does not appear that a new Local Rule 7.1(h) Statement is necessary to resolve the parties' cross-motions [**10] for summary judgment for two reasons. First, although Pro-Football's renewed Motion for Summary Judgment includes factual assertions regarding Pro-Football's various expenditures during the Romero Delay Period, it explains that the calculations behind those figures are based on the methods described in Pro-Football's original Local Rule 7.1(h) Statement, and attaches a copy of that Statement to its Memorandum. *See, e.g.*, Pro-Football MSJ at 13 & ns. 9-10. Second, Defendants do not contest Pro-Football's factual claims regarding its expenditures during the Romero Delay Period, but rather argue that those expenditures are not sufficient, as a matter of law, to demonstrate that Pro-Football suffered

economic prejudice as a result of Defendant Romero's delay. As such, no Local Rule 7.1(h) Statement is required in order to "isolate[] the facts that the parties assert are material, distinguish[] disputed from undisputed facts, and identif[y] the pertinent parts of the record." *Jackson v. Finnegan, Henderson, Farabow, Garrett & Dunner, 322 U.S. App. D.C. 35, 101 F.3d 145, 150 (D.C. Cir. 1996)* (quoting *Gardels v. CIA, 637 F.2d 770, 773 (D.C. Cir. 1980)).*

For its part, Pro-Football argues that this Court should not [**11] consider the new factual submissions that Defendants proffer in support of their renewed Cross-Motion for Summary Judgment, and specifically argues that the Court should strike certain portions of the Declaration of Philip J. Mause submitted by Defendants. *See* Pro-Football Reply at 19-21. Defendants oppose Pro-Football's requests. *See* Defs.' Reply at 7-8. The Court declines to address Pro-Football's requests because the Court's resolution of the parties' cross-motions for summary judgment does not require reliance upon the information contained in Defendants' additional factual submissions (including Mr. Mause's Declaration).

B. The Parties' Factual Assertions Regarding Defendant Romero's Laches

As was the case as of the Court's September 30, 2003 Memorandum Opinion, [*51] there is no dispute that Defendant Romero was aware of the Washington Redskins team name and the name of the cheerleaders prior to reaching the age of

majority in December 1984. *See Harjo Summ. J. Op., 284 F. Supp. 2d at 112.* Indeed "Mr. Romero, born in 1966, saw Redskins games on television as a child as well as the Redskinettes cheerleaders." *Id.* "It is also undisputed that Defendants did not file their petition to cancel [**12] the registrations of the trademarks until September 10, 1992." *Id.* Finally, "it is also undisputed that . . . Pro-Football and NFL Properties invested in the trademarks and had increasing revenues during the [Romero Delay Period]." *Id.* In particular, Defendants do not contest Pro-Football's assertions that:

> . Its list of merchandise licensees nearly tripled (from just over 100 to more than 300) between September 1985 and the end of the Romero Delay Period. *See* Pro-Football MSJ at 13 (citing original Rule 7.1(h) Stmt (Ex. A to the 10/20/06 Decl. of Robert L. Raskopf submitted in support of Pro-Football's MSJ) P 76 and Pl.'s App. Ex. 126).
>
> . In total, the Redskins contributed over **REDACTED** to NFL Properties' advertising and promotional expenses during the Romero Delay Period, and the Redskins' annual contribution towards advertising and promotion grew from **REDACTED** to **REDACTED** during the Romero Delay Period. *See* Pro-Football MSJ at 13.
>
> . During the Romero Delay Period, the Redskins have expended money and other resources on prosecuting the registrations

of the trademarks and enforcing them against third party infringement and dilution. *Id.* (citing 7.1(h) Stmt. P 71). This has included filing [**13] and renewing the trademarks, responding to office actions from the PTO, drafting cease and desist letters, conducting litigations, and seizing counterfeit goods. *Id.*

. The Redskins have developed goodwill in the trademarks, which was valued at more than **REDACTED** in the Redskins' financial statement for the period ending March 31, 2001. *Id.* at 12-13 n. 8 (citing 7.1(h) Stmt. P 257). Further, a third party valued the goodwill at **REDACTED** in February 2001. *Id.* (citing 7.1(h) Stmt. P 258). In addition, during the Romero Delay Period, the Redskins received revenue in excess of **REDACTED,** and the annual team revenue increased from **REDACTED** in 1984 to **REDACTED** in 1990. *Id.* at 14 (citing 7.1(h) Stmt. P 81).

II: LEGAL STANDARDS

A party is entitled to summary judgment if the pleadings, depositions, and affidavits demonstrate that there is no genuine issue of material fact in dispute and that the moving party is entitled to judgment as a matter of law. *See Fed. R. Civ. P.*

56(c); Tao v. Freeh, 307 U.S. App. D.C. 185, 27 F.3d 635, 638 (D.C. Cir. 1994). In particular, in ruling on cross-motions for summary judgment, the court may grant summary judgment only if one of the moving parties is entitled to judgment as a matter of [**14] law upon material facts that are not genuinely disputed. *See Rhoads v. McFerran, 517 F.2d 66, 67 (2d Cir. 1975); Long v. Gaines, 167 F. Supp. 2d 75, 85 (D.D.C. 2001).* More generally, under the summary judgment standard, the moving party, "bears the initial responsibility of informing the district court of the basis for its motion, and identifying those portions of 'the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any' which it believes demonstrate the absence of a genuine issue of material fact." *Celotex* [*52] *Corp. v. Catrett, 477 U.S. 317, 323, 106 S. Ct. 2548, 91 L. Ed. 2d 265 (1986).* In response, the nonmoving party must "go beyond the pleadings and by [its] own affidavits, or by the 'depositions, answers to interrogatories, and admissions on file,' designate 'specific facts showing that there is a genuine issue for trial.'" *Id. at 324.*

Although a court should draw all inferences from the supporting records submitted by the nonmoving party, the mere existence of a factual dispute, by itself, is not sufficient to bar summary judgment. *See Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 247-48, 106 S. Ct. 2505, 91 L. Ed. 2d 202 (1986).* To be material, the factual assertion must be capable of affecting [**15] the substantive outcome of the litigation; to be genuine, the issue must be supported by sufficient admissible evidence that a reasonable

trier-of-fact could find for the nonmoving party. *Laningham v. U.S. Navy, 259 U.S. App. D.C. 115, 813 F.2d 1236, 1242-43 (D.C. Cir. 1987)*; *Liberty Lobby, 477 U.S. at 251-52*, (the court must determine "whether the evidence presents a sufficient disagreement to require submission to a jury or whether it is so one-sided that one party must prevail as a matter of law"). "If the evidence is merely colorable, or is not sufficiently probative, summary judgment may be granted." *Liberty Lobby, 477 U.S. at 249-50* (internal citations omitted).

III: DISCUSSION

The Court makes a few initial observations before turning to the merits of the parties' pending cross-motions for summary judgment. First, the Court's consideration of those motions is significantly cabined by the very limited nature of the D.C. Circuit's remand in this case. As discussed above, the D.C. Circuit concluded that this Court's September 30, 2003 Memorandum Opinion measured Defendant Romero's laches using the wrong delay period, and declined to undertake the analysis of Defendant Romero's laches in the first instance. [**16] *Harjo Appeal, 415 F.3d at 50.* Instead, the D.C. Circuit remanded the record to this Court for an "evaluation" of Defendant Romero's laches, while retaining jurisdiction over the case. *Id.* As a result, this Court concludes that it lacks jurisdiction to revisit its previous factual findings and legal conclusions that are not directly implicated by its evaluation of Defendant Romero's laches. Furthermore, the D.C. Circuit did not consider this Court's conclusion that the TTAB's cancellation

decision lacked substantial evidence or that the other Defendants' claims are barred by laches, and did not provide any indication that it believed those conclusions to be in error. Therefore, even if this Court had jurisdiction to consider issues beyond Defendant Romero's laches, the D.C. Circuit's remand opinion offers no reason for this Court to revisit its prior findings at this time.

This Court also declines to revisit issues (beyond the applicability of laches to Defendant Romero's claim) that were resolved in the Court's September 30, 2003 Memorandum Opinion granting summary judgment to Pro-Football and its July 26, 2006 Memorandum Opinion denying Defendants' motion to conduct discovery on remand. [**17] This is appropriate in light of the law of the case doctrine, which provides that "[w]here issues have been resolved at a prior state in the litigation, based upon principles of judicial economy, courts generally decline to revisit [them]." *New York v. Microsoft, 209 F. Supp. 2d 132, 141 (D.D.C. 2002)*. The law of the case doctrine "bars reconsideration of a court's explicit decisions [in earlier phases of a case] as well as those issues decided by necessary implication." *Id.* (citing *Crocker v. Piedmont Aviation, Inc., 311 U.S. App. D.C. 1, 49 F.3d 735, 739* [*53] *(D.C. Cir. 1995)*; *LaShawn A. v. Barry, 318 U.S. App. D.C. 380, 87 F.3d 1389, 1394 (D.C. Cir. 1996)* (en banc)). As such, unless required by the D.C. Circuit's remand, the Court does not revisit herein the issues resolved in its previous opinions.

Finally, the Court also notes at the outset that its finding that Defendants' claims are barred by laches was an alternative holding to its conclusion that the

TTAB's cancellation decision was not supported by substantial evidence. That primary holding was not reached by the D.C. Circuit on appeal, and represents this Court's resolution of the underlying issue of disparagement. As a result, it would be entirely inappropriate for the Court [**18] to--as Defendants suggest--"exercise its discretion to deny the defense" of laches in order to allow "the underlying issue of disparagement" to be resolved in this case. *See* Defs' Cross-MSJ at 24. The Court nevertheless reiterates that its primary holding regarding disparagement was not intended to "mak[e] any statement on the appropriateness of Native American imagery for team names." *Harjo Summ. J. Op., 284 F. Supp. 2d at 144-45*

Having addressed all of these initial considerations, the Court turns to the task before it: evaluating Defendant Romero's laches within the context of the parties' renewed cross-motions for summary judgment.

A. The Elements of Laches

As the D.C. Circuit explained, laches is an equitable doctrine "founded on the notion that equity aids the vigilant and not those who slumber on their rights." *Harjo Appeal, 415 F.3d at 47* (quoting *NAACP v. NAACP Legal Def. & Educ. Fund, Inc., 243 U.S. App. D.C. 313, 753 F.2d 131, 137 (D.C. Cir. 1985)).* Laches "is designed to promote diligence and prevent enforcement of stale claims." *Gull Airborne Instruments, Inc. v. Weinberger, 224 U.S. App. D.C. 272, 694 F.2d 838 (D.C. Cir. 1982)* (citing *Powell v. Zuckert, 125 U.S. App. D.C. 55, 366 F.2d 634, 636 (D.C. Cir. 1966)).* Pro-Football has the burden [**19]

of proving the defense of laches, *id.*, which "requires proof of (1) lack of diligence by the party against whom the defense is asserted, and (2) prejudice to the party asserting the defense," *Harjo Appeal, 415 F.3d at 47* (quoting *Nat'l R.R. Passenger Corp. v. Morgan, 536 U.S. 101, 121-22, 122 S. Ct. 2061, 153 L. Ed. 2d 106 (2002)).* [4] In turn, as the D.C. Circuit noted in remanding the record to this Court, prejudice to the party asserting laches may arise from either trial prejudice or economic prejudice. *Harjo Appeal, 415 F.3d at 50.*

> 4 The Court's September 30, 2003 Memorandum Opinion specifically noted that the two-prong test articulated by the D.C. Circuit in the *Harjo Appeal (and by the Federal Circuit in Bridgestone/Firestone Research, Inc. v. Automobile Club de L'Ouest de la France, 245 F.3d 1359 (Fed. Cir. 2001))* is fundamentally similar to the three-prong test applied in *NAACP* and in this Court's September 30, 2003 Memorandum Opinion granting summary judgment to Pro-Football. As the Court explained:
>
> > Essentially, to demonstrate laches Pro-Football must show that Defendants' delay in bringing the cancellation proceeding was unreasonable, and that prejudice to Pro-Football resulted from the delay. *Bridgestone, 245 F.3d at 1361*; [**20] [*Hot Wax, Inc. v. Turtle Wax, Inc., 191 F.3d 813, 820 (7th Cir. 1999)].* This test is not materially

> different from the standard articulated in *NAACP*. The first two steps of the *NAACP* test, substantial delay and notice, form the unreasonable delay prong of the *Bridgestone* case. Finally, the third step of the *NAACP* test, development of goodwill during the period of delay, is the prejudice element in the *Bridgestone* case.

Harjo Summ. J. Op., 284 F. Supp. 2d at 139.

B. Defendant Romero's Delay Demonstrates a Lack of Diligence

As noted above, Defendant Romero waited almost eight years--seven years, [*54] nine months, to be precise--after reaching the age of majority before petitioning to cancel the six trademarks in question. [5] That delay is "unusually long by any standard." *See Peshlakai v. Duncan, 476 F. Supp. 1247, 1256 (D.D.C. 1979)* (describing seven-year period of delay in bringing action under the National Environmental Policy Act). Pro-Football correctly notes that "the Romero Delay Period is similar to or longer than the delay in other trademark cases in which courts have applied the laches doctrine." Pro-Football MSJ at 4 (citing [**21] *Eppendorf-Netheler-Hinz GmBH v. Nat'l Scientific Supply Co., 14 Fed. Appx. 102, 2001 WL 798844, at *2, 3 (2d Cir. 2001)* (eight-year delay); *Hubbard Feeds, Inc. v. Animal Feed Supplement, Inc., 182 F.3d 598, 602 n.5 (8th Cir. 1999)* (delay of "over four years"); *Brittingham v.*

Jenkins, 914 F.2d 447, 456 (4th Cir. 1990) (eight-year delay); *Landers, Frary & Clark v. Universal Cooler Corp., 85 F.2d 46, 49 (2d Cir. 1936)* (eight-year delay) (L. Hand, J.)). Likewise, outside the trademark infringement context, courts in this Circuit have found laches when faced with similar periods of delay. Pro-Football MSJ at 5 (citing, *inter alia, CarrAmerica Realty Corp. v. Kaidanow, 355 U.S. App. D.C. 180, 321 F.3d 165, 171-72 (D.C. Cir. 2003)* (two-year delay in action brought by minority shareholders); *Jeanblanc v. Oliver Carr Co., No. 94-7118, 62 F.3d 424,* [published in full-text format at *1995 U.S. App. LEXIS 19995], 1995 WL 418667, at *4 (D.C. Cir. June 21, 1995)* (almost eight-year delay in breach of partnership/fiduciary duties action)).

> 5 Defendants argue in their Cross-Motion for Summary Judgment that "the [**22] delay period must be calculated differently for the registration of Pro Football's 'Redskinettes' trademark without consideration of the other marks or the length of time the mark 'Redskinettes' had been in use prior to its registration," because Defendant Romero "had no legal cause of action as to the 'Redskinettes' trademark until it was registered" in 1990. Defs' Cross-MSJ at 22-24. The Court already addressed and rejected these arguments in its September 30, 2003 Memorandum Opinion. *See Harjo Summ. J. Op., 284 F. Supp. 2d at 140.* In particular, the Court noted that Defendants' claim regarding the "Redskinettes" mark is grounded in their claims regarding the other five marks, which were registered long before 1990, and that the TTAB recognized as much

> during the cancellation proceeding, concluding that Defendants' "arguments and extensive evidence pertain almost entirely to the 'Redskins' portion of [Pro-Football's] marks." *Id.* Further, the Court "explained that the context of this case is different from many other trademark cases" because "the Washington Redskins cheerleaders have been using the term 'REDSKINETTES' since 1962 . . . this is not a case where the mark was introduced [**23] in 1990; rather it had been use for approximately thirty years at the point the Defendants brought their cancellation proceeding." *Id.* Indeed, it is undisputed that Defendant Romero has been aware of the Redskins cheerleaders since he was a child. Pro-Football MSJ at 4 n.3 (citing 7.1(h) Stmt. P 61). Thus, even if Defendants are correct that Defendant Romero did not have a legal cause of action as to the "Redskinettes" mark until it was registered in 1990, they offer no reason for concluding that Defendant Romero acted reasonably in waiting two years after that registration to bring the cancellation petition. Rather, it is undisputed that Defendant Romero was aware of the Redskinettes name-as well as the other five Redskins marks--upon reaching the age of majority in 1984 and therefore could have filed the cancellation petition immediately upon the registration of the Redskinettes mark in 1990, instead of waiting until 1992 to do so.

In addition to finding that the Romero Delay Period is similar to periods that other courts have

found to evidence a lack of diligence, the Court concludes that Defendant Romero's almost eight-year delay is unreasonable in light of the undisputed facts [**24] in this case. Specifically, as the Court previously found in its September 30, 2003 Memorandum Opinion, Defendant Romero does not contest that he has been aware of the Washington Redskins team name and the name of the cheerleaders since he watched Redskins games on [*55] television as a child. *See Harjo Summ. J. Op., 284 F. Supp. 2d at 139.*; 7.1(h) Stmt. P 61. This Court's previous opinion also found "the fact that [Defendants] had knowledge of the use of the [Redskins] team name [] sufficient to supply actual knowledge of the trademarks being used in the market place." *Harjo Summ. J. Op., 284 F. Supp. 2d at 141 n.35.* The D.C. Circuit's remand opinion offers no reason to reconsider that finding, and the Court therefore declines to do so. Further, although Defendants attempt to downplay the significance of Defendant Romero's awareness of the Redskins team name during the delay period, that attempt is unavailing. Defendants argue that actual notice of the trademarks in question should not be ascribed to Defendant Romero because "[t]here is no evidence that Mateo Romero was actually aware of his right to file a petition to cancel the 'Redskins' trademarks" prior to 1992. Defs.' Cross-MSJ at 3. [**25] As the Court's previous opinion specifically stated, however, "ignorance of one's legal rights is not a reasonable excuse in a laches case." *Harjo Summ. J. Op., 284 F. Supp. 2d at 141* (citing *Jones v. United States, 6 Cl. Ct. 531, 532-33 (Cl. Ct. 1984)* ("Where laches is raised, knowledge of the law is imputed to all plaintiffs. Consequently, professed ignorance of one's

legal rights does not justify delay in filing suit.")). Thus, Defendant Romero's professed lack of "a sophisticated understanding of the law, including the Lanham Act," Defs.' Cross-MSJ at 3, is irrelevant in evaluating his diligence in pursuing the cancellation action.

In addition to finding that Defendant Romero had actual notice of the trademarks during the Romero Delay Period, the Court also finds that Defendant Romero had constructive notice of the "Redskinettes" mark during the Romero Delay Period, by virtue of its publication and registration in 1990. As this Court has previously found--and the D.C. Circuit has not challenged--"[p]ublication of the marks in the *Official Gazette* constitutes constructive notice of the applications at issue." *Harjo Summ. J. Op., 284 F. Supp. 2d at 140.* This Court has also previously [**26] concluded that it is appropriate to charge Defendants with constructive notice, even though they are not competing claimants, because they "are sophisticated individuals who are seeking to strip a corporation of the protections of federal law for its trademarks" and because their "use of the federal trademark laws would cause the same type of damage as a competitor's actions would." *Id. at 141.* Again, the D.C. Circuit's opinion provides no reason for reconsidering this conclusion, and the Court therefore rejects Defendants' attempt to reargue it. *See* Defs.' Cross-MSJ at 4 n.5.

The Court does, however, limit its finding of Defendant Romero's constructive knowledge to the "Redskinettes" mark--"[i]n accordance with the context-specific approach required by equity" in an evaluation of laches, *Harjo Appeal, 415 F.3d at 49-*

50--because Defendant Romero had not yet attained majority when the other five trademarks at issue were published and registered. *See Harjo Summ. J. Op., 284 F. Supp. 2d at 105-107* (the first five Redskins trademarks were published and registered in 1967, 1972-1974, 1976, and 1978; the "Redskinettes" mark was published and registered in 1990). While the Court therefore [**27] only charges Defendant Romero with constructive knowledge of the "Redskinettes" mark, it nevertheless notes--as this Court and the TTAB have previously--that Defendants' claim regarding the "Redskinettes" mark is grounded in their claims regarding the other five marks. *Harjo Summ. J. Op., 284 F. Supp. 2d at 140* (citing TTAB finding that Defendants' "arguments and extensive [*56] evidence pertain almost entirely to the 'Redskins' portion of [Pro-Football's] marks.").

In sum, the Court concludes that Defendant Romero's delay was undue, in light of his actual knowledge of all of the trademarks before he reached majority and during the seven year and nine months Romero Delay Period, his constructive knowledge of the Redskinettes mark (as to which his claim is derivative of his claims regarding the other Redskins marks), and the fact that he has no reasonable excuse for his delay in taking action. *See id. at 141-42* (quoting *Bridgestone, 245 F.3d at 1361* ("To prevail on its affirmative defense, Bridgestone was required to establish that there was undue or unreasonable delay . . .")). The Court therefore finds that Pro-Football has established a lack of diligence on Defendant Romero's part with [**28] respect to pursuing his cancellation petition.

C. Pro-Football Has Established Prejudice

With respect to the second prong of the laches analysis, the D.C. Circuit instructed that on remand, this Court "should assess both trial and economic prejudice" to Pro-Football during the Romero Delay Period. *Harjo Appeal, 415 F.3d at 50*. The Court of Appeals did not offer any specific guidance as to the quantum of prejudice that Pro-Football must show, and Pro-Football argues that it "need only show a modicum of prejudice to show laches, in light of Romero's eight-year delay." Pro-Football MSJ at 7-8. [6] While Defendants protest that assertion, *see* Defs.' Cross-MSJ at 11 n.6, Pro-Football is correct that "laches is a question of degree." *Hot Wax, 191 F.3d at 824*. Indeed, as the D.C. Circuit explained in *Gull Airborne* (upon which Defendants rely extensively in their Cross-Motion for Summary Judgment, *see* Defs' Cross-MSJ at 3, 5, 13, 16, 18, 19), "[i]f only a short period of time elapses between accrual of the claim and suit, the magnitude of prejudice required before suit would be barred is great; if the delay is lengthy, a lesser showing of prejudice is required." *694 F.2d at 843* (citations omitted). [**29]

> 6 Pro-Football also argues that it may be entitled to a "presumption" of prejudice based solely on Defendant Romero's "substantial eight-year delay." Pro-Football MSJ at 7-8 (citing *NAACP, 753 F.2d at 139*). *NAACP*, however, involved a delay of "almost thirteen years without any clear reservation of rights," where the party asserting the laches defense had previously threatened to sue but instead

> "continued as a client" of the other party and "did not protest" the trademark use at issue in the case. *753 F.2d at 139*. As the facts of *NAACP* are easily distinguished from the instant case, *NAACP* does not establish that Pro-Football is entitled to a presumption of prejudice in this case.

1. Pro-Football Has Demonstrated Trial Prejudice

The D.C. Circuit specifically instructed that, on remand, "[a]s to trial prejudice, the court should consider the extent to which Romero's post-majority delay resulted in a 'loss of evidence or witnesses supporting [Pro-Football's] position.'" *Harjo Appeal, 415 F.3d at 50* (quoting *Gull Airborne, 694 F.2d at 844*). Pro-Football asserts that the Romero Delay Period has caused substantial losses of both witnesses and evidence supporting its position.

First, and quite [**30] significantly, Pro-Football notes that Edward Bennett Williams, the President of the Redskins from 1965 to 1980 (when five of the six trademarks at issue were originally registered), died during the Romero Delay Period, on August 13, 1988. Pro-Football MSJ at 8. Pro-Football argues that the loss of Mr. Williams' testimony during the cancellation [*57] proceeding before the TTAB constitutes significant trial prejudice because his "testimony or recollections could have been particularly important to the Redskins' defense on the issue of alleged disparagement in the relevant time frame." *Id.* at 8-9. Pro-Football specifically notes that Mr. Williams "received a letter from and met with a group of purported representatives of Native Americans concerning the 'Redskins' name in

1972." *Id.* For their part, Defendants contest the significance of Mr. Williams' testimony regarding this meeting, arguing that it is of marginal relevance because the only relevant evidence with respect to the disparagement issue is the opinions of Native Americans. Defs.' MSJ at 7-8; Defs.' Reply at 5-6. The 1972 meeting, however, is only one example of what Mr. Williams might have been able to testify to during the TTAB [**31] proceeding if Defendant Romero had brought his cancellation petition upon reaching the age of majority in 1984, i.e., while Mr. Williams was still alive. Mr. Williams may very well have had other interactions with Native Americans that would have provided contemporaneous evidence of their opinions of the Redskins name (as opposed to the reconstructed, after-the-fact survey evidence proffered by Defendants, discussed below). Further, Mr. Williams would likely have been able to shed some light on whether the Redskins might have changed their name during the Romero Delay Period if the cancellation petition had been brought earlier, an issue that, as discussed below, Defendants stress. In short, as Pro-Football convincingly argues "because Mr. Williams died before the cancellation petition itself, it is impossible for the Redskins to know what Mr. Williams would have said about the allegedly disparaging nature of the marks when registered." Pro-Football Reply at 7. While the Court does not conclude that the loss of Mr. Williams' testimony, alone, would establish prejudice to Pro-Football as a result of Defendant Romero's delay, it is certainly a source of relevant evidence that has become [**32] unavailable due to the passage of time.

Next, Pro-Football argues that it has suffered trial prejudice as a result of Defendant Romero's delay because that delay "served to exacerbate the problems inherent in trying to construct methodologically valid surveys of relevant persons' attitudes concerning the Redskins Marks in 1967," the central issue underlying Defendants' cancellation petition. Pro-Football MSJ at 9. In response, Defendants argue that Pro-Football cannot establish prejudice by arguing that Defendants could have obtained additional evidence but for the delay. Defs.' Reply at 6. Pro-Football is undoubtably correct, however, that "by adding eight additional years to the other defendants' long delay, Romero further increased the time elapsed between the initial registrations and the date on which a survey of attitudes at the time of registration took place." Pro-Football Reply at 10. If Defendant Romero had filed his cancellation petition when he reached majority in 1984, he would have been able to collect evidence of attitudes prevailing in the mid-1960s that was twelve years less removed, and likely more reliable, than the evidence he and his co-Defendants eventually captured [**33] with their 1996 survey. As this Court recognized in its September 30, 2003 Memorandum Opinion, "defending this lawsuit against evidence that, due to the twenty-five year delay, does not directly address the legal question at issue, would represent a hardship to Pro-Football." *Harjo Summ. J. Op., 284 F. Supp. 2d at 143 n.37.* Similarly, while the Court does not find that the impact upon the available survey evidence, alone, would establish prejudice to Pro-Football, Pro-Football is correct that defending this lawsuit [*58] against evidence that, due to Defendant Romero's

delay may be significantly less accurate, would represent a hardship to Pro-Football.

Finally, Pro-Football notes that the "undisputed record reflects that the Redskins Club is missing financial records from 1988 and 1991-1992 (as well as from periods before the Romero Delay Period), and that NFL Properties is missing sponsorship lists in connection with the Redskins Marks from 1967 to 1988." Pro-Football MSJ at 8 (citing 7.1(h) Stmt P 63,65). Defendants do not dispute these claims, but rather argue that Pro-Football has not demonstrated that "these documents would be probative other than to argue economic prejudice" and further [**34] argue (without supporting case law) that Pro-Football cannot "prove trial prejudice by showing an inability to carry its burden of proving economic prejudice." Defs' Cross-MSJ at 5-7. To the contrary, although of less weight than the other claims of prejudice, the Court finds that Pro-Football may establish trial prejudice by demonstrating the loss of evidence relevant to its laches defense. If Defendants were to succeed in their effort to preclude summary judgment in favor of Pro-Football based on its laches defense, this case would proceed to a trial, where evidence regarding Pro-Football's economic prejudice during the Romero Delay Period would be critical to its ability to establish a laches defense. Indeed, as the Court previously recognized in its July 26, 2006 Memorandum Opinion regarding Defendants' motion to take discovery on remand, "it is impossible to assert trial prejudice when the evidence necessary to make the prejudice showing itself was the victim of passing time." *Harjo Discovery Op., 2006 U.S. Dist. LEXIS 51086, 2006 WL 2092637, at *7.* [7]

7 Defendants also argue that Pro-Football should not be allowed to point to the missing financial records as evidence of trial prejudice because "a plaintiff [**35] cannot use its own lack of diligence as an offensive weapon in a laches argument." Defs.' Cross-MSJ at 6 (citing *Rozen v. District of Columbia, 227 U.S. App. D.C. 14, 702 F.2d 1202, 1204 (D.C. Cir. 1983)).* As Pro-Football correctly points out, however, in *Rozen,* the District of Columbia admitted that it might have the records at issue but could not locate them, and that it might have destroyed the records after the filing of the plaintiff's discrimination claim. *See id.* In contrast, the Redskins have stated under oath that the financial records in question in this case are missing, and there is no evidence that they were destroyed after the cancellation petition was filed. Pro-Football Reply at 9; 7.1(h) Stmt. PP 62-63.

In sum, the Court finds that Pro-Football has established three forms of trial prejudice: foremost, the loss of Mr. Williams' testimony and the diminished quality of the survey evidence available, and of lesser importance, the lost financial records. Although none of these, standing alone, would necessarily convince the Court that it would be inequitable to allow Defendant Romero to enforce his claim notwithstanding his delay, when Pro-Football's trial prejudice is considered in conjunction [**36] with its economic prejudice, the Court is so convinced. The Court now continues to address that economic prejudice.

2. Pro-Football Has Established Economic Prejudice

In remanding the record to this Court to evaluate Defendant Romero's laches, the D.C. Circuit "express[ed] no view as to how [economic] prejudice should be measured where, as here, what is at stake is not the trademark owner's right to use the marks but rather the owner's right to Lanham Act protections that turn on registration." *Harjo Appeal, 415 F.3d at 50.* Instead, the D.C. Circuit "encourage[d] [this] court to take briefing on whether economic prejudice should be measured based on the [*59] owner's investment in the marks during the relevant years, on whether the owner would have taken a different course of action--e.g., abandoned the marks--had the petitioner acted more diligently in seeking cancellation, or on some other measure." *Id.* Thereafter, in its July 26, 2006 Memorandum Opinion regarding Defendants' request to take discovery on remand, the Court reiterated its previous conclusion that:

> in assessing laches in a trademark cancellation proceeding where a litigant is faced not with the loss of the use of the name, but [**37] rather the loss of the registration, "[e]conomic prejudice arises from investment in and development of the trademark, and the continued commercial use and economic promotion of a mark over a prolonged period adds weigh[t] to the evidence of prejudice."

*Harjo Discovery Op., 2006 U.S. Dist. LEXIS 51086, 2006 WL 2092637, at *4* (quoting *Bridgestone, 245 F.3d at 1363* (as cited by this Court, *see 284 F. Supp. 2d at 142*, and by the Court of Appeals, *see 415 F.3d at 48*)). The Court therefore concluded that Defendants' request to take discovery on "whether Pro-Football would have changed the Redskins' name during the Romero Delay Period, does not advance the ball at this point in the proceeding--the question whether the name would have been changed is irrelevant; rather, the question is how much investment there has been in the commercial exploitation of the mark." *Id.*

Notwithstanding this conclusion, Defendants continue to suggest that Pro-Football cannot demonstrate economic prejudice (and that they are therefore entitled to summary judgment on Pro-Football's laches defense) because "Pro-Football has failed to submit any evidence, nor has it even alleged, that it would have changed its name if a cancellation petition [**38] had been filed earlier." Defs.' Cross-MSJ at 20 (emphasis in original). The Court has previously rejected this argument, and continues to find that Pro-Football is not required to make such a showing in order to establish economic prejudice. It is true that some courts have considered, in the context of economic prejudice, the fact that "[h]ad [the plaintiff] successfully pressed its claims in a timely manner, [the defendant asserting the laches defense] certainly could have invested its time and money in other areas or simply renamed its products." *See Hot Wax, 191 F.3d at 824.* Defendants do not, however, cite any cases--nor is the Court aware of any--establishing that such a showing is a

requirement of a laches defense, as opposed to one possible means of demonstrating economic prejudice.

Moreover, *Hot Wax* involved a claim for false advertising and false promotion under the Lanham Act, rather than a trademark cancellation action. In contrast, as this Court previously found, *Bridgestone,* which involved a trademark cancellation petition, concluded that "[e]conomic prejudice arises from investment in and development of the trademark, and the continued commercial use and economic promotion [**39] of a mark over a prolonged period adds weigh[t] to the evidence of prejudice." *Bridgestone, 245 F.3d at 1363.* The Court therefore applies the standard articulated in *Bridgestone* in evaluating Pro-Football's claim of economic prejudice and shall deny Defendants' Cross-Motion for Summary Judgment to the extent that it is based upon an argument that Pro-Football cannot establish laches without showing that the Redskins would have changed the team's name. [8]

> 8 While the Court concludes that Pro-Football is not required to demonstrate that the Redskins would have changed the team's name in order to establish economic prejudice, if such a showing were required, the Redskins are correct that Mr. Williams' testimony--lost during the Romero Delay Period--could have illuminated that very question. *See* Pro-Football Reply at 8 n.2.

[*60] Pro-Football is correct that, as discussed above, "[i]t is undisputed that, during the Romero Delay Period, the Redskins spent millions of dollars in promoting and marketing the Redskins Marks."

Pro-Football MSJ at 9. Indeed, Defendants do not challenge any of Pro-Football's factual assertions regarding the money it expended during the Romero Delay Period. As such, "the [**40] only question for purposes of [the parties' cross-motions for summary judgment] is whether, under the applicable standards, this undisputed showing is sufficient to establish economic prejudice as a matter of law." *Id.* In addressing this question, the Court reiterates that it has already concluded--in its September 30, 2003 Memorandum Opinion--that Pro-Football established economic prejudice by showing that it had "invested heavily in the marketing and development of its brand during the period of the [other Defendants' twenty-five year] delay," and that "common sense dictates that Pro-Football [would] suffer some economic hardship" if its trademark registrations were cancelled. *Harjo Summ. J. Op., 284 F. Supp. 2d at 143-44.* Again, the D.C. Circuit's remand opinion offers no reason to revisit this conclusion.

Nevertheless, Defendants argue that Pro-Football's undisputed millions of dollars of investments in its trademarks during the Romero Delay Period does not constitute economic prejudice because Pro-Football is required to make a showing of reasonable reliance on Defendant Romero's delay. Defs.' Cross-MSJ at 13-17. The Court previously rejected this argument in its September 30, [**41] 2003 Memorandum Opinion, based on the Federal Circuit's observation "that in trademark cases, unlike patent cases, in order to prove laches a defendant does not need to demonstrate with specific evidence that it relied on the plaintiff's silence."

Harjo Summ. J. Op., 284 F. Supp. 2d at 143. Indeed, in *Bridgestone,* the Federal Circuit stated that "economic prejudice to the defendant may ensue whether or not the plaintiff overtly lulled the defendant into believing that the plaintiff would not act, or whether or not the defendant believed that the plaintiff would have grounds for action." *245 F.3d at 1363. See also A.C. Auckerman Co., 960 F.2d at 1034* ("[L]aches focuses on the reasonableness of the plaintiff's delay in suit. [In contrast,] equitable estoppel focuses on what the defendant has been led to reasonably believe from the plaintiff's conduct."). While Defendants note that two earlier D.C. Circuit opinions, *NAACP* and *Gull Airborne,* suggest that reliance is required to establish laches, this Court previously accepted *Bridgestone's* more recent rejection of a reliance requirement in connection with a trademark cancellation proceeding, and the D.C. Circuit's remand opinion in this [**42] case provides no basis for reconsidering that conclusion. The Court therefore finds Defendants' arguments regarding reliance irrelevant to Pro-Football's ability to demonstrate economic prejudice. [9]

9 In particular, Defendants argue that Pro-Football cannot demonstrate reasonable reliance upon Defendant Romero's silence during the Romero Delay Period because any such reliance is inherently unreasonable "in light of the legal fact that an action to cancel the mark[s] may be brought at any time by a Native American who recently attained the age of majority." Defs.' Cross-MSJ at 15 (citing *Harjo Appeal, 415 F.3d at 48-49*). As Pro-Football correctly notes, however, the D.C.

> Circuit's remand opinion makes clear that laches must be assessed on an individual basis. *See Harjo Appeal, 415 F.3d at 50.* As such, "if Mateo Romero is not bound by the [] laches of other individual Native Americans in his allegedly disparaged group, he [] cannot benefit from any purported absence of laches of still other individuals in the group." Pro-Football Reply at 14-15.

[*61] Defendants next argue that, even if Pro-Football is not required to show reasonable reliance on Defendant Romero's inaction or silence, it "nevertheless [**43] bears the burden of showing that the potential economic harm of which it complains is due to Mateo Romero's delay rather than simply being a harm inherent in cancellation of the registered marks." Defs.' Cross-MSJ at 18-22 (emphasis in original). According to Defendants, "economic prejudice hinges on Pro-Football proving a 'change in [its] economic during the period of delay,' which change would not have occurred if the delay had not occurred." *Id.* at 18-19 (quoting *Auckerman, 960 F.2d at 1033*) (emphasis in Defs.' Cross-MSJ). Specifically, Defendants argue that "Pro-Football has produced no evidence whatsoever that would prove or even tend to prove that it would have reduced investment in the marks or taken other action had a cancellation petition been filed earlier." *Id.* at 20.

This argument is essentially a restatement of Defendants' reliance argument, rejected above. It is true that "[m]ere delay in asserting a trademark-related right does not necessarily result in changed conditions sufficient to support the defense of laches.

There must also have been some detriment due to the delay." *Bridgestone, 245 F.3d at 1362.* In the context of a trademark cancellation action, however, that [**44] detriment derives from "investment in and development of the trademark, and the continued commercial use and economic promotion of a mark over a prolonged period adds weight to the evidence of prejudice." *Id. at 1363.* As this Court explained in its September 30, 2003 Memorandum Opinion, "[i]n other words, prejudice is equated with investment in the trademark that theoretically could have been diverted elsewhere had the suit been brought sooner." *Harjo Summ. J. Op. at 143.*

It is undisputed that the Redskins substantially expanded their use of and investment in the registered marks during the Romero Delay Period. Moreover, this Court has previously concluded that, even though Pro-Football would not lose its ability to use the Redskins trademarks if Defendants succeeded in their cancellation petition, "past investment in the mark will be jeopardized by uncertainty surrounding the brand name" and "an economic cost exists when a trademark is cancelled that adversely affects prior investment in the brand." *Id. at 144.* "Indeed . . . common sense dictates that Pro-Football will suffer some economic hardship" if its trademarks are cancelled, "[o]therwise there would be no point to this litigation [**45] being used as a vehicle to force Pro-Football to change the name of the team." *Id.* Had Defendant Romero commenced his cancellation proceeding when he reached the age of majority in 1984, Pro-Football could have diverted the millions of dollars it spent on promoting, advertising, and protecting its

marks during the Romero Delay Period elsewhere, rather than continuing to invest money in marks that might be rendered uncertain by a successful cancellation petition. The Court previously concluded that this showing was sufficient to establish economic prejudice to Pro-Football as a result of the other Defendants' twenty-five year delay. *See Harjo Summ. J. Op., 284 F. Supp. 2d at 142-44.* While Pro-Football's investments in the Redskins trademarks during the eight-year Romero Delay [*62] Period are undoubtedly less than its investments over the course of the other Defendants' delay period, the difference in scope does not require a change in legal reasoning. The Court therefore continues to find that the Redskins' expanded use of and investment in the registered marks, coupled with the risk Defendant Romero's cancellation petition poses to the security of those marks, establishes economic prejudice [**46] resulting from the Romero Delay Period.

C. Pro-Football Is Entitled to Summary Judgment Based on Defendant Romero's Laches

In sum, the Court finds that Pro-Football has established, based on the undisputed material facts, that Defendant Romero unreasonably delayed his bringing of a cancellation petition and that his eight-year delay demonstrates a lack of diligence on his part. The Court further finds that Defendant Romero's delay has resulted in both trial prejudice and economic prejudice to Pro-Football, such that it would be inequitable to allow Defendant Romero to proceed with his cancellation petition. The Court

shall therefore grant Pro-Football's renewed Motion for Summary Judgment as to its laches defense.

IV: CONCLUSION

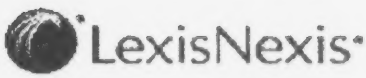
For the reasons set forth above, the Court shall GRANT Plaintiff Pro-Football's [117] Motion for Summary Judgment and DENY Defendants' [112] Cross-Motion for Summary Judgment. In so doing, the Court again reiterates-as it did in its September 30, 2003 Memorandum Opinion-that this "opinion should not be read as [] making any statement on the appropriateness of Native American imagery for team names." *Harjo Summ. J. Op., 284 F. Supp. 2d at 144-45*. An appropriate [**47] Order accompanies this Memorandum Opinion.

Date: June 25, 2008

/s/

COLLEEN KOLLAR-KOTELLY

United States District Judge



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PRO-FOOTBALL, INC., Plaintiff, v. SUZAN SHOWN HARJO, et al., Defendants.

Civil Action No. 99-1385 (CKK)

UNITED STATES DISTRICT COURT FOR THE DISTRICT OF COLUMBIA

284 F. Supp. 2d 96*; *2003 U.S. Dist. LEXIS 17180*; *68 U.S.P.Q.2D (BNA) 1225

September 30, 2003, Decided

SUBSEQUENT HISTORY: Motion denied by, Motion granted by *Pro Football, Inc. v. Harjo, 2004 U.S. App. LEXIS 6991 (D.C. Cir., Apr. 7, 2004)* Remanded by *Pro-Football, Inc. v. Harjo, 2005 U.S. App. LEXIS 14312 (D.C. Cir., July 15, 2005)*

PRIOR HISTORY: *Harjo v. Pro-Football, Inc., 1999 TTAB LEXIS 181 (Trademark Trial & App. Bd., Apr. 2, 1999)*

DISPOSITION: TTAB decision reversed. Plaintiffs Motion for Summary Judgment granted as to their First, Second, and Fifth Causes of Action. Court denied summary judgment to Defendants on these Causes of Action.

COUNSEL: [**1] For Pro Football, Inc, PLAINTIFF: Carolyn Beth Lamm, Francis Anthony Vasquez, Jr, Marc E Ackerman, Robert Lloyd Raskopf, White & Case, New York, NY USA.

For Suzan S Harjo, Raymond D Apodaca, Vine Deloria, Jr, Norbert S Hill, Jr, Mateo Romero, William A Means, Manley A Begay, Jr, DEFENDANTS: Aldo Noto, Dorsey & Whitney, LLP, Washington, DC USA.

JUDGES: COLLEEN KOLLAR-KOTELLY, United States District Judge.

OPINION BY: COLLEEN KOLLAR-KOTELLY

OPINION

[*98] MEMORANDUM OPINION

(September 30, 2003)

TABLE OF CONTENTS

[*99] I. INTRODUCTION

II. FACTUAL BACKGROUND

A. Procedural History

B. The Present Motions

C. Factual Background

1. Local Rule 56.1

2. The Washington Redskins and this Litigation

a. The Origins of the Trademarks at Issue

b. The Challenged Trademarks

3. The TTAB's Findings of Fact

a. The Expert Linguist Testimony

b. The Survey Evidence

4. Facts Relating to Pro-Football's Laches Defense

III. LEGAL STANDARD DISTRICT COURTS USE IN RESOLVING MOTIONS FOR SUMMARY JUDGMENT UNDER *RULE 56*

IV. DISCUSSION

A. The Evidence Below is Insufficient to Conclude that During the Relevant [**2]

Time Periods the Trademarks at Issue Disparaged Native Americans or Brought Them Into Contempt or Disrepute

1. Standard of Review

2. The TTAB's Disparagement Conclusion is a Question of Fact

3. The TTAB's Findings of Fact

a. TTAB's Findings of Fact Regarding Linguists' Testimony

b. TTAB's Findings Regarding Dr. Ross's Survey

4. The TTAB's Legal Analysis

a. The Burden of Proof at the TTAB Level

b. The Meaning of "May Disparage"

5. The TTAB's Finding of Disparagement

a. Meaning of the Matter In Question

b. Whether the Matter in Question May Disparage Native Americans

(1) *Equating the Views of the General Public with Those of Native Americans*

(2) *The Derogatory Nature of the Word "redskin(s)"*

(3) *The Word "redskin(s)" as a Term of Disparagement*

B. Pro Football's Defense of Laches Bars Defendants' Challenge

1. Laches as an Available Defense

2. Substantial Delay

3. Notice

4. Prejudice

V. SUMMARY OF ANALYSIS

VI. CONCLUSION

I. INTRODUCTION

Presently before the Court are cross motions for summary judgment in this long-running trademark cancellation [**3] case. At issue in this appeal is the decision of the Trial Trademark and Appeal Board ("TTAB" or the "Board") to cancel six federal trademark registrations involving the professional football team, the Washington Redskins, because it found that the marks "may disparage" Native Americans or "bring them into contempt, or disrepute." *Harjo v. Pro-Football, Inc., 1999 TTAB LEXIS 181, 50 U.S.P.Q.2d 1705, 1749 (T.T.A.B. 1999)* ("*Harjo II*"). While the national debate over the use of Native American terminology and imagery as depictions for sports teams continues to raise serious questions and arouse the passions of committed individuals on both sides of the issue, the Court's decision on the motions before it does not venture into this thicket of public policy. Rather, at the summary judgment stage, the Court only assesses the legal sufficiency of the TTAB's decision and whether a laches defense is appropriate on the basis of the undisputed material facts. The Court's

conclusions in this case, as to the sufficiency of the evidence before the TTAB and the applicability of the laches defense, should *not* be interpreted as reflecting, one way or the other, this Court's [**4] views as to whether the use of the term "Washington Redskins" may be disparaging to Native Americans. The conclusions in this Memorandum Opinion are in the context of an agency review proceeding and not a decision in the first instance.

The Court has reviewed the parties' extensive briefings, including both parties' motions for summary judgment, both parties' oppositions, and both parties' reply briefs. The Court has also reviewed, where appropriate, the parties' Local Civil Rule 7.1(h) statements of undisputed material facts and the oppositions to those statements. After reviewing all of these pleadings, the entire record submitted herein, the relevant case law and statutory framework, and the transcript of the July 23, 2003, motions hearing, the Court concludes that the TTAB's decision must be reversed.

II. FACTUAL BACKGROUND

A. Procedural History

Pro-Football, Inc. ("Pro-Football"), Plaintiff in the current action and Respondent in the trademark action below, holds six trademarks containing the word, or a derivative of the word, "redskin(s)" that are registered with the Patent and Trademark Office ("PTO"). In September 1992, Suzan Shown Harjo and six other Native [**5] Americans (collectively, "Defendants" or "Petitioners") petitioned the TTAB to cancel the six trademarks, arguing that the use of the word "redskin(s)" is "scandalous," "may . . . disparage" Native Americans, and may cast Native

Americans into "contempt, or disrepute" in violation of *section 2(a) of the Lanham Trademark Act of 1946* ("Lanham Act" or "Act"). Compl. P 13 (citing *15 U.S.C. § 1052(a)*). Pro-Football raised several affirmative defenses in the TTAB action. These included arguments that *section 2(a) of the Lanham Act* unconstitutionally impinges on *First Amendment* speech rights, that it also contravenes *Fifth Amendment* due process rights, and that the Petitioners' challenge to the trademarks was barred by the equitable defense of laches. *See id.* PP 15, 17.

In a pretrial order issued in March of 1994, the TTAB struck each of those defenses. *Harjo v. Pro Football, 1994 TTAB LEXIS 9, 30 U.S.P.Q.2d 1828, 1833 (T.T.A.B. 1994)* ("*Harjo I*"). The TTAB dismissed Pro-Football's [*100] constitutional defenses because assessing the constitutionality of a statute is "beyond the Board's authority." *Harjo I, 30 U.S.P.Q.2d at 1833.* [**6] It held that the laches defense was unavailable as well, after determining that Petitioners advocated on behalf of a broad, public interest, while Pro-Football's interests were distinctly private. *Harjo I, 30 U.S.P.Q.2d at 1831.*

On April 2, 1999, five years after issuing its pretrial order, the TTAB issued a cancellation order in which it scheduled the cancellation of the contested trademarks. *Harjo II, 50 U.S.P.Q.2d at 1748.* The TTAB based its decision on the conclusion that the trademarks "may be disparaging of Native Americans to a substantial composite of this group of people," and "may bring Native Americans into contempt or disrepute." *Id.*

On June 1, 1999, Pro-Football filed its Complaint with this Court, seeking "*de novo* review, pursuant

to *15 U.S.C. § 1071(b)*, of [the TTAB's] unprecedented administrative decision." Compl. P 1. Without expressly bestowing a right to *de novo* review, *section 1071(b)(1)* states that a party "dissatisfied with the decision of the [TTAB] . . . may . . . have remedy by a civil action." In that action, "the court may adjudge . . . that a registration involved should be canceled, . . . as the facts in the case [**7] may appear." *15 U.S.C. § 1071(b)(1). Section 1071(b)(4)* states that the United States District Court for the District of Columbia has jurisdiction where, as here, the defendants "reside in a plurality of districts not embraced within the same State . . . ." *15 U.S.C. § 1071(b)(4).*

In its complaint, Pro-Football presents five causes of action supporting its request that the Court overturn the TTAB's cancellation order. It argues first that the trademarks do not disparage Native Americans and second that they do not bring Native Americans into contempt or disrepute. Compl. PP 108-111. In the third cause of action, Pro-Football contends that *section 2(a) of the Lanham Act* violates the *First Amendment* because it is a vague, overbroad, and content-based restriction on speech. *Id.* PP 112-116. Fourth, it asserts that *section 2(a)* is unduly vague in violation of the *Fifth Amendment. Id.* PP 117-118. Finally, it argues that the Defendants' cancellation petition was barred by the doctrine of laches. *Id.* PP 119-120.

Defendants filed an answer to the complaint on August 30, 1999, and, subsequently, a motion seeking dismissal of Pro-Football's [**8] constitutional and laches claims or, alternatively, judgment on the pleadings with regard to those claims. After receiving thorough briefing on the

motion, the Court held a motions hearing on the record on June 29, 2000, and requested limited additional briefing. The parties submitted additional briefings pursuant to that request.

On December 11, 2000, the Court denied without prejudice Defendants' motion to dismiss Pro-Football's constitutional claims as premature. *Pro-Football v. Harjo, 2000 U.S. Dist. LEXIS 19792, 57 U.S.P.Q.2d 1140, 1142-43 (D.D.C. 2000)* ("*Harjo III*") (finding that the doctrine of constitutional avoidance-the fundamental rule of judicial restraint-required the Court to first rule on Pro-Football's three non-constitutional claims). The Court wrote that "the avoidance doctrine forecloses the Court's assessment of Pro-Football's constitutional claims on the Native Americans' motion because non-constitutional claims seeking the same relief remain unresolved." *Id. at 1143*; *see also id. at 1144* ("Because the constitutionality of the challenged portion of the *Lanham Act* is a novel and unsettled [*101] issue, the Court shall tackle it only if Pro-Football [**9] does not prevail on its nonconstitutional claims.").

The Court also denied without prejudice Defendants' motion on Pro-Football's laches claim. *Id. at 1145-46*. The Court first observed that "the *Lanham Act* does not unequivocally bar laches claims and defenses raised in regard to petitions brought under *section 2(a)*." *Id. at 1145*. Noting that the applicability of the doctrine of laches was "dependent upon the equities of the factual scenarios within which it is raised," *id. at 1145*, the Court refused to dismiss Pro-Football's laches argument until the factual record could be further developed. *Id. at 1145-46*.

After this ruling, the parties engaged in a protracted period of discovery on the issue of laches that spawned a series of disputes, which were sent to Magistrate Judge John M. Facciola for resolution. Magistrate Judge Facciola resolved the pending discovery issues on February 28, 2002. Pursuant to a consent request of Pro-Football, the Court extended the close of discovery until June 7, 2002, and requested that the parties jointly file their dispositive motions on July 12, 2002. However, on June 7, 2002, Defendants moved to preclude testimony or compel discovery

[**10] relating to the testimony of Daniel M. Snyder, team owner of the Washington Redskins. The Court referred this motion to Magistrate Judge Facciola on June 18, 2002. While this motion relating to Mr. Snyder's testimony was still pending, on July 12, 2002, the parties filed cross motions for summary judgment. These motions became ripe on August 28, 2002. However, given that the issue of Mr. Snyder's deposition was still pending before Magistrate Judge Facciola, the Court deferred ruling on these motions until the issue over Mr. Snyder's deposition could be resolved.

Since the Snyder deposition was not conducted until May 16, 2003, the Court postponed a motions hearing that had been originally scheduled in this case for April 25, 2003, until July 23, 2003. On July 23, 2003, the Court convened the parties for a motions hearing on the pending cross motions for summary judgment.

Immediately prior to the motions hearing, the parties submitted the Snyder Deposition transcript without any explanation or additional argument.

The Court, at the July 23, 2003, motions hearing, requested that the parties submit page citations to the deposition that the parties found probative in relation to their [**11] cases. Both parties complied with this request. However, as the old saw goes, in giving an inch, the parties took a mile. Both sides filed supplemental evidence, unrequested by the Court, that the Court finds unhelpful in resolving the legal challenge. The Court accordingly strikes Pro-Football's July 25, 2003, Praecipe, Pro-Football's August 6, 2003, Supplemental Praecipe, and Defendants' Supplemental Expert Reports of Geoffrey Nunberg and Timothy J. Nantell. This material was not requested by the Court and is not helpful in resolving the current motions. [1]

1 As such, the Court grants Pro-Football's motion to strike the supplemental reports of Geoffrey Nunberg and Timothy J. Nantell. The Court also grants Defendants' request, filed in their opposition, to strike all recent submissions outside those the Court specifically requested.

B. The Present Motions

These proceedings are presently before the Court on cross motions for summary judgment. Pro-Football seeks summary judgment on its first (Pro-Football's [**12] [*102] trademarks do not and will not disparage Native Americans), second (Pro-Football's trademarks do not and will not bring Native Americans into contempt or disrepute), and fifth (laches) causes of action. Essentially, Pro-Football makes two main arguments: (1) assuming Defendants' petition for cancellation was timely, the dispositive evidence before the TTAB was irrelevant

and therefore does not support a finding that the term "redskin(s)" may be disparaging or cause Native Americans to be brought into contempt or disrepute; and (2) Pro-Football has met the laches standard articulated by the Court and therefore the Court should order the TTAB to dismiss Defendants' petition for cancellation of the Redskins Marks under *section 2(a) of the Lanham Act*. Defendants have also moved for summary judgment. They argue that (1) the Court should affirm the TTAB's decision and (2) Pro-Football's laches claim should be rejected. Defendants also renew their motion to dismiss Pro-Football's constitutional claims, if the Court reaches that issue.

In the context of the first issue, whether summary judgment should be granted for either party on Pro-Football's first and second counts, the Court notes that [**13] the *Lanham Act*'s provisions for district court review of a decision of the TTAB are fairly unique and unlike most other administrative reviews. Essentially, the Court reviews the findings of fact of the TTAB under the substantial evidence test, which has been derived from the Administrative Procedure Act ("APA"), *5 U.S.C. § 706*. Additionally, the parties are permitted to offer new evidence, and the Court may make new findings of fact based on this newly submitted evidence. [2] However, for purposes of this proceeding, the parties chose not to present any new evidence on Pro-Football's first two counts. *See* Tr. of 7/23/2003 Motions Hearing ("Tr. 7/23/2003") at 3, 8 (not disputed).

2 Of course, at this summary judgment stage in the proceedings, the Court would not be

permitted under the Federal Rules of Civil Procedure to make findings of fact.

As will be examined in some detail below, the TTAB only made specific findings of fact in two areas-linguistic evidence and survey evidence. These [**14] findings are very limited, because in most instances, the TTAB merely drew from the undisputed portions of the record to make these findings of fact. [3] Indeed, the TTAB heard no live testimony and the testimony cited in its opinion merely came from deposition transcripts. For the rest of the voluminous record, the TTAB decided not to make findings of fact, and instead simply cataloged the evidence put forth by both parties. The Court, therefore, in discussing the TTAB's opinion in factual background section of this Memorandum Opinion only concentrates on the areas where the TTAB actually made findings of fact. [4]

3 In this sense, even though the TTAB held a cancellation proceeding, it is almost as if its decision approximates a summary judgment proceeding. However, given the fact that the TTAB treated the case as a "trial," the Court does not review the TTAB's decision as if it were made on motions for summary judgment.

4 As will be demonstrated *infra*, the TTAB's approach is problematic because the TTAB states that its entire legal conclusion is premised on "the cumulative effect of the *entire* record." *Harjo II, 50 U.S.P.Q.2d at 1743* (emphasis added). However, by making minimal findings on the disputed evidence and focusing almost exclusively on the undisputed portion of the record, the TTAB's finding of

disparagement is supported by inferential fact-based judgments, unsubstantiated with concrete evidentiary proof.

[**15] **C. Factual Background**

The Court now turns to the undisputed material facts of this case. First, the Court [*103] sets forth those facts essential to understanding this case by reviewing the trademarks that are at issue. Second, the Court discusses the factual findings made by the TTAB. Finally, the Court sets out the undisputed material facts relating to the new evidence in the record that pertains to Pro-Football's laches defense.

1. Local Rule 56.1

At the outset, the Court observes that the District Court for the District of Columbia has supplemented *Federal Rule of Civil Procedure 56* with LCvR 56.1, which requires that each party submitting a motion for summary judgment attach a statement of material facts to which that party contends there is no genuine issue, with specific citations to those portions of the record upon which the party relies in fashioning the statement. [5] The party opposing such a motion must, in turn, submit a statement of genuine issues enumerating all material facts which the party contends are at issue and thus require litigation. *See* LCvR 56.1. Where the opposing party fails to discharge this [**16] obligation, a court may take all facts alleged by the movant as admitted. LCvR 56.1. As the District of Columbia Circuit has emphasized, "[LCvR 56.1] places the burden on the parties and their counsel, who are most familiar with the litigation and the record, to crystallize for the district court the material facts and relevant

portions of the record." *Jackson v. Finnegan, Henderson, Farabow, Garrett & Dunner, 322 U.S. App. D.C. 35, 101 F.3d 145, 151 (D.C. Cir. 1996)* (citing *Twist v. Meese, 272 U.S. App. D.C. 204, 854 F.2d 1421, 1425 (D.C. Cir. 1988)*; *Guarino v. Brookfield Township Trustees, 980 F.2d 399, 406 (6th Cir. 1992)*). Because of the significance of this task and the potential hardship placed on the court if parties are derelict in their duty, courts require strict compliance with LCvR 56.1. *See id. at 150* (citations omitted).

5 The Rule provides, in relevant part:

> Each motion for summary judgment shall be accompanied by a statement of material facts as to which the moving party contends there is no genuine issue, which shall include references to the parts of the record relied on to support the statement. An opposition to such a motion shall be accompanied by a separate concise statement of genuine issues setting forth all material facts as to which it is contended there exists a genuine issue necessary to be litigated, which shall include references to the parts of the record relied on to support the statement. . . . In determining a motion for summary judgment, *the Court may assume that facts identified by the moving party in its statement of material*

> *facts are admitted, unless such a fact is controverted in the statement of genuine issues filed in opposition to the motion.*
>
> LCvR 56.1 (formerly known as Local Rule 108(h)) (emphasis added).

[**17] This Court strictly adheres to the text of Local Civil Rule 56.1 when resolving motions for summary judgment. *See Pro-Football, Inc. v. Harjo*, Civ. No. 99-1385 (D.D.C. February 13, 2001) (scheduling and procedures order) P 6 (discussing that the parties are required to comply with Local Civil Rule 7.1(h), which is identical to Local Civil Rule 56.1); *see also Burke v. Gould, 351 U.S. App. D.C. 1, 286 F.3d 513, 519 (D.C. Cir. 2002)* (district courts need to invoke Local Civil Rule 56.1 before applying it to the case). Although discretionary in the text of the Local Civil Rule 56.1, in resolving the present summary judgment motion, this Court "assumes that facts identified by the moving party in its statement of material facts are admitted, unless such a fact is controverted in the statement of genuine issues filed in opposition to the motion." LCvR 56.1.

Where possible, the Court cites to the parties' statements of facts filed in accordance with Local Civil Rule 7.1(h). The Court has reviewed the record citations by [*104] the parties to ensure that the representations made in the parties' statement are accurate. Moreover, the Court only uses the facts in a manner consistent [**18] with the approach taken by the parties in their briefing and arguments made to the Court. *See, e.g., Morgan v. Federal Home Loan*

Mortgage Corp., 356 U.S. App. D.C. 109, 328 F.3d 647, 655 n.10 (D.C. Cir. 2003).

Since much of the relevant background of this case has been already set forth in this Court's prior published opinion in this case, and in the published opinion in the proceedings below, this Court has endeavored to avoid repetition and focus only on those facts necessary for resolving the present motions for summary judgment. Having set forth these preliminaries, the Court moves to a discussion of the material facts not genuinely in dispute.

2. The Washington Redskins and this Litigation

a. The Origins of the Trademarks at Issue

Plaintiff Pro-Football, Inc. is a Maryland corporation with its principal place of business in Virginia. Pro-Football is the owner of the Washington Redskins, a professional football franchise located in the Washington, D.C. area, and one of the thirty-two member clubs of the National Football League ("NFL"). Pl.'s Local Civil Rule 7.1(h) Statement of Material Facts in Supp. of Its Mot. for Summ. J. ("Pl.'s Stmt.") PP 1-2; Compl. [**19] P 4. On or about July 8, 1932, George Preston Marshall, along with Vincent Bendix, Jay O'Brien, and Dorland Doyle, purchased a then-inactive Boston National Football League franchise. Pl.'s Stmt. P 3. Within the year, his co-owners dropped out and Mr. Marshall was left as the sole owner of the franchise. *Id.* The Boston team played the 1932 season in

Braves Field, home of Boston's then-National League baseball team, and like the baseball team, were known as "The Braves." *Id.* P 4. On or about July 8, 1933, Mr. Marshall officially changed the name of his franchise from the "Boston Braves" to the "Boston Redskins." *Id.* P 5. Mr. Marshall chose to rename his franchise the Redskins in honor of the team's head coach, William "Lone Star" Dietz, who was a Native American. *Id.* P 7. [6]

6 To support this fact, Pro-Football cites the declaration of David Pauken, the Chief Operating Officer of Pro-Football and an op-ed piece from *The Washington Post* that Mr. Pauken cites as proof of this fact. The newspaper article, entitled "My Grandfather Named the Redskins" was written by Jordan Harrison Price, Mr. Marshall's granddaughter. Defendants object to this evidence because they argue that Mr. Paulken does not have a foundation to establish this fact and the newspaper article is "inherently unreliable" since it was written many years after the event in question. Defs.' Local Civil Rule 7.1(h) Statement of Material Facts in Opp'n to Pl.'s Mot. for Summ. J. (Defs.' Opp'n Stmt.") P 7. The essence of Defendants' objection is with the article itself and is not related to the fact that the article came from a newspaper. They argue that the author of the article, Mr. Marshall's granddaughter, cannot provide reliable testimony due to the passage of time.

The Court disagrees with Defendants objection to the newspaper article. They offer no compelling reason why the memories of Mr.

Marshall's granddaughter would be inherently unreliable; particularly since they do not dispute other facts that also have their basis in the newspaper article. *Compare* Pl.'s Stmt. PP 3-5 *with* Defs.' Opp'n Stmt. PP 3-5. Moreover, Defendants did not introduce any evidence that would contradict this statement.

[**20] Around this time, i.e. the 1930's, the Redskins began to use the marks:

[*105] [SEE EXHIBIT IN ORIGINAL]

and "REDSKINS" in commerce. *Id.* P 6 (observing that these marks were later registered as Registration Nos. 836,122 and 1,085,092 respectively). [7] On or about February 13, 1937, the Boston Redskins franchise moved to the Washington, D.C. area and were re-christened the "Washington Redskins." *Id.* P 9. On or about September 16, 1937, the day of the Redskins' first game in Washington, D.C., the Redskins began to use the mark "WASHINGTON REDSKINS" in commerce. *Id.* P 10. In or about January 1941, the Redskins started using the following marks in commerce:

[SEE EXHIBITS IN ORIGINAL]

Id. P 11. In or about 1962, the Redskins started using the "REDSKINETTES" mark in commerce in connection with its cheerleaders. *Id.* P 13.

7 The graphical images of the trademarks used in this opinion have been obtained by entering the registration numbers into the United States Patent and Trademark Office's Trademark Electronic Search System. This

useful website is located at: http://tess2.uspto.gov/bin/gate.exe?f=tess&state=23s9ck.4.1.

[**21]

b. The Challenged Trademarks

On July 14, 1966, the Redskins filed application serial number 72/250,227 for the mark:

[SEE EXHIBIT IN ORIGINAL]

for use in connection with "entertainment services-namely, football exhibitions rendered live in stadia and through the media of radio and television broadcasts" in International Class 041. *Id.* P 24. On July 11, 1967, the PTO published this application for public opposition in the *Official Gazette*. *Id.* The PTO issued registration number 836,122 for this mark on September 26, 1967. *Id.* [8] On September 26, 1987, the PTO renewed the Redskins' registration for an additional twenty years. *Id.* P 40.

8 It does not appear that Defendants dispute Pro-Football's contention that the PTO received not "a single opposition from anyone, let alone any Native American" in connection with its publication in the *Official Gazette*. Defs.' Opp'n Stmt. P 24. Nevertheless, the documentary evidence submitted-which consists of the principal register of the service mark-does not indicate that oppositions were or were not received. However, since this fact is not specifically disputed the Court will accept Pro-Football's representation.

[**22] [*106] On September 11, 1972, the Redskins filed application serial number 72/435,127 for the

[SEE EXHIBIT IN ORIGINAL]

trademark, application serial number 72/435,243 for the "WASHINGTON REDSKINS" trademark, and application serial number 72/435,244 for the

[SEE EXHIBIT IN ORIGINAL]

trademark, all for use in connection with "entertainment services-namely, presentations of professional football contests" in International Class 041. *Id.* P 26. The first of these three trademarks was published in the *Official Gazette* on November 6, 1973, and the other marks were likewise published. *Id.* PP 30-31. [9] On June 18, 1974, the PTO issued registration number 986,668 for first of these three trademarks. *Id.* P 33. On February 12, 1974, the PTO issued registration number 978,824 for the second of these two trademarks. *Id.* P 32. On June 25, 1974, the PTO issued registration number 987,127 for the third of these trademarks. On June 18, 1994, the first of these trademarks was renewed for ten years. *Harjo II, 50 U.S.P.Q.2d at 1708 n.7.* On February 12, 1994, the PTO renewed the second of these three trademarks for ten years. *Id. at 1707 n.3.* On June 25, 1994, the [**23] PTO renewed the third of these three trademarks for ten years. *Id. at 1708 n.8.*

9 Defendants clearly do not dispute Pro-Football's contention that the PTO received not "a single opposition from anyone, let alone any Native American" in connection with its publication of these three trademarks in the

Official Gazette. Defs.' Opp'n Stmt. PP 32-34. Nevertheless, the documentary evidence submitted-which consists of the principal register of the service mark-does not indicate that oppositions were or were not received or the date the trademarks were published; with the exception of the first of these three marks where the record discloses that the trademark was published on November 6, 1973. However, since these facts are not specifically disputed, the Court will accept Pro-Football's representation.

On November 26, 1976, the Redskins filed application serial number 73/107,873 for the mark "REDSKINS" for use in connection with "entertainment services-namely, presentations of professional football contests" [**24] in International Class 041. Pl.'s Stmt. P 35. The PTO issued registration number 1,085,092 for this mark on February 7, 1978, following publication in the *Official Gazette. Id.* [10] On February 7, [*107] 1998, this trademark was renewed for a period of ten years. *Harjo II, 50 U.S.P.Q.2d at 1707 n.4.*

10 It does not appear that Defendants dispute Pro-Football's contention that the PTO received not "a single opposition from anyone, let alone any Native American" in connection with its publication in the *Official Gazette*. Defs.' Opp'n Stmt. P 35. Nevertheless, the documentary evidence submitted-which consists of the principal register of the service mark-does not indicate that oppositions were or were not received or the date that the trademark was published. However, since these facts are not

specifically disputed the Court will accept Pro-Football's representation.

On October 4, 1989, the Redskins filed application serial number 73/829,272 for the mark "REDSKINETTES" for use in connection [**25] with "entertainment services, namely, cheerleaders who perform dance routines at professional football games and exhibitions and other personal appearances" in International Class 041. Pl.'s Stmt. P 42. The PTO published this application for public opposition in the *Official Gazette* on April 24, 1990. *Id.* The PTO issued registration number 1,606,810 for this mark on July 17, 1990. *Id.* [11]

11 It does not appear that Defendants dispute Pro-Football's contention that the PTO received not "a single opposition from anyone, let alone any Native American" in connection with its publication in the *Official Gazette*. Defs.' Opp'n Stmt. P 42. Nevertheless, the documentary evidence submitted-which consists of the principal register of the service mark-does not indicate that oppositions were or were not received. However, since this fact is not specifically disputed the Court will accept Pro-Football's representation.

3. The TTAB's Findings of Fact

The TTAB made specific findings of fact in only [**26] two areas: (1) the testimony of expert linguists, *Harjo II, 50 U.S.P.Q.2d at 1731-32*, and (2) survey evidence, *id. at 1734*. With these two exceptions, the TTAB made no other findings of fact regarding the voluminous record and instead merely presented the evidence of each of the parties in the

form of summaries. *Id. at 1721* ("Except for the testimony and related exhibits of the parties' linguistics experts and marketing and survey experts, we summarize the testimony and related exhibits of, first, petitioners' witnesses and, second, respondent's witnesses."). Again, it should be noted that the testimony supporting these findings was in the form of depositions and not in the form of live testimony before the finders of fact. The Court now turns to these findings. [12]

12 The Court has compiled this section primarily from the actual opinion of the TTAB. Defendants discuss the TTAB's Findings in their 7.1(h) statement. Defs.' Statement of Undisputed Material Facts in Supp. of Defs.' Mot. for Summ. J. ("Defs.' Stmt.") at 5-7. However, Defendants compiled these findings from the portion of the TTAB's opinion where it applied the law to these facts to reach legal conclusions. The Court reviews the TTAB's ultimate finding-that the trademarks at issue "may disparage" Native Americans-in the context of its own Discussion section *infra*.

[**27]

a. The Expert Linguist Testimony

During the proceedings below, Petitioners presented the testimony of Geoffrey Nunberg, a linguistics expert, while Pro-Football presented the testimony of David Barnhart and Ronald Butters, who also are linguistics experts. *Id. at 1728*. The experts explained that linguistics is "the study of

language and its uses, both generally and within particular populations or historical contexts; and that lexicography is the branch of linguistics concerned with the meaning of words with respect to the production of dictionaries." *Id.* The Board then summarized the testimony of these experts. *Id. at 1728-31.* After compiling this summary, the TTAB essentially made five findings of fact regarding the linguists' testimony. These findings of fact are:

> 1. "There is no dispute among the linguistics experts that the word 'redskin(s)' [*108] has been used historically to refer to Native Americans, and is still understood, in many contexts, as a reference to Native Americans." *Id. at 1731.*
>
> 2. "From at least the mid-1960's to the present, the word 'redskin(s)' has dropped out of written and most spoken language as a reference to Native [**28] Americans." *Id.*
>
> 3. "From at least the mid-1960's to the present, the words 'Native American,' 'Indian,' and 'American Indian' are used in spoken and written language to refer to Native Americans." *Id.*
>
> 4. "From at least the mid-1960's to the present, the word 'redskin(s)' appears often in spoken and written language only as a reference to respondent's football team." *Id.*
>
> 5. "The experts agree the evidence of record establishes that, until at least the

> middle of this century, spoken and written language often referred to Native Americans in a derogatory, or at least condescending, manner and that references to Native Americans were often accompanied by derogatory adjectives and/or in contexts indicating savagery and/or violence." *Id.* (noting that "there is no dispute that, while many of these usage examples refer to Native Americans as 'Indians,' the word 'Indian' has remained in the English language as an acceptable reference to Native Americans during the second half of this century").

Importantly, in making these findings of fact, the TTAB specifically indicated where it was declining to make certain findings of fact regarding the linguistic expert [**29] testimony. First, with regard to the testimony of the experts "about the denotation and connotation of 'redskin(s)' as a reference to Native Americans and as it appears in the name of respondent's football team," the TTAB found that "to some extent, this testimony is self-serving and the opinions of the different individuals seem to negate each other's assertions, which offsets whatever probative value could be attributed to this portion of their testimony." *Id. at 1731.* Second, with regard to the question of "significance of the word 'redskin(s)[']in written and spoken language from the 1960's to the present, both as a reference to Native Americans and as part of the name of respondent's football team," the TTAB reasoned that this testimony

reached the ultimate legal inquiry that was before the TTAB and therefore was not considered in rendering its decision. *Id.* Third, the TTAB noted that in reaching their conclusions, the experts made statements that required "scrutiny." *Id. at 1732.* The TTAB stated:

> For example, while respondent's linguistics experts contend that the word "redskin(s)" is merely an informal term, petitioners' expert notes, credibly, that such [**30] a characterization does not address the issue of whether the connotation of 'redskin(s)' in any given instance is negative, neutral or positive. Nor does the characterization of the word "redskin(s)" as informal adequately address the question of why the word appears, on this record, to have entirely dropped out of spoken and written language since, at least, the 1960's, except in reference to respondent's football team.

Id. The TTAB, however, reached no further than these observations and did not make a finding of fact on the implication of these omissions by Pro-Football's experts.

Finally, the Board summarized the dictionary results that were in evidence and simply cataloged the evidence without making any specific findings of fact:

> [*109] Looking to dictionary definitions of the word "redskin(s)," the experts agree

> that the many dictionaries in evidence, including dictionaries from the time periods when each of the challenged registrations issued, define "redskin" as a Native American person; that one dictionary also defines "Redskin" as respondent's professional football team; and that several dictionaries, dating from 1966 to the present, include usage labels indicating [**31] that the word "redskin" is an offensive reference to Native Americans, whereas several dictionaries, dating from 1965 to 1980, do not include such usage labels in defining "redskin." Predictably, the experts' opinions differ as to the significance to be attached to the usage labels, or the lack thereof. *We find these contradictory opinions of little value in resolving this dispute.* Thus, we have considered the dictionary definitions themselves in the context of the entire record.

Id. (emphasis added). Again, the Board declined to make specific findings of fact with regard to the experts' different views on the usage labels contained in the dictionary definitions. Instead, of making findings of fact on the significance of these usage labels or their importance, or on usage labels in general, the TTAB simply considered the dictionary definitions, themselves, in the context of its legal analysis, without relying on the experts' opinions. With regard to the linguists' expert deposition testimony, therefore, the TTAB made only

five findings of fact. These findings of fact were taken from undisputed portions of the record. The TTAB did not credit one side's experts over another [**32] side's experts in making these findings.

b. The Survey Evidence

Survey expert Dr. Ivan Ross, President of Ross Research and a former Professor of Marketing and Adjunct Professor of Psychology with the Carlson School of Management of the University of Minnesota testified by deposition in the TTAB proceeding. Defs.' Stmt. P 15. In March of 1996, Dr. Ross conducted a survey for purposes of this case. *Id.* Dr. Ross stated that the purpose of the survey was "to determine the perceptions of a substantial composite of the general population and of Native Americans to the word "redskin(s)" as a reference to Native Americans. *Harjo II, 50 U.S.P.Q.2d at 1732.* Dr. Ross surveyed three hundred and one American adults and three hundred and fifty-eight Native American adults. *Id.* (observing that both groups included men and women ages 16 and above).

The Native American group was "a stratified sample." *Id.* First, Dr. Ross selected the twenty states with the highest numbers of Native Americans, excluding Alaska and Hawaii. Pl.'s Mot., Ex. 196, Ross Rep., Letter to Ivan Ross from Jim Robinson on "Method of Drawing Sample for Native American Project" at 1. [**33] After selecting these twenty states, the Business Research Bureau of the University of South Dakota stratified the counties by percentage of population which is Native American. *Id.* Dr. Ross's polling firm selected the top fifty counties Tfrom among all twenty states, for which a

random sample was then drawn. *Id.* These counties fell in only thirteen states. *Id.* The final step in getting a sample involved Dr. Ross's polling firm taking precautions against polling only in urban areas. *Id. at 1-2.* The net result was a sample where the top fifty census tracts fell into only twelve states. *Id. at 2.* According to Dr. Ross, the Native American sample reflected "a consistent mix of rural and urban Native Americans; and included both registered members of Indian tribes and non-registered individuals who identified [*110] themselves as Native American." *Harjo II, 50 U.S.P.Q.2d at 1732-33.*

The survey was constructed as follows:

> Individuals in both population groups were read a list, in varying order, of the following terms: "Native American," "Buck," "Brave," "Redskin," "Injun," "Indian," and "Squaw." With respect to each term, participants were asked whether [**34] or not they, or others, would be "offended" by the use of the term and, if so, why. Dr. Ross testified that he chose these terms as representative of a spectrum of acceptability, positing that, in general, "Native American" would be likely to be considered acceptable and "Injun" would be likely to be considered pejorative. Dr. Ross testified that, for the question, he chose the word "offensive" as most likely to reflect, to those unfamiliar with trademark law, the behavioral concepts embodied in the terms "scandalous" and "disparaging" in the

> trademark law. Dr. Ross stated that asking participants whether others might be offended is an accepted additional means of obtaining the speaker's opinion, based on the assumption that the speaker may be circumspect in answering a direct question.

Id. at 1733. [13] On the basis of these questions, Dr. Ross found that 46.2% of the general population sample would be personally offended by the use of the term "redskin" and 36.6% of the Native American population sample would be personally offended by the use of the term "redskin." *Id.*

13 The two Ross Survey questions were:

> Q: I'm going to say some terms which you might hear someone say when referring to an American Indian person. One or more of these terms may be OFFENSIVE to you when you hear it used, or NONE of them may be offensive to you . . . .
>
> Q: Would you, yourself, be OFFENDED by the term REDSKIN if you hear that term being used to describe an American Indian person, or would you not be offended, or don't you have an opinion ONE WAY OR THE OTHER about that?

> Pl.'s Stmt. P 89; *see also* Defs.' Opp'n Stmt. P 89 (indicating that the ordering of the survey phrases within the questions were randomized).

[**35] Pro-Football did not conduct its own survey; however, it did provide an expert witness to critique Dr. Ross's survey. *Id.* Dr. Jacob Jacoby, a psychologist and expert in the area of marketing and trademark surveys made a number of criticisms. His critique of the questions asked stated that:

> . the questions in the survey were leading and not neutral;
>
> . the lists of words referring to Native Americans contained an insufficient number of terms;
>
> . in using the term "offensive" in its questions, the survey did not illicit the necessary information for a determination under *section 2(a)*;
>
> . asking questions about what others think leads to ambiguous results. *Id.*

Dr. Jacoby's analysis of the sampling procedure led him to conclude:

> . the Native American sample was too geographically limited to be representative;
>
> . the method for ascertaining whether a participant is a Native American was flawed;

> . the birthday sample method used by Dr. Ross violated the randomness of the survey; [14]
>
> . [*111] the age requirements for the survey included participants who could not reflect the state of mind of people in 1967; and
>
> . there was [**36] a less than 50% response rate to the survey, which rendered it a very weak probability survey. *Id. at 1733-34.*

In addition, Dr. Jacoby concluded that "you cannot project, as Dr. Ross says, to the Native American population as a whole for several very important reasons." Pl.'s Mot., Ex. 185, Jacoby Tr. at 21-25. First, the Ross Survey excluded those Native Americans living in thirty-six of the forty-eight contiguous states. Pl.'s Stmt. P 96. Second, the survey excluded large numbers of Native Americans living in Alaska and Hawaii. *Id.* P 97. Third, the Ross Survey included counties in only twelve states, the net result being that the Ross Survey represented only two percent of all U.S. counties. *Id.* PP 98, 100.

> 14 Dr. Jacoby explained at his deposition the problem with this method. The Ross Survey's polling firm called each house and to ensure randomness asked to speak to the person in the household who was having the next birthday. Pl.'s Mot., Ex. 185, Jacoby Tr. at 23. If the

> person with the next birthday was not home then the proper procedure, in Dr. Jacoby's view, was to call that individual back at another time. *Id.* at 24. However, the Ross Survey did not follow this practice and instead of calling the person back, the questioner asked to speak to the person with the next birthday in the house, which, according to Dr. Jacoby, "totally violated, according to all kinds of sample theory, the requirements for calling what you're doing a probability sample." *Id.*

[**37] Finally, with regard to the tabulation of the results, Dr. Jacoby observed that certain responses were incorrectly tabulated as positive responses. In particular, these incorrectly tabulated results included those responses where the participant stated that his/her response was dependent on the context in which the word was used and those responses indicating that others may be offended. *Harjo II, 50 U.S.P.Q.2d at 1734.*

These critiques of the Ross survey led Dr. Jacoby to conclude that the survey was completely unscientific. *Id.* In addition, Dr. Jacoby found the survey flawed because it sought the current views of its participants rather than their perceptions during the relevant time period. *Id.* Finally, Dr. Jacoby observed that the survey was a failure because it did not ascertain the perceptions of those questioned on the use of the word "redskin(s)" in the context of Pro-Football's entertainment services. *Id.*

After detailing the evidence on the surveys, the Board ignored Dr. Jacoby's detailed criticisms and made basically three findings of fact regarding this survey evidence:

1. "After careful consideration of Dr. Ross' testimony, the survey [**38] report and the substantial survey data in the record, we find ample support for the viability of the survey methodology used, including the sampling plan, the principal questions asked, and the manner in which the survey was conducted." *Id.* [15]

2. "We find no error in including adults aged 16 and above in the survey, even though the younger participants were not alive, or not adults, at the time of registration of several of respondent's marks herein. Dr. Ross does not represent this survey as anything other than a survey of current attitudes as of the time the survey was conducted." *Id.*

3. "In this regard, we find that the survey adequately represents the views of the two populations sampled. [*112] While certainly far from dispositive of the question before us in this case, it is relevant and we have accorded some probative value to this survey, as discussed in our legal analysis . . . ."*Id.*

15 Since the TTAB made a separate finding that the survey results could be extrapolated to the general and Native American populations,

> the Court does not read the TTAB's use of the term "methodology" as encompassing extrapolation.

[**39] The Board indicated, however, that the Ross survey was "not without flaws." *Id.* In particular, the Board did not accord any weight to the survey results pertaining to the participants' conjecture about the views of others. *Id.* The TTAB also observed that "a survey of attitudes as of the dates of registration of the challenged registrations would have been *extremely* relevant in this case." *Id.* (emphasis added). Additionally, the Board noted that "a survey that considered participants' views of the word 'redskin(s)' as used by respondent, the media and fans in connection with respondent's football team would have been *extremely* relevant." *Id.* (emphasis added).

4. Facts Relating to Pro-Football's Laches Defense

It is not disputed that Defendants were aware of the Washington Redskins team name and the name of the cheerleaders during the relevant time period. Defendant Suzan Shown Harjo, who as born in 1945, admits to being aware of the Washington Redskins team name since she was a child. Pl.'s Stmt. P 17. Defendant Vine Deloria admits that he first knew of the Washington Redskins during World War II. *Id.* P 18. Defendant Norbert Hill testifies in his [**40] deposition that he has known of the Washington Redskins since his childhood in the 1950's and 1960's. *Id.* P 19. Defendant Manley Begay testifies in his deposition that he was born August 10, 1954, and became aware of the Washington Redskins at a "very young" age. *Id.* P 20. Defendant William A. Means

has watched Redskins games and cheerleaders on television at least ten times. *Id.* P 52. Defendant Raymond D. Apodaca has watched football, including Redskins games, since it was televised. *Id.* P 57. Mr. Romero, born in 1966, saw Redskins games on television as a child as well as the Redskinettes cheerleaders. *Id.* P 61. It is also undisputed that Defendants did not file their petition to cancel the registrations of the trademarks until September 10, 1992. In addition, it is also undisputed that during the period of delay, Pro-Football and NFL Properties invested in the trademarks and had increasing revenues during this time frame. *See, e.g., id.* PP 68, 70, 72-81.

III. LEGAL STANDARD DISTRICT COURTS USE IN RESOLVING MOTIONS FOR SUMMARY JUDGMENT UNDER *RULE 56*

A party is entitled to summary judgment if the pleadings, depositions, and affidavits demonstrate [**41] that there is no genuine issue of material fact in dispute and that the moving party is entitled to judgment as a matter of law. *Fed. R. Civ. P. 56(c); Tao v. Freeh, 307 U.S. App. D.C. 185, 27 F.3d 635, 638 (D.C. Cir. 1994).* Although a court should draw all inferences from the supporting records submitted by the nonmoving party, the mere existence of a factual dispute, by itself, is not sufficient to bar summary judgment. *Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 248, 91 L. Ed. 2d 202, 106 S. Ct. 2505 (1986).* The adverse party's pleadings must evince the existence of a genuine issue of material fact. *Id. at 247-48.* To be material, the factual assertion must be capable of affecting the substantive outcome of the litigation; to be genuine, the issue must be supported by sufficiently admissible evidence such

that a reasonable trier-of-fact could find for the nonmoving party. *Id.*; *Laningham v. United States Navy, 259 U.S. App. D.C. 115, 813 F.2d 1236, 1242-43 (D.C. Cir. 1987)*. Mere [*113] allegations or denials in the adverse party's pleadings are insufficient to defeat an otherwise [**42] proper motion for summary judgment. Rather, the nonmoving party bears the affirmative duty to present, by affidavits or other means, specific facts showing that there is a genuine issue for trial. *Laningham, 813 F.2d at 1241-42*. The adverse party must do more than simply "show that there is some metaphysical doubt as to the material facts." *Matsushita Elec. Indus. Co. v. Zenith Radio Corp., 475 U.S. 574, 586, 89 L. Ed. 2d 538, 106 S. Ct. 1348 (1986)*.

In the case of a laches claim, a district court enjoys "considerable discretion in determining whether to apply the doctrine of laches to claims pending before it." *Hot Wax, Inc. v. Turtle Wax, Inc., 191 F.3d 813, 819 (7th Cir. 1999)*. As a result, appellate courts, even on summary judgment motions review a district court's laches finding under an abuse of discretion standard in cases where no material facts are disputed. *Id.* ("Therefore, while our review of the record is *de novo*, in determining whether there are any disputed issues of material fact, our review of whether the district court properly applied the doctrine of laches is under an abuse of discretion standard."). The Court of Appeals for the District [**43] of Columbia Circuit states, however, that "[a] district court's ruling on laches does not qualify for deference if the court applied the wrong legal standard." *Daingerfield Island Protective Soc. v. Lujan, 287 U.S. App. D.C. 101, 920 F.2d 32,*

38 (D.C. Cir. 1990). Nevertheless, as the Fifth Circuit succinctly observes, "as long as the district court applies the correct legal standard on summary judgment and does not resolve disputed issues of material fact against the nonmovant, its determination of whether the undisputed facts warrant an application of laches is reviewed for abuse of discretion." *National Ass'n of Gov't Employees v. City Public Serv. Bd. of San Antonio, Tex., 40 F.3d 698, 707 (5th Cir. 1994)*.

IV. DISCUSSION

The Court first turns to the question of whether the TTAB appropriately concluded that the marks at issue disparage Native Americans or cause them to be brought into contempt or disrepute. The Court next turns to Pro-Football's claim of laches.

A. The Evidence Below is Insufficient to Conclude that During the Relevant Time Periods the Trademarks at Issue Disparaged Native Americans or Brought Them Into Contempt [**44] or Disrepute

Essentially, this appeal presents the question of whether the TTAB's decision that the registered marks "may disparage" Native Americans was supported by "substantial evidence." Under the *section 2(a) of the Lanham Act*:

> No trade-mark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it-

> (a) Consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage . . . persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute. . . .

15 U.S.C. § 1052(a). In reaching its decision, the TTAB concluded that the registrations at issue did not comprise "scandalous matter." *Harjo II, 50 U.S.P.Q.2d at 1748-49*. That decision has not been appealed and is not before this Court. The TTAB also conflated the "contempt or disrepute" inquiry with the "disparage" inquiry. *Id. at 1740*. In other words, the TTAB concluded that "the guidelines enunciated [in [*114] its opinion], in connection with determining whether matter in a mark [**45] may be disparaging are equally applicable to determining whether such matter brings 'persons, living or dead, institutions, beliefs, or national symbols into contempt or disrepute.'" *Id.* (quoting *15 U.S.C. § 1052(a)*). None of the parties argue that the TTAB's decision to treat "disparage" in the same manner as "contempt or disrepute" was error. Therefore, the Court has not reviewed this legal determination and in assessing the TTAB's decision, only reviews whether the marks at issue "may disparage" Native Americans, which includes whether the marks bring Native Americans into contempt or disrepute.

Pursuant to *section 14 of the Lanham Act* "any person who believes that he is or will be damaged by the registration of a mark" may file a petition to cancel a registration "within five years from the date

of the registration of the mark," or "at any time . . . if its registration was obtained fraudulently or contrary to the provisions of . . . subsection (a), (b), or (c) of *section 1052* of this title . . . ." *15 U.S.C. § 1064. Section 21 of the Lanham Act* entitles persons authorized to appeal to bring either a civil action in a federal [**46] district court or a direct appeal if they are dissatisfied with the decision rendered by the TTAB in a cancellation proceeding. *15 U.S.C. § 1071.* By undertaking a civil action, as opposed to a direct appeal to the Federal Circuit, the parties acknowledge that "the testimony and exhibits of the record in the Patent and Trademark Office, when admitted, shall have the same effect as if originally taken and produced in the suit." *Id. § 1071(b).* Moreover, this Court is not precluded from adducing further factual development of the record. *Id.* [16]

16 As discussed *supra*, neither of the parties have submitted new evidence on the question of whether the TTAB's finding of disparagement was supported by substantial evidence.

1. Standard of Review

After reviewing the arguments of the parties, particularly those of Defendants who advocate that the Court adopt a "clearly erroneous/thorough conviction" standard of review, Tr. 7/23/2003 at 56, the Court determines that its review [**47] of the TTAB's findings shall be commensurate with the "substantial evidence" standard of review articulated in the APA. In other words, the Court will reverse the TTAB's findings of fact only if they are "unsupported by substantial evidence." *5 U.S.C. § 706.* The United States Supreme Court recently held

that in the context of a review of a decision of the PTO in the Federal Circuit, the Federal Circuit was to apply the standard of review articulated in the APA. *Dickinson v. Zurko, 527 U.S. 150, 144 L. Ed. 2d 143, 119 S. Ct. 1816 (1999)* (reversing *en banc* decision of the Federal Circuit which held that "clearly erroneous" was the appropriate standard of review). Although the Supreme Court in *Zurko* left open which of the APA's review standards were appropriate, the Federal Circuit has since concluded that the APA's "substantial evidence" test is the appropriate review standard for findings of fact of the agency. *In re Gartside, 203 F.3d 1305, 1315 (Fed. Cir. 2000)*. In addition, the Federal Circuit has concluded that despite the fact that *Zurko* involved the Federal Circuit's review of a decision of the PTO, the Supreme [**48] Court's holding is applicable to findings of fact made by the TTAB. *Recot, Inc. v. Becton, 214 F.3d 1322 (Fed. Cir. 2000)*; *see also On-Line Careline Inc. v. America Online, Inc., 229 F.3d 1080, 1085 (Fed. Cir. 2000)* ("Nothing in these statutes suggests that the TTAB should receive any less deference on fact-finding than the BPAI.").

[*115] As a result of the fact that *Zurko* only applied to the review of the PTO by the Federal Circuit, courts have been somewhat divided on the question of whether a district court uses the APA "substantial evidence" standard of review for the TTAB's fact-finding. Nevertheless, in the Court's judgment, the better authority holds that district courts should also use the substantial evidence standard from the APA. [17] *See Mazzari v. Rogan, 323 F.3d 1000, 1005 (Fed. Cir. 2003)* ("Therefore, a reviewing court, *whether this court or the district court*, applies the 'substantial evidence' standard of

review to findings of fact made by the board.") (emphasis added); *CAE, Inc. v. Clean Air Engineering, Inc., 267 F.3d 660, 675 n.9 (7th Cir. 2001)* ("Furthermore, whether the aggrieved party elects [**49] direct review by the Federal Circuit or initiates a new action in the district court, both courts should apply the APA standard of review to the TTAB's fact-finding."); *but see U.S. Filter Corp. v. Ionics, Inc., 68 F. Supp. 2d 48, 52 (D. Mass. 1999)* ("I do not accept defendant's argument that *Zurko* has changed the standard of review that this court must apply in reviewing the PTO's finding of a valid patent."). [18]

17 The Supreme Court observed that it could find no opinion where a court stated that the difference between the "clearly erroneous" standard and the "substantial evidence" standard would have produced a different outcome. *Zurko, 527 U.S. at 162-63.* Based on this statement, Defendants argue that there is no difference in practice between the two approaches. Defs.' Opp'n at 6 (difference is "likely [to] be meaningless"); Tr. 7/23/2003 at 56. Defendants' argument is erroneous for two principal reasons. First, the Supreme Court said there is a difference between the two standards. *Zurko, 527 U.S. at 162* ("The upshot in terms of judicial review is some practical difference in outcome depending upon which standard is used. The court/agency standard, as we have said, is somewhat less strict than the court/court standard."). Second, the Supreme Court only observed that it could not find any case where a court had stated that a

different outcome would result from the use of different standards-not that the standards themselves were indistinguishable. *Id. at 163-63* (observing that the difference is a "subtle one").

[**50]

18 In *Material Supply International v. Sunmatch Industrial Co, 331 U.S. App. D.C. 42, 146 F.3d 983, 989-90 (D.C. Cir. 1998)*, the Court of Appeals for the District of Columbia Circuit stated the standard of review applicable to a district court's review of a decision of the TTAB:

> Although courts sometimes refer to the district court's review of the TTAB's decision as a "*de novo*" proceeding, *see, e.g., Spraying Sys. Co. v. Delavan, Inc., 975 F.2d 387, 391 (7th Cir. 1992)*; *Wilson Jones Co. v. Gilbert & Bennett Mfg. Co., 332 F.2d 216, 218 (2d Cir. 1964)*, that is something of a misnomer:
>
> While district court review is called "*de novo*" because new evidence may be introduced, it is a unique procedure because unlike a true de novo proceeding, findings of fact made by the [TTAB] are given great weight and not upset unless new evidence is introduced which carries thorough conviction.

> 3 [J. Thomas McCarthy, *McCarthy on Trademarks & Unfair Competition*] § 21:21, at 21-26 [(4th ed. 1997)].

Material Supply, 146 F.3d at 990. Although this Court cited the *Material Supply* standard in its December 11, 2000, Opinion, *Material Supply* predates the Supreme Court's holding in *Zurko* and, therefore, in this Court's judgment no longer states the appropriate legal standard for reviewing the TTAB's findings of fact. While the Court's December 11, 2000, Memorandum Opinion quoted the "thorough conviction" standard in the text of the opinion, it referenced the Supreme Court's recent decision in a footnote. *Harjo III, 57 U.S.P.Q. at 1142 n.2.* At that time, the issue was not ripe for resolution. After reflection on the case law and briefing on the subject, the Court finds that the substantial evidence test is the appropriate standard of review.

[**51] The substantial evidence standard requires the reviewing court to ask whether a "reasonable mind might accept" a particular evidentiary record as "adequate to [*116] support a conclusion." *Consolidated Edison Co. v. NLRB, 305 U.S. 197, 229, 83 L. Ed. 126, 59 S. Ct. 206 (1938); Zurko, 527 U.S. at 162.* Considered to be less deferential than the "arbitrary, capricious" standard, *see Gartside, 203 F.3d at 1312,* the "substantial evidence" standard requires a stricter judicial review of agency fact-finding than the "arbitrary, capricious" approach. *On-Line Careline, 229 F.3d at*

1085-86; *see also Universal Camera Corp. v. NLRB, 340 U.S. 474, 490, 95 L. Ed. 456, 71 S. Ct. 456 (1951)* ("The Board's findings are entitled to respect; but they must nonetheless be set aside when the record before a Court of Appeals clearly precludes the Board's decision from being justified by a fair estimate of the worth of the testimony of witnesses or its informed judgment on matters within its special competence or both."); *Zurko, 527 U.S. at 162* (observing that the Supreme Court has "stressed the importance of not [**52] simply rubber-stamping agency fact-finding") (citing *Universal Camera, 340 U.S. at 490*). The Supreme Court has stated that "substantial evidence is more than a mere scintilla." *Consolidated Edison, 305 U.S. at 229*; *id. at 230* (finding that "mere uncorroborated hearsay or rumor does not constitute substantial evidence"). A review for substantial evidence "involves examination of the record as a whole, taking into account evidence that both justifies and detracts from an agency's decision." *Gartside, 203 F.3d at 1312* (citing *Universal Camera, 340 U.S. at 487-88*).

2. The TTAB's Disparagement Conclusion is a Question of Fact

The Court concludes that the ultimate question of whether the six trademarks at issue "may disparage" Native Americans is a question of fact. Accordingly, Pro-Football bears a burden of submitting evidence or argument that the TTAB's decision on disparagement was not supported by substantial evidence. However, with regard to the legal standards applied in the proceeding below, the Court reviews the TTAB's conclusions on these issues *de novo*.

As discussed *supra*, the [**53] TTAB's findings of fact are reviewed under the substantial evidence test. However, while the Court is unable to find any helpful precedent on point, it would appear that, by analogy, there is a dispute in authority as to whether the "ultimate" question about whether a trademark "may disparage" would be treated as one of fact or one of law. The parties have not directly addressed this question in their papers. The Federal Circuit has held that the question of whether a trademark is scandalous under *section 2(a) of the Lanham Act* is treated as a question of law. *In re Mavety Media Group Ltd., 33 F.3d 1367, 1371 (Fed. Cir. 1994)* ("The determination that a mark comprises scandalous matter is a conclusion of law based upon underlying factual inquiries. . . . Therefore, while we review the Board's underlying fact findings for clear error, we review de novo the Board's ultimate legal conclusion of scandalousness."). In making this decision, the Federal Circuit analogized to cases involving "likelihood of confusion" scenarios.

The Court's research reveals, however, that the courts of appeals are split over whether, in the context of "likelihood of confusion" cases, the "ultimate" [**54] question as to whether the trademarks are similar is one of fact or of law. *Compare Scandia Down Corp. v. Euroquilt, Inc., 772 F.2d 1423, 1428 (7th Cir. 1985)* ("the question of likelihood of confusion is all fact and no law"), *with Jet, Inc. v. Sewage Aeration Sys., 165 F.3d 419, 422 (6th Cir. 1999)* ("Likelihood of confusion is a mixed question of fact and law. After a bench trial, [*117] we review a trial court's underlying factual findings for clear error but review *de novo* whether these

facts indicate a likelihood of confusion.") (internal citation omitted). The majority view, that the question is a pure question of fact, is considered to be "the better view." *Restatement (Third) of Unfair Competition § 21 cmt. m* (1995).

The Court agrees with the majority view. Whether the six trademarks disparage Native Americans is ultimately a fact-bound conclusion that rests with the fact-finder in the first instance. For example, had this been an original proceeding in this Court, the Court would have referred the question of whether the trademarks were disparaging to a jury. The issue of disparagement, like the issue of [**55] likelihood of confusion, requires a fact-based judgment that depends heavily on the particular circumstances of each case. The Third Circuit compellingly explained why a court should defer to a trial court's findings of fact in a likelihood of confusion case, which, by analogy, accurately reflects the situation that the Court currently faces:

> At the threshold we must determine the standard of appellate review applicable to a trial court's findings as to likelihood of confusion or lack thereof. This is an issue over which the courts of appeals have disagreed in the past. *See Elby's Big Boy of Steubenville, Inc. v. Frisch's Restaurants, Inc., 459 U.S. 916, 74 L. Ed. 2d 182, 103 S. Ct. 231 (1982)* (White, J., dissenting from denial of certiorari). Some courts have reviewed findings concerning likelihood of confusion under the "clearly erroneous" standard applicable to questions of fact, *see, e.g., Keebler Co. v.*

> *Rovira Biscuit Corp., 624 F.2d 366, 377 (1st Cir. 1980)*, while other courts, characterizing likelihood of confusion as a question of law, have engaged in *de novo* review of such findings, *see, e.g., Blue Bell, Inc. v. Jaymar-Ruby, Inc., 497 F.2d 433, 435 n.2 (2d Cir. 1974)*. [**56] To the extent that the latter approach rests on the perception that appellate courts are in as good a position as trial courts to evaluate evidence of likelihood of confusion, the validity of this approach has been largely undermined by the 1985 amendment to *Federal Rule of Civil Procedure 52(a)*. *See Scandia Down Corp. v. Euroquilt, Inc., 772 F.2d 1423, 1427-29 (7th Cir.1985), cert. denied, 475 U.S. 1147, 90 L. Ed. 2d 346, 106 S. Ct. 1801 (1986)*. This amendment made clear that a district court's conclusions cannot be regarded as pertaining to a "question of law"-and thus reviewed *de novo*-merely because they are based on evidence that is theoretically susceptible of independent evaluation by an appellate court. *Rule 52(a)* now requires appellate courts to apply the clearly erroneous standard to all findings of fact, "whether based on oral or documentary evidence."

American Home Products Corp. v. Barr Laboratories, Inc., 834 F.2d 368, 370 (3d Cir. 1987). The Court finds the Third Circuit's reasoning persuasive. Accordingly, the Court reviews the "ultimate"

question of whether the trademarks [**57] at issue "may disparage" Native Americans under the substantial evidence test. [19]

> 19 In the context of this particular case, however, as noted *infra*, it makes no practical difference to the Court's ultimate resolution of this case whether the review of this issue is under the substantial evidence test or is *de novo*.

Defendants correctly argue, therefore, that in this proceeding, "Pro-Football bears the burden of demonstrating that the TTAB's findings were unsupported by substantial evidence." Defs.' Opp'n at 4 (citing *Trans-Union Corp. v. F.T.C., 345 U.S. App. D.C. 301, 245 F.3d 809, 814-15 (D.C. Cir. 2001)*; *Cleary Gottlieb Steen & Hamilton v. Dep't of* [*118] *Health and Human Services, 844 F. Supp. 770, 783 (D.D.C. 1993))*. The Court of Appeals for the District of Columbia Circuit in *Trans-Union* re-affirmed the common understanding that a party making a substantial evidence challenge to an agency's decision has a responsibility to articulate why each particular finding [**58] is unsupported by substantial evidence. *Trans-Union, 245 F.3d at 815* ("To bring a substantial evidence challenge [to an agency's decision, a party] . . . must identify the specific findings it challenges and demonstrate that each finding is either unsupported by evidence or, because the Commission unreasonably discounted contrary evidence, unsupported by 'the record in its entirety.'") (quoting *Universal Camera, 340 U.S. at 488*). [20]

> 20 Interestingly, Defendants' reliance on *Trans-Union* would seem to undercut their argument that the substantial evidence test does not apply to this proceeding.

Pro-Football, however, argues that the Court of Appeals' decision in *Material Supply* compels a different result. Pl.'s Reply at 17 (citing *Material Supply, 146 F.3d at 990*). In the context of a district court review of a decision of the TTAB, the United States Court of Appeals for the District of Columbia Circuit stated:

> Because the TTAB decided against [**59] [Plaintiff] and [Plaintiff] sought review of that decision in district court, we think [Plaintiff] had the burden of going forward, that is, of submitting to the court evidence or argument to counter the decision of the TTAB. Nevertheless, because [Defendant] had the burden of proof before the TTAB *and because the district court must review the TTAB's decision* de novo, *[Defendant] must bear the burden of persuasion in district court.*

Material Supply, 146 F.3d at 990-91 (emphasis added). The proceedings in *Material Supply* differ from the instant proceedings, however, because that case involved a District Court's review of a TTAB's summary judgment decision. *Id. at 990.* A review of the TTAB's summary judgment conclusion, like any legal decision of the TTAB, is reviewed under a *de novo* standard of review. In this case, however, the proceedings below were not decided on summary

judgment motions, and as such, the TTAB, sitting as a finder of fact, must be awarded the deference befitting the procedural posture of this case.

Unquestionably, the Court reviews *de novo* the TTAB's decisions regarding the appropriate legal standards to [**60] apply to the case. *See In re International Flavors & Fragrances, Inc., 183 F.3d 1361, 1365 (Fed. Cir. 1999)* ("We review the Board's legal conclusions, such as its interpretation of the Lanham Act, *15 U.S.C. § 1051, et seq., de novo.*"). Accordingly, the legal standards used to make a finding of disparagement and any other questions of law are reviewed by this Court *de novo*.

* * *

The Court now turns its attention to the opinion of the TTAB in this case. The Court first analyzes the TTAB's sporadic attempts at findings of fact. These findings of fact, as discussed *supra*, are reviewed under the substantial evidence test. The Court then turns its attention to the legal principles adopted by the TTAB to help it resolve this case. The Court reviews the TTAB's legal principles *de novo*. Finally, the Court returns to the TTAB's application of the legal principles to its findings of fact and its determination that these findings demonstrate by a preponderance of the evidence that the trademarks at issue may disparage Native Americans. As the Court has indicated, it [*119] must review this decision under the substantial evidence test outlined [**61] above.

3. The TTAB's Findings of Fact

The Court's review of the TTAB's findings of fact is limited by necessity given the paucity of actual

findings of fact made by the TTAB. Even though it spent fourteen pages cataloging the evidence in the case, *Harjo II, 50 U.S.P.Q.2d at 1721-34*, the TTAB made specific findings of fact in only two areas: (1) linguists testimony, *id at 1731-32*, and (2) survey evidence, *id. at 1734*; *see also id. at 1721* ("Except for the testimony and related exhibits of the parties' linguistics experts and marketing and survey experts, we summarize the testimony and related exhibits of, first, petitioners' witnesses and, second, respondent's witnesses."). Since the TTAB only made specific findings of fact in two areas, it is only these two areas that are subject to court-scrutiny under the substantial evidence test. Therefore, the Court passes, at this stage, on ruling on Pro-Football's objections that much of the evidence admitted by the TTAB was inadmissible. These objections are best considered in the context of the legal framework, which the Court discusses, *infra*.

a. TTAB's Findings of Fact Regarding Linguists' [**62] Testimony

The TTAB only found with regard to the linguists' testimony that the term "redskin(s)" has been used historically as a reference for Native Americans and is still, understood in many contexts as a reference to Native Americans. *Harjo II, 50 U.S.P.Q.2d at 1731*. In addition, the TTAB found that since the-mid-1960's to the present, the term "redskin(s)" appears often only as a reference for the professional football club known as the Washington Redskins, that the term has not been used to refer to Native Americans during this time frame, and that

the words "Native American," "Indian," and "American Indian" have been used as a reference for Native Americans during this time frame. *Id.* The TTAB also found that until the middle of this century, Native Americans were often referred to in spoken and written language in a derogatory manner. *Id.* While many of these usage examples refer to Native Americans as Indians, the TTAB concluded that these terms had remained an acceptable reference for Native Americans during the second half of the twentieth century. *Id.*

In making specific findings of fact in this area, the TTAB culled from the evidentiary record findings of fact that were [**63] not disputed by the experts of each of the parties. Aside from the question of the relevance of these findings to the legal question presented by this case, *see infra*, it is impossible to say that these specific findings of fact are not supported by substantial evidence.

b. TTAB's Findings Regarding Dr. Ross's Survey

The Board basically made three findings of fact regarding this survey evidence. First, the Board found that the survey methodology was sound. *Id. at 1734.* Second, the TTAB found that the survey was nothing more than "a survey of current attitudes as of the time the survey was conducted." *Id.* Finally, the Board concluded that the survey adequately represents the views of the two populations sampled." *Id.*

First, the Court finds that there is substantial evidence for the narrow conclusion that the survey represents nothing more "than a survey of current attitudes at the time the survey was conducted." *Id.* This fact does not appear disputed by either [*120] side and therefore it would be difficult for the Court to conclude that this conclusion was not supported by substantial evidence.

In regard to the TTAB's decision that the survey methodology [**64] used was appropriate, the Court finds that there is substantial evidence to show that this methodology supported a survey that did nothing more "than survey . . . current attitudes." *Id.* However, to the extent that the TTAB's finding purported to hold that the methodology was proper to extrapolate the survey results to the Native American population at large, the Court must disagree that substantial evidence supports this conclusion.

First, the TTAB's opinion presents no defense to the critique by Dr. Jacoby that the survey improperly extrapolated the views of its respondents to the Native American population as a whole. *See id.* As discussed earlier, a review for substantial evidence "involves examination of the record as a whole, taking into account evidence that both justifies and detracts from an agency's decision." *Gartside, 203 F.3d at 1312* (citing *Universal Camera, 340 U.S. at 487-88*). Instead of explaining why Dr. Jacoby's critique was flawed, the Board concludes-with no explanation-that the survey "represents the views of the two populations sampled." *Id.* Dr. Jacoby's criticisms, while listed by the TTAB, are never engaged. They [**65] are simply cast aside with an empty phrase such as "no survey is perfect."

This case is not one where Dr. Jacoby testified before the TTAB and the TTAB members could observe the demeanor of this witness and reach conclusions as to whether to credit his testimony. The evidence for both Drs. Ross and Jacoby was on a cold record which ordinarily would require an explanation as to why evidence is credited or rejected. As discussed *supra*, Dr. Jacoby presented a highly detailed criticism of this survey's attempts at extrapolation. For example, Dr. Jacoby noted that the Ross Survey included Native Americans living in only twelve states, was deficient because it excluded large numbers of Native Americans living in Alaska and Hawaii, and was flawed because the survey included only two percent of all the counties in the United States. While the agency listed Dr. Jacoby's criticisms it never addressed them or rebutted them. Left completely unexplained, the Court cannot accept that the Ross Survey is a sufficient proxy for the views of Native Americans as a whole.

In this vein, the Court observes that in setting forth Dr. Jacoby's critiques again in their Rule 7.1(h) statement, Pro-Football [**66] essentially presented the Defendants with the opportunity to rebut the serious problems with the attempts of the survey to measure the attitudes of Native Americans as a whole. However, the Defendants merely responded by stating, "The Native American Parties do not dispute that Dr. Ross did not conduct a nationwide sample. The Ross Report explains the basis for Dr. Ross' methodology." Defs.' Opp'n Stmt. PP 95-97; *see also id.* PP 98-100. The glaring problem with this approach is that while the Ross Expert Report lays out the methodology used in the survey, it does not address Dr. Jacoby's critique that the survey is

incapable of being extrapolated, which is a different issue. *See* Pl.'s Mot., Ex. 196, Ross Rep. at

Finally, during the July 23, 2000, motions hearing, counsel for the Defendants stated, "If you take our survey evidence which says that 36 percent of Native Americans believe that the term is offensive to themselves, then that number come to somewhere between 700 and 800,000, using the number that [Pro-Football's counsel] gave us of 2.41 million Native [*121] Americans today." Tr. 7/23/2003 at 61. The Court immediately questioned the Defendants' counsel over this figure. [**67] This colloquy followed:

> THE COURT: . . . I'm trying to figure out where you came from 36 percent out of the survey to 700 and 800,000. MR. LINDSAY: Well, that's just plain arithmetic. THE COURT: I know. But what does it represent? I understand you did the arithmetic. But what I'm saying is, aren't you -- you're extrapolating that if 36 percent of the group of the survey felt this way, you then applied 36 percent to the whole population that are Native Americans. Is that accurate? MR. LINDSAY: Yes. THE COURT: And making an assumption, aren't you, then, that that is representative of what all the rest of them would feel? MR. LINDSAY: We're certainly saying that the survey that the TTAB accepted and rejected the methodological critique of the opposition, that that survey would say that yes, those views would hold for the Native American

> population, in general, if that's Your Honor's question.

Tr. 7/23/2003 at 61-62. Thus, even when presented with an opportunity to defend the extrapolation, the Defendants' counsel merely relied on the TTAB's decision to find that the survey represented the views of Native Americans as a whole. Moreover, the Defendants' counsel had no scientific [**68] basis for the extrapolation. Rather, at the hearing, he merely multiplied the percentages of the Ross Survey by the number of Native Americans allegedly living in the United States. While this might be a proper technique, there is no evidence in the record that this was how Dr. Ross arrived at his conclusion. There is also no evidence in the record as to the overall number of Native Americans who would share the view that the word "redskin(s)" was offensive to themselves. In fact, there is no discussion in either the Ross Report or the decision of the TTAB about the aggregate number of Native Americans that would find the term "redskin(s)" offensive when used as a reference for Native Americans.

The Court, therefore, concludes that the TTAB's decision to extrapolate the results of the Ross Survey to the Native American population as a whole was not supported by substantial evidence. Critiques by Dr. Jacoby went unanswered in the TTAB opinion. Conclusory statements such as "no survey is perfect" do not assist the Court in understanding the basis for accepting Dr. Ross's decision to extrapolate his results to the Native American population as a whole. Indeed, counsel at the July 23, 2003, motions

[**69] hearing came up with the extrapolation figure on the spot by doing "plain arithmetic" based on information not in the record. For all of these reasons, the Court concludes that the decision of the TTAB to extrapolate the Ross Survey results to the Native American population as a whole is not supported by substantial evidence. [21]

> 21 To the extent that the conclusion regarding extrapolation implicates Dr. Ross's methodology, the Court finds that the TTAB's decision that Dr. Ross's methodology was sound to not be supported by substantial evidence. Regarding the remainder of the Ross Survey's methodology, the Court has no occasion to reach the question of whether the TTAB's decision to accept it was supported by substantial evidence. The Court would point out that Dr. Jacoby's criticisms in this regard also went unanswered.

4. The TTAB's Legal Analysis

The legal standards applied by the TTAB to the evidence in this case is reviewed by this Court *de novo*. After reviewing the decision of the TTAB, the [**70] relevant authority, and the parties' pleadings, the Court finds that the TTAB correctly [*122] articulated the law to apply to disparagement cases.

> a. The Burden of Proof at the TTAB Level

The Court determines that the TTAB correctly held Defendants/Petitioners to a "preponderance of the evidence" standard, *Harjo II, 50 U.S.P.Q.2d at 1735 n.90*, rather than a "clear and convincing evidence" standard suggested by Pro-Football, Pl.'s Reply at 16. [22] In other words, Defendants/Petitioners at the agency level needed to demonstrate by a preponderance of the evidence that the challenged trademarks "may disparage" Native Americans or "bring them into contempt, or disrepute."

> 22 If the Court were reviewing the TTAB's decision on disparagement *de novo*, Pro-Football would encourage the Court to apply the "clear and convincing evidence" standard to this proceeding as well. However, the Court has determined that the TTAB's decision on disparagement is a question of fact reviewed under the substantial evidence test and therefore Defendants do not have the same burden that they had before the Board.

[**71] Pro-Football challenges this assertion by arguing that Defendants need to prove their case by "clear and convincing evidence." Pl.'s Reply at 15-16. In the usual course, a petitioner seeking a cancellation before the TTAB needs to prove his or her case by a preponderance of the evidence. *Material Supply, 146 F.3d at 990* (citing various authority). Pro-Football observes however that the clear and convincing evidence standard was employed in the case of *Woodstock's Enters., Inc. v. Woodstock's Enters., Inc., 1997 TTAB LEXIS 21, 43 U.S.P.Q.2d 1440 (T.T.A.B. 1997)*. Pl.'s Mot. at 16 n.18. However, the use of the "clear and convincing"

evidence standard in *Woodstock Enters.* was employed because the cancellation of the trademark was premised on fraud in the application. *Woodstock's Enters., 43 U.S.P.Q.2d at 1443* ("It does appear that the very nature of the fraud requires that it be proven 'to the hilt' with clear and convincing evidence."). This case does not involve any allegations of fraud in the application and, therefore, *Woodstock's Enters.* is inapplicable. [23] Pro-Football also cites to *Eurostar, Inc. v. "Euro-Star" Reitmoden GMBH & Co., 1994 TTAB LEXIS 29, 34 U.S.P.Q.2d 1266 (T.T.A.B. 1995)* [**72] to support its position that a "clear and convincing" evidentiary standard should apply. Pl.'s Mot. at 16 n.18. However, in *Eurostar* the court suggested the "clear and convincing" evidentiary standard because the case involved a cancellation of a trademark due to abandonment. *Eurostar, 34 U.S.P.Q.2d at 1273* (Simms, administrative trademark judge, concurring) ("Moreover, we should keep in mind that abandonment is generally regarded as a forfeiture of rights and the courts and the Board have required strict or clear and convincing proof before finding abandonment."); *but see Cerveceria Centroamericana, S.A. v. Cerveceria India, Inc., 892 F.2d 1021, 1024 (Fed. Cir. 1989)* (applying preponderance of the evidence standard to abandonment proceeding). As the instant case does not involve an abandonment of the trademark [*123] at issue, *Eurostar* is equally inapplicable. Finally, Pro-Football vaguely alleges that because its *First Amendment* interests are at stake, clear and convincing evidence is required. Pl.'s Mot. at 16 n.18 (citing *Gertz v. Robert Welch, 418 U.S. 323, 41 L. Ed. 2d 789, 94 S. Ct. 2997 (1974)).* This Court has

delayed ruling on the constitutional questions [**73] and even putting that aside, *Gertz* involved a libel claim, which as Defendants point out, is similar to a claim of fraud in that it requires a heightened standard of proof. Defs.' Opp'n at 5 n.1.

> 23 The Court disagrees with Pro-Football's assertion that because both a fraud case and a disparagement case involve assessing a situation at the time a registration was made, a "clear and convincing" standard is required. Pl.'s Reply at 17. As the Court in *Woodstock's Enters.* observed, it is "*the very nature of the fraud* [that] requires that it be proven 'to the hilt' with clear and convincing evidence." *Woodstock Enters., 43 U.S.P.Q.2d at 1443* (emphasis added). Given that fraud involves an allegation of a proof of an intent to deceive, courts require a heightened standard of proof-not, as Plaintiffs allege, because the Court needs to review evidence of something that occurred in the past.

Instead, of a "clear and convincing evidence" standard, the Court concludes that a "preponderance [**74] of the evidence" standard applied to the Defendants' burden during the TTAB proceeding. *Harjo II, 50 U.S.P.Q.2d at 1735 n.90.* Unfortunately, the TTAB failed to remark that in the context of cancellation proceedings where a lengthy period of time ensues between registration and the cancellation request, the Board is required to pay even closer attention to the proof adduced to buttress the cancellation request. A popular and oft-cited commentary on trademarks observes:

> The registrant in a cancellation proceeding is entitled to the prima facie presumption that the registration and the mark are valid, that registrant is the owner and that registrant has the exclusive right to use the mark. Thus, cancellation of a valuable registration around which a valuable business good will has been built, should be granted only with "due caution and after a most careful study of all the facts." The Court of Customs and Patent Appeals has stated that in cancellation proceedings:
>
> The defendant [respondent] in such proceedings is one who has obtained substantial rights from the Government upon or about which he may have built a large and, of course, legitimate business. [**75] The cancellation of one's trademark [sic] may prove destructive to the business built about it. Surely, no registration should be cancelled hastily and without a most careful study of all the facts.

3 McCarthy, *supra*, § 20:64, at 117-18 (footnotes omitted) (cited with approval in *Material Supply, 146 F.3d at 989-90*). Moreover, as the Court of Customs and Patent Appeals once said, "the longer a party waits, after the time for bringing an opposition has expired, to commence a cancellation proceeding, the greater may be the number of facts (e.g., evidence of actual confusion) to be considered in

determining the quantum of proof required." *Massey Junior Coll., Inc. v. Fashion Inst. of Tech., 492 F.2d 1399, 1402 (C.C.P.A. 1974).*

The TTAB's decision is silent on whether it paid cautious heed to the admonition that in proceedings where a party has waited longer to bring a cancellation petition, that party has a very serious burden of making its case, even though the standard of proof is not technically different and remains "a preponderance of the evidence." Nevertheless, the Board stated that it applied the preponderance of the evidence standard [**76] and that is all that the case law requires. Therefore, reviewing *de novo* the decision of the TTAB, the Court finds that the preponderance of the evidence standard adopted by the Board in the proceedings below was appropriate. [24]

24 Although Pro-Football relies on *United States Filter Corp.* for the proposition that a "clear and convincing" standard applies, the Court finds that case inapplicable because it was a patent infringement proceeding, which differs from the instant cancellation proceeding. Pl.'s Reply at 16 (citing *United States Filter Corp., 68 F. Supp. 2d at 52*); *see also* McCarthy, *supra*, § 20:64 ("The Federal Circuit has stated that because a presumption of validity attaches to the registered mark, the party seeking cancellation must rebut this presumption by a preponderance of the evidence.") (citing *West Fla. Seafood v. Jet Restaurants, 31 F.3d 1122, 1125 (Fed. Cir. 1994)*; *see also Cerveceria Centroamericana, 892 F.2d at 1023.*

[**77]

[*124] b. The Meaning of "May Disparage"

After acknowledging the dearth of precedent to guide their hand in interpreting the disparagement clause of *section 2(a), Harjo II, 50 U.S.P.Q.2d at 1737*, the TTAB approached the task as it would a charge of scandalousness under *section 2(a). Id.* No party disputes this approach and the Court finds no error in treating the two as similar for purposes of developing a conceptional framework. First, the TTAB has not conflated the two approaches and has made sure to note differences where appropriate. Second, the TTAB has noted the dearth of legislative history on the disparagement provision in *section 2(a). Id. at 1737 n.98.* Given the lack of legislative history as a guide, and the TTAB's efforts to adjust the scandalousness framework for the disparagement inquiry, the Court finds no error in the TTAB's approach.

The TTAB first defined the term "disparage" in accordance with the ordinary and common meaning of the term. *Id.* From this review, the Board concluded that the trademarks may disparage if they may "dishonor by comparison with what is inferior, slight, deprecate, degrade, or affect or injure by unjust [**78] comparison." *Id.* The Board then observed that unlike the inquiry into whether a trademark is scandalous, where the test looks to the reaction of American society as a whole, a disparagement test is much more circumscribed and is limited by *section 2(a) of the Lanham Act. Id.* The

TTAB stated that "it is only logical that in deciding whether the matter may be disparaging we look, not to American society as a whole, . . . but to the views of the referenced group." *Id. at 1739*. The views of the referenced group, the Board concluded, are "reasonably determined by the views of a substantial composite thereof." *Id.* (citing *In re Hines, 31 U.S.P.Q.2d 1685, 1688 (T.T.A.B. 1994), vacated on other grounds 32 U.S.P.Q.2d 1376 (T.T.A.B. 1994)*). To determine the referenced group, the TTAB adopted the test from *In re Hines*, which looks to "the perceptions of 'those referred to, identified or implicated in some recognizable manner by the involved mark.'" *Harjo ii, 50 U.S.P.Q.2d at 1740* (quoting *Hines, 31 U.S.P.Q.2d at 1688*) ("In determining whether or not a mark is disparaging, the perceptions of the general public are irrelevant. [**79] Rather, because the portion of *section 2(a)* proscribing disparaging marks targets certain persons, institutions or beliefs, only the perceptions of those referred to, identified or implicated in some recognizable manner by the involved mark are relevant to this determination."). [25] As the parties have not objected to this approach and because this approach is often used in cancellation [*125] proceedings, the Court does not find legal error in applying it to this proceeding.

25 The Board observed that the question of "who comprises the targeted, or relevant, group" must be answered "on the basis of the facts in each case." *Harjo II, 50 U.S.P.Q.2d at 1739* ("For example, if the alleged disparagement is of a religious group or its iconography, the relevant group may be the

> members and clergy of that religion; if the alleged disparagement is of an academic institution, the relevant group may be the students, faculty, administration, and alumni; if the alleged disparagement is of a national symbol, the relevant group may be citizens of that country.").

[**80] In addition, the TTAB concluded that the addition of the term "may" before the word "disparage" in the *Lanham Act* was to "avoid an interpretation of this provision which would require an intent to disparage." *Id. at 1738* (noting that such an interpretation shifts the focus to whether the matter may be perceived as disparaging). This conclusion is also not disputed by the parties.

Most importantly, the TTAB pointed out that "the question of disparagement must be considered in relation to the goods or services identified by the mark in the context of the marketplace." *Id.* (citing *Doughboy Indus., Inc. v. The Reese Chem. Co., 88 U.S.P.Q. 227 (Pat. Off. 1951)).* In the *Doughboy* case, the Examiner-in-Chief of the Patent Office observed, "that a trade mark was unregistrable if it was scandalous by reason of the particular goods in connection with which it was used and this same interpretation, it is believed, should also apply to *section 2(a)* of the new Act, not only in connection with scandalous matter, but also in connection with matter which may disparage persons." *Doughboy Indus., Inc., 88 U.S.P.Q. at 228.* In *Doughboy*, the Patent Office [**81] denied the registration for DOUGH-BOY for an anti-venereal preparation. *Id. at 227.* The Patent Office observed that the mark DOUGH-BOY, a name for American soldiers in World War I, was disparaging *in connection with* an

anti-venereal prophylactic preparation; particularly given its packaging which featured depictions of American soldiers. *Id. at 228.* Based on this case, the TTAB appropriately concluded that:

> To ascertain the meaning of the matter in question, we must not only refer to dictionary definitions, but we must also consider the relationship between the subject matter in question and the other elements that make up the mark in its entirety; the nature of the goods and/or services; and the manner in which the mark is used in the marketplace in connection with the goods and/or services.

Harjo II, 50 U.S.P.Q.2d at 1739. The Court finds no error in this approach.

c. Determining if a Trademark is Disparaging

The Court concludes that the TTAB correctly stated the test for disparagement and neither of the parties specifically dispute this approach. The Board stated:

> Our analysis is essentially [**82] a two-step process in which we ask, first: What is the meaning of the matter in question, as it appears in the marks and as those marks are used in connection with the services identified in the registrations? Second, we ask: Is this meaning one that

> may disparage Native Americans? As previously stated, both questions are to be answered *as of the dates of registration of the marks herein.*

Id. at 1741 (emphasis in original). Since the oldest trademark in this case was issued in 1967 and the newest was issued in 1990, the Board "focused its determination of the issue of disparagement on the time periods, between 1967 and 1990, when the subject registrations issued." *Id.* None of the parties contest this approach and the Court finds no error in the TTAB's articulation of this test for disparagement.

5. The TTAB's Finding of Disparagement

The Court concludes that the TTAB's finding that the marks at issue "may disparage" Native Americans is unsupported [*126] by substantial evidence, is logically flawed, and fails to apply the correct legal standard to its own findings of fact. With no material facts in dispute, the Court finds that Defendants' motion for summary judgment [**83] must be denied, and that Pro-Football's motion must be granted as to the Counts I and II of the Complaint. The Court will first turn to the TTAB's discussion of the "meaning of the matter in question," and then will focus on the TTAB's decision that the matter "may disparage" Native Americans. [26]

> 26 It is important to point out that the TTAB rejected the Defendants' argument that the use of Native American references or imagery by

non-Native Americans is *per se* disparaging to Native Americans. *Harjo II, 50 U.S.P.Q.2d at 1743*. This decision has not been appealed. In addition, because the evidence below tended to revolve exclusively around the disparaging nature of the term "redksin(s)," there was "very little evidence or argument" related to the portrait of a Native American or the Native American spear in Pro-Football's trademarks. *Id.* Given this lack of evidence, the TTAB concluded that the Defendants' had not established that the picture of the Native American and the Native American spear "may disparage" Native Americans. *Id.* This finding has also not been appealed.

[**84]

a. Meaning of the Matter In Question

The Court concludes that substantial evidence exists in the record to support the TTAB's finding that "when considered in relation to the other matter comprising at least two of the subject marks and as used in connection with [Pro-Football]'s services, 'Redskins' clearly both refers to respondent's professional football team and carries the allusion to Native Americans inherent in the original definition of that word." *Id. at 1742* (noting that this conclusion is equally applicable to the time periods encompassing 1967, 1974, 1978 and 1990, as well as to the present time"). The TTAB began its analysis by focusing on the word "redskin(s)" as it appears in each of the six challenged trademarks. *Id. at 1741*. The TTAB observed that one denotive meaning of

the word was a Native American person. *Id.* The TTAB observed that dictionary definitions and articles that refer to the word "redskin(s)" in connection with Native Americans indicate the term has remained a denotive term for Native Americans from the 1960's to the present. *Id.*; *see also id.* n.109. The TTAB, however, also agreed with Pro-Football that "there is [**85] a substantial amount of evidence in the record establishing that, since at least the 1960's and continuing to the present, the term 'Redskins' has been used widely in print and other media to identify [Pro-Football's] professional football team and its entertainment services." *Id. at 1741.*

Nevertheless, the TTAB observed that, in focusing on the manner in which Pro-Football's trademarks were actually used in the marketplace, the Washington Redskins football club used Native American imagery throughout its logos and team imagery. *Id. at 1741-42.* The TTAB found that although the record disclosed that the vast majority of the use of the term "redskin(s)" in the media and press since the 1960's refers to the Washington football club, "it would be both factually incomplete and disingenuous to ignore the substantial evidence of Native American imagery used by [Pro-Football], as well as by [Pro-Football's] fans, in connection with [Pro-Football's] football team and its entertainment services." *Id. at 1742.* Indeed, the TTAB noted that two of the registered marks include a portrait of the profile of a Native American and what presumably is a Native [*127] American spear. *Id.* [**86] Given this situation the TTAB remarked:

> This is not a case where, through usage, the word "redskin(s)" has lost its meaning, in the field of professional football, as a reference to Native Americans in favor of an entirely independent meaning as the name of a professional football team. Rather, when considered in relation to the other matter comprising at least two of the subject marks and as used in connection with respondent's services, "Redskins" clearly both refers to respondent's professional football team and carries the allusion to Native Americans inherent in the original definition of that word.

Id. Based on the record before the TTAB, the Court finds that this conclusion is supported by substantial evidence.

b. Whether the Matter in Question May Disparage Native Americans

The Court determines that the TTAB's conclusion that the six trademarks may disparage Native Americans is not supported by substantial evidence. The Board began by correctly articulating the question before it as "whether the word <redskin(s)' may be disparaging of and to Native Americans, as that word appears in the marks in the subject registrations, in connection [**87] with the identified services, and during the relevant time

periods." *Id. at 1743.* In answering this question and rendering its opinion, the Board made a number of initial statements that are problematic.

In rendering its decision, the TTAB stated that "we consider the broad range of evidence in this record as relevant to this question either *directly* or by inference." *Id.* (emphasis added). The difficulty with this statement is transparent. Even a cursory review of the TTAB's findings of fact reveals that there is no *direct* evidence in the findings that answers the legal question posed by the TTAB. None of the findings of fact made by the TTAB tend to prove or disprove that the marks at issue "may disparage" Native Americans, during the relevant time frame, especially when used in the context of Pro-Football's entertainment services. For example, none of the findings of fact related to the linguistic testimony tended to directly prove that the marks at issue "may disparage" Native Americans as used in connection with Pro-Football's football club during the relevant times at issue. Indeed, the TTAB said it was unable to resolve the dispute between the linguists related [**88] to the connotation of the word "redskin(s)" as used in Pro-Football's team name. *Id. at 1731.* Moreover, even if the Court considers all of the findings of fact related to the survey evidence, the survey is not directly dispositive of the legal question before the TTAB because it asked participants for views about the word "redskin(s)" as a reference for Native Americans in 1996. The survey did not test the participants' view of the term "redskin(s)" in the context of Pro-Football's services and it did not measure the attitudes of the survey participants as they were held during the relevant time periods.

While the TTAB noted that such information would have been "extremely relevant," *id. at 1743*, the fact remains that the TTAB did not have what would be considered "direct" or circumstantial evidence before it, or evidence from which it could draw reasonable inferences for such a conclusion.

Second, in finding that the trademarks "may disparage" Native Americans, the TTAB stated that "no single item of evidence or testimony alone brings us to this conclusion; rather, we reach our conclusion *based on the cumulative effect of the entire record.*" *Id. at 1743* (emphasis [**89] added). The troubling [*128] aspect of this statement is that the Board made findings of fact in only two very specific areas; and many of these findings of fact simply summarized undisputed testimony. As a result, many of the TTAB's findings of fact never involved weighing conflicting evidence or addressing criticisms of some of the evidence. The TTAB compounded this problem by declining to make specific findings of fact in key areas. *See, e.g., id. at 1731* ("To some extent, this testimony is self-serving and the opinions of the different individuals seem to negate each other's assertions, which offsets whatever probative value could be attributed to this portion of their testimony."). The result of this approach is that the TTAB reached its decision to cancel the trademarks inferentially, by piecing together bits of limited, undisputed evidence from the record. Even though the Court defers to the TTAB's inferences under the rubric of a substantial evidence review, the TTAB's approach is flawed because as will be demonstrated *infra*, the inferences are predicated on assumptions that are not contained anywhere in the record.

As the Court explains *infra*, the decision of the [**90] TTAB cannot withstand even the deferential level of judicial scrutiny provided by the substantial evidence test. While a *de novo* test to the TTAB's findings of fact might have led to an immediate reversal, due to the paucity of actual findings of fact, the substantial evidence test counsels otherwise and requires that the Court not substitute its judgment for that of the TTAB. Instead, the Court reviews point-by-point whether "substantial evidence" supports the TTAB's disparagement finding.

(1) *Equating the Views of the General Public with Those of Native Americans*

In rendering its decision, the TTAB stated that "we have considered the perceptions of both the general public and Native Americans to be probative [to determining if the marks at issue 'may disparage']." *Id. at 1743*. The TTAB went on to state:

> For example, we have found that the evidence supports the conclusion that a substantial composite of the general public finds the word "redskin(s)" to be a derogatory term of reference for Native Americans. *Thus, in the absence of evidence to the contrary, it is reasonable to infer that a substantial composite of Native Americans would similarly* [**91] *perceive the word.* This is consistent with the testimony of the petitioners.

Id. at 1743-44 (emphasis added). The problem with this approach is manifest.

First, and most importantly, the Ross survey indicates that the views of the general populace and the Native American population are distinct. *Harjo II, 50 U.S.P.Q.2d at 1733* (36.6% of Native Americans view the term "redskin" offensive as a term of reference for Native Americans, compared to 46.2% for the general population). Thus, the evidence before the TTAB indicated that the views of the Native Americans on this issue were not congruent with that of the population as a whole.

Second, the legal question before the TTAB only pertained to whether a "substantial composite" of Native Americans would conclude that the term "redskin(s)" may disparage. As the Board itself stated only five pages earlier in its opinion, "it is only logical that, in deciding whether the matter may be disparaging, *we look, not to American society as a whole*, as determined by a substantial composite of the general population, but to the views of the referenced group." *Id. at 1739* [*129] (emphasis added); *id.* (quoting *Hines, 31 U.S.P.Q.2d at 1688*) [**92] ("'In determining whether or not a mark is disparaging, *the perceptions of the general public are irrelevant*.'") (emphasis added). By concluding that the views of the general public were probative, the TTAB erred. By focusing on the general public and inferring that the Native Americans would simply agree with those views, the TTAB made a decision unsupported by substantial evidence.

Third, outside the testimony of the seven Native Americans who brought suit, the TTAB cited no independent or additional evidence to support its

conclusion. Defendants clearly do not constitute a "substantial composite" of Native Americans. From this testimony it was impossible for the Board to reasonably corroborate its decision to equate the views of the American public with the views of the Native American population.

Fourth, the TTAB reached this conclusion only because there was an "absence of evidence to the contrary," *Harjo II, 50 U.S.P.Q.2d at 1744*, thus, completely shifting the burden of proof in the wrong direction. This is not a case of the TTAB simply crediting unrebutted evidence. Indeed, the Ross survey and other evidence clearly demonstrates that the views of Native Americans do not [**93] necessarily correlate with the views of the general population. At the very least, there was other evidence in the record that the TTAB ignored in making this finding. [27] Since Defendants had the burden of proving their case by a preponderance of the evidence in the proceeding below, the TTAB, by making this statement, impermissibly shifted the burden to Pro-Football. Consequently, the Court is unable to conclude that this finding is supported by substantial evidence.

27 The statement by the TTAB that there was no evidence to the contrary is belied by the fact that Pro-Football had introduced two news articles as evidence in the proceeding below that Native Americans use the term "redskin(s)" interchangeably with the term "Indian" as a reference for Native Americans. Pl.'s Opp'n at 32 (citing Pl.'s Stmt. PP 273, 287). The TTAB did not indicate in its opinion that it was not crediting this evidence.

> Although not considered by the TTAB in the record below, it certainly is not fair to say that there was no evidence in the record to support a contrary view. While the Defendants object to these news articles on reliability and hearsay grounds, *see* Def.'s Opp'n Stmt. PP 273, 287, and in the case of one of the articles on the ground that the writer was being "sarcastic," *id.* P 273, these articles certainly could have been considered by the Board according to the Defendants' own arguments. Indeed, it is the Defendants who vociferously argue that "the Federal Rules of Evidence do not apply to agency proceedings," Defs.' Opp'n at 7, in seeking to persuade the Court that even evidence inadmissible under the federal rules can be considered "substantial evidence." Thus, under the Defendants' own logic the Board could have considered this evidence and it was error for the Board to say that there was no evidence to the contrary on this point without addressing this evidence in some manner.
>
> [**94]
>
> (2) *The Derogatory Nature of the Word "redskin(s)"*

The TTAB began by discussing the term "redskin(s)," decoupled from Pro-Football's entertainment services. Putting aside the relevance of this sojourn into linguistics, the Board concluded that "the word 'redskin(s)' has been considered by a substantial composite of the general population, *including by inference Native Americans*, a

derogatory term of reference for Native Americans during the time period of relevance herein." *Id. at 1746* (emphasis added). As the Court has already explained, the TTAB's decision to conflate the views of the general population with those of Native Americans cannot be supported by substantial [*130] evidence. Nevertheless, even a review of the evidence that supports this conclusion leads the Court to conclude that the TTAB's finding on this point was not supported by substantial evidence. The Court examines this evidence in turn.

(a) Dictionary Evidence

In support of the proposition that the term "redskin(s)" was a derogatory term for Native Americans, the TTAB first turned its attention to the dictionary definitions that were in evidence. As discussed *supra*, the TTAB had refused [**95] to make findings about the expert testimony surrounding the definitions and therefore only had the dictionary definitions, themselves, to consider. The TTAB observed that half of the dictionaries in the record contained a usage label indicating, for example, that the word "redskin(s)" is "often offensive," "informal," or "offensive slang." Half of the dictionaries did not have any usage labels. Based solely on this evidence, the TTAB wrote that "from the fact that usage labels appear in approximately half of the dictionaries of record at any point in the time period covered, we can conclude that a not insignificant number of Americans have understood 'redskin(s)' to be an offensive reference to Native Americans since at least 1966." *Id. at 1744.*

There are a number of concerns that the Court has with this conclusion. First, the TTAB expressly found that it would not make findings on the conflicting linguistic expert testimony that related to the "significance to be attached to the usage labels, or the lack thereof." *Id. at 1732.* Even though it made this statement, the TTAB still made a finding about the significance to be attached to the usage labels in the dictionary. The [**96] TTAB's conclusion is without any basis because there is no evidence in the record that was credited as to the purpose and methodology for including or not including usage labels in dictionaries or an explanation as to the basis for their conclusion. There are no findings of fact to support the TTAB's conclusion; rather, it is mere speculation on the part of the TTAB that this is the case.

Second, the fact that a "not insignificant number of Americans have understood "redskin(s)" to be an offensive reference to Native Americans," has nothing to do with whether Native Americans, themselves, consider the term "offensive," which would obviously be more probative or relevant. Third, the dictionary evidence only states that the term "redskin(s)" is "often offensive," which, as Pro-Football observes, means that in certain contexts the term "redskin(s)" was not considered offensive. Pl.'s Mot. at 27. In fact, the TTAB concluded that the term "redskin(s)" means both a Native American and the Washington-area professional football team. The fact that it is usually offensive may mean the term is only offensive in one of these contexts. There is not a discussion of this possibility in the TTAB's [**97] opinion. Moreover, as Defendants' own expert observed, "disparaging and offensive are two

different words and mean two different things." Pl.'s Stmt. P 124.

Finally, the dictionary evidence was, at best, equivocal. The TTAB observed in a footnote that:

> In view of the contradictory testimony of the parties' linguistics experts regarding the significance of a lack of usage label for a dictionary entry, we cannot conclude that the lack of such labels in the other excerpts of record establishes that the word "redskin(s)" was *not* considered offensive during the relevant time period.

Harjo II, 50 U.S.P.Q.2d at 1744 n.114 (emphasis in original). [*131] By the same token, however, the conflicting linguist expert testimony should not necessarily lead to a finding that usage labels establish that the term "redskin(s)" was necessarily considered offensive by the American public. Accordingly, the Court finds that the TTAB's findings related to the significance of the dictionary evidence are not supported by substantial evidence.

(b) Historical Evidence

The TTAB next deviated into a lengthy discussion of the history of the term "redskin(s)." The TTAB observed [**98] that it had found that during the late 1800's and early 1900's that the vast majority of evidence which included the word "redskin(s)" as a reference for Native Americans, portrayed Native Americans in a "derogatory manner." *Id. at 1744.* [28] The TTAB then observed

that the evidence demonstrates that by the 1930's through the late 1940's the word "redskin(s)" as a reference for Native Americans "reflected a slightly less disdainful, but still condescending, view of Native Americans." *Id. at 1745.* However, the TTAB then states that "from the 1950's forward, the evidence shows, and neither party disputes, that there are minimal examples of uses of the word 'redskin(s)' as a reference to Native Americans." *Id.* During this same time period the TTAB noted that the record reflects "significant occurrences of the word 'redskin(s)' as a reference to [Pro-Football's] football team." *Id.* From this latter evidence, the TTAB stated:

> We conclude from the evidence of record that the word "redskin(s)" does not appear during the second half of this century in written or spoken language, formal or informal, as a synonym for "Indian" or "Native American" because it is, and has [**99] been since at least the 1960's, perceived by the general population, which includes Native Americans, as a pejorative term for Native Americans.

Id. The Court determines that this finding is also not supported by substantial evidence because no concrete evidence supports this conclusion.

> 28 Although the TTAB found that the expert testimony was undisputed on this point, *Harjo II, 50 U.S.P.Q.2d at 1731*, it appears that this testimony was not completely undisputed, *id.*

> *at 1744 n.116* (observing that Pro-Football's expert found the term to be used in a neutral, if not positive, fashion). The TTAB disagreed, without explanation, with Pro-Football's expert. Although not particularly relevant ultimately to the Court's conclusion, the Court observes that the TTAB completely failed to recognize this testimony while discussing the historical evidence.

First, the TTAB agreed with Pro-Football, that "the pejorative nature of 'redskin(s)' in the early historical writings of record comes [**100] from the overall negative viewpoints of the writings." *Id.* Despite this finding, the TTAB merely assumed that because the term "redskin(s)" dropped out of use as a term for Native Americans it must have been because the term was derogatory. There is no evidence in the record to support this finding one way or the other. Concerned with adopting witness testimony that reached the ultimate legal question, the TTAB did not make findings regarding the significance of the use of the word from the 1960's onward. *Id. at 1731.* However, the ultimate legal inquiry is whether the six trademarks at issue may disparage Native Americans when used in connection with Pro-Football's services and during the relevant time frame. The ultimate legal inquiry is not whether the term "redskin(s)" is a pejorative term for Native Americans. Accordingly, the [*132] TTAB's reluctance to make findings in this area deprives the Court of meaningful review. There is no evidence to support the conclusion that the drop-off of the use of the term "redskin(s)" as a reference for Native Americans is correlative with a finding that the term is pejorative. Accordingly, the Court finds

that this finding is unsupported by [**101] substantial evidence. [29]

29 The TTAB also stated:

> We find the context provided by Dr. Hoxie's historical account, which [Pro-Football] does not dispute, of the often acrimonious Anglo-American/Native American relations from the early Colonial period to the present to provide a useful historical perspective from which to view the writings, cartoons and other references to Native Americans in evidence from the late 19th century and throughout this century.

Harjo II, 50 U.S.P.Q.2d at 1745 (footnote omitted). The Court agrees with Pro-Football, that this testimony is plainly irrelevant to the legal question before the TTAB. *See* Pl.'s Mot. at 22-23. There is no question that the history of the treatment of Native Americans in this country has been tragic. Nevertheless, the history of Native Americans has nothing to do with whether the trademarks at issue may disparage Native Americans in the context of Pro-Football's services and during the relevant time frame Furthermore, the TTAB expressly declined to make findings of fact regarding Dr. Hoxie's testimony.

[**102]

(c) Survey Evidence

As discussed earlier, the Court found the TTAB's conclusion that the survey could be extrapolated to the Native American population as a whole to be unsupported by substantial evidence. Nevertheless, to the extent that the survey would be even included in the calculus, the Court determines that it does not support the TTAB's decision that the word "redskin(s)" was viewed by a substantial composite of Native Americans to be a derogatory term of reference for Native Americans from the mid-1960's to 1990. The survey measures attitudes of Native Americans about their perceptions of the term "redskin" as used as a reference to Native Americans in *1996*. The survey, therefore, is entirely irrelevant to the question before the Board.

As the TTAB itself observed, "neither [the fact that the survey measured the views of individuals not alive at the time of registration of certain of the trademarks or the fact that the survey did not consider participants' views of the word 'redskin(s)' as used in connection with Pro-Football's entertainment services] diminishes the value of petitioners' survey for what it is--a survey of *current* attitudes towards the word [**103] "redskin(s)" as a reference to Native Americans." *Id. at 1734* (emphasis added). The TTAB has no evidence, therefore, to draw a conclusion that during the relevant time periods, i.e. 1967, 1974, 1978, and 1990, the term Native Americans was a pejorative term for Native Americans. [30] Putting aside the fact that the survey results have no bearing on Native Americans perceptions of the term "redskin(s)" as

used in connection with the Pro-Football's professional sports team, the survey tells us nothing about the relevant time frame. [31] Accordingly, it fails to [*133] support with substantial evidence the TTAB's finding that the term "redskin(s)" is viewed by a substantial composite of Native Americans as a derogatory term for Native Americans. [32]

30 Indeed, during this time frame, several different PTO examiners reviewed the Redskins marks and none came to the conclusion that the trade marks were disparaging. *See 15 U.S.C. § 1052(a)*; Pl.'s Opp'n at 32-33.

31 For example, while a word like "redskin(s)" may have been accepted as an informal term for a Native American in 1967, by 1996, attitudes of people may have changed as Native American culture became increasingly accepted and respected. The TTAB addressed this argument in a footnote stating that Pro-Football "has presented no evidence suggesting that, as a term identifying Native Americans, the perception of the derogatory nature of the word 'redskin(s)' by any segment of the general population, including Native Americans changed significantly during this time period." *Harjo II, 50 U.S.P.Q.2d at 1746 n.121* (observing that the evidence in the record supports the conclusion that the term "redskin(s)" has been viewed by Native Americans a derogatory word since at least the 1960s). The difficulty with the TTAB's statement is that, as the Court has discussed at length in this section, there is no evidence or

findings of fact made by the TTAB that a substantial composite of Native Americans view the term "redskin(s)" as derogatory as a reference for Native Americans. Hence, it is not as if the TTAB was crediting some unrebutted testimony in making this finding.

[**104]

32 The survey evidence, that Native Americans find the term "redskin(s)" offensive as a term for Native Americans, does not even represent a majority of Native Americans polled. Indeed only 36.6 of Native Americans agreed with that statement. While the TTAB found that 36.6 was a substantial composite, *Harjo II, 50 U.S.P.Q.2d at 1746 n.120* (quoting McCarthy, *supra*, § 32.185) (noting that in cases dealing with likelihood of confusion, "an appreciable number of customers" may be less than a majority), the Court finds that conclusion difficult to support in the context of this case. The survey only found that 131 out of the 358 participants agreed that this term was offensive when used as a reference to Native Americans. This Court, accordingly, finds that the survey results do not demonstrate that a "substantial composite" of Native Americans found the term offensive as a reference for Native Americans.

(3) *The Word "redskin(s)" as a Term of Disparagement*

The TTAB next turned to the ultimate inquiry before the Board and found that "within the relevant time periods, [**105] the derogatory connotation of the word 'redskin(s)' in connection with Native Americans extends to the term 'Redskin(s)' as used in [Pro-Football's] marks in connection with the identified services, such that [Pro-Football's] marks may be disparaging of Native Americans to a substantial composite of this group of people." *Id. at 1748.* The crux of the TTAB's conclusion, therefore, is that the "derogatory connotation of the word 'redskin(s)'" extends to the term "Redskin(s)" as used in connection with Pro-Football's entertainment services. This finding is not supported by substantial evidence.

To reach its conclusion that the trademarks may disparage Native Americans, the TTAB essentially determined that because the *word* "redskin(s)" may be viewed by Native Americans as derogatory when used as a reference for Native Americans, the trademarks are disparaging because they use that word. The result of this analysis is that there is very little discussion of the use of the mark in connection with Pro-Football's product or services. Unlike in the *Doughboy* case, where the Examiner-in-Chief of the Patent Office stated that use of the term "Doughboy"- a reference for a World [**106] War I soldier-was disparaging when used to sell an anti-venereal prophylactic, *Doughboy, 88 U.S.P.Q. at 228,* in this case the TTAB did very little analysis of *how* the use of the trademarks in connection with Pro-Football's services disparages Native Americans. The Board was content with stating that because it found the name to be pejorative, the marks must be disparaging. [33]

33 The Board's reasoning reflects the views of Defendants in this case, as the following statement from Defendant Harjo at her deposition makes clear:

> Q: Have any actions been taken by the Washington Redskins football team that you believe disparage Native Americans other than the use of the name?
>
> A: The use of their name, the use of that term, colors all their actions in my estimation. And so I find everything disparaging.

Pl.'s Mot., Ex. 161, Harjo Tr. at 162.

[*134] First, the TTAB observed that "as we move through the 1960's to the present, the evidence shows increasingly respectful portrayal of Native [**107] Americans." *Id. at 1746.* The TTAB then noted that "*the evidence herein shows a parallel development of [Pro-Football's] portrayal of Native Americans.*"*Id.* (emphasis added). What the TTAB found therefore, was that during the relevant time periods, the use of the term "redskin(s)" in connection with Pro-Football's marks was used in a respectful manner. Nevertheless, despite this stunning observation--that during the relevant time frame Pro-Football used Native American imagery in a respectful manner as connected to its entertainment services--the Board still concluded that the use of the term "redskin(s)" was disparaging

when used in the context of Pro-Football's professional football club.

The TTAB apparently premised this conclusion on a number of factors. First, the TTAB discussed the fact that the media has used Native American imagery in connection with Pro-Football's football team, throughout the entire period, "in a manner that often portrays Native Americans as aggressive savages or buffoons." *Id. at 1747* (noting newspaper headlines referring to Washington Redskins team, players or managers scalping opponents, seeking revenge on the warpath, holding pow wows, [**108] or using pidgin English). In addition, newspaper and video excerpts of games were presented showing Washington Redskins fans dressed "in costumes and engaging in antics that clearly poke fun at Native American culture and portrays [sic] Native Americans as savages and buffoons." *Id.* While the TTAB stated that it agreed with Pro-Football that it was not responsible for the actions of the media or its fans, the TTAB, nevertheless, found "the actions of the media and fans . . . probative of *the general public's* perception of the word 'redskin(s)' as it appears in respondent's marks herein." *Id.* (emphasis added). From this evidence, the TTAB concluded that the term "redskin(s)" "retains its derogatory character as part of the subject marks and as used in connection with respondent's football team." *Id.*

The problem with this reasoning is twofold. First, the perceptions of the general public are irrelevant to determining if the marks are disparaging to Native Americans. In other words, this evidence is simply not relevant to the legal question in the case. Second, and most importantly, this finding is

logically flawed. At best, this evidence demonstrates that Pro-Football's [**109] fans and the media continue to equate the Washington Redskins with Native Americans and not always in a respectful manner. However, the evidence does not automatically lead the Court to conclude that the word "redskin(s)" as used in Pro-Football's marks is derogatory in character. Under the broad sweep of the TTAB's logic, no professional sports team that uses Native American imagery would be permitted to keep their trademarks if the team's fans or the media took any action or made any remark that could be construed as insulting to Native Americans. The Court cannot accept such an expansive doctrine; particularly when premised on a finding that is not supported by any substantial evidence.

Clearly, the evidence relating to the media and fans has no bearing on whether a substantial composite of Native Americans finds the term "redskin(s)" to be disparaging when used in connection with Pro-Football's marks. In this regard, the evidence the TTAB put forward comes nowhere [*135] close to meeting the substantial evidence test. First, the TTAB noted that the record contained the testimony of the Defendants who stated that they were "seriously offended" by Pro-Football's use of the term in connection [**110] with its services. *Id.* This testimony, however, is a reflection of their individual viewpoints and there is no evidence that Defendants' views are a reasonable proxy for a substantial composite of the entire Native American population. As Pro-Football's counsel stated at the July 23, 2003, motions hearing, "Do these seven petitioners strongly believe that our famous football team mark Washington Redskins is disparaging?

Apparently. That's fine. They have an opinion, but they are representing themselves and no one else. There are 2.41 million Native Americans in this country, Your Honor. There are over 500 Native American tribes. So I ask, can petitioner's opinions, no matter how stridently held, be extrapolated to even one additional Native American by some method acceptable in a courtroom? The answer is, of course, not at all." Tr. 7/23/2003 at 16.

To corroborate its ultimate conclusion, the TTAB cites to other evidence which this Court views as irrelevant because it has no correlation to the relevant time frame at issue and it does not add exponentially to the requirement that the marks, when used in connection with Pro-Football's services, are considered disparaging by a substantial [**111] composite of Native Americans. The TTAB noted that the record includes Resolutions indicating a present objection to the use of the word "redskin(s)" in connection with Pro-Football's services, from the National Congress of American Indians ("NCAI"), "a broad-based organization of Native American tribes and individuals" from the Oneida tribe, and from Unity 94, "an organization including Native Americans." All of these resolutions were made after the relevant time frame, with no explanation by the TTAB as to how they "shed light" on the relevant time period, and thus, are irrelevant to the calculus. *See* Pl.'s Mot. at 23. Indeed, all of these resolutions were adopted after Defendants filed their Petition to Cancel. *Id.* at 24. Moreover, the TTAB made no findings of fact about the strength of this evidence. For example, only two Native Americans voted for the Unity '94 resolution. Pl.'s Stmt. P 212.

In addition, the TTAB relies on "news articles," which appeared at various times from 1969 to 1992, describing Native American objections to the team name. *Harjo II, 50 U.S.P.Q.2d at 1747.* The TTAB does not describe the contents of these news articles and it is impossible [**112] to determine if they would represent a substantial composite of Native Americans. Moreover, these articles were only introduced to demonstrate "the existence of a controversy spanning over a long period of time." *Id.* Again, the existence of a controversy does not inform the Court as to whether the trademarks at issue are perceived of as disparaging by a substantial composite of Native Americans.

Finally, the TTAB relied on a letter written by Harold Gross in 1972 to Edward Bennett Williams, the then-team owner urging the team name be changed. *Id. at 1747.* The record also indicates that Mr. Gross and seven other colleagues from Native American organizations met with Mr. Williams to discuss the disparaging nature of the team's name. *Id.*; *see also* Pl.'s Stmt. P 202. Again, this evidence does not represent a "substantial composite" of Native Americans.

The TTAB concluded that "the evidence of record establishes that, within the relevant time periods, the derogatory connotation of the words "redskin(s)" in connection [*136] with Native Americans extends to the term "Redskins," as used in [Pro-Football's] marks in connection with the identified services, such that [Pro-Football's] [**113] marks may be disparaging of Native Americans to a substantial composite of this group of people." *Harjo II, 50 U.S.P.Q.2d at 1748.* The Court determines that this decision is not supported by substantial

evidence. [34] As such, the decision of the TTAB must be reversed.

> 34 Moreover, it is undisputed that the six marks at issue were published and registered without opposition from Native Americans or anyone else on *twelve* different occasions. This fact would appear, at least, to work against the TTAB's inferential conclusion that the marks, when used in connection with Pro-Football's entertainment services may disparage Native Americans.

B. Pro Football's Defense of Laches Bars Defendants' Challenge

In addition to concluding that the TTAB's finding of disparagement was not supported by substantial evidence, the Court, in the alternative, determines that Pro-Football's defense of laches would also preclude the cancellation of the six trademarks. As the United States Court of [**114] Appeals for the District of Columbia Circuit has stated, "Plaintiffs are encouraged to file suits when courts are in the best position to resolve disputes." *NAACP v. NAACP Legal Def. and Educ. Fund, Inc., 243 U.S. App. D.C. 313, 753 F.2d 131, 137 (D.C. Cir. 1985).* The best time to resolve this case was 1967 or shortly thereafter. The net result of the delay is that there is no direct or circumstantial evidence in the record that, at the times the trademarks were registered, the trademarks at issue were disparaging; even though the Native Americans contend that during this entire time period the trademarks were disparaging. Hence, the evidence used by the TTAB to support its disparagement conclusion was purely inferential. The Court, like the TTAB, is

handicapped in resolving this case because of the Defendants' delay. Therefore, the problem of laches correlates, to some degree, with the Court's finding that the TTAB's decision is not supported by substantial evidence. It is for this reason, that the Court has determined to address it in the context of this case.

In its December 11, 2000, Memorandum Opinion, the Court set forth the test for laches that Pro-Football [**115] needed to meet in order to prevail:

> "The doctrine of laches bars relief to those who delay the assertion of their claims for an unreasonable time. Laches is founded on the notion that equity aids the vigilant and not those who slumber on their rights." *NAACP v. NAACP Legal Defense & Educational Fund, Inc., 243 U.S. App. D.C. 313, 753 F.2d 131, 137 (D.C. Cir. 1985).* Typically, a laches defense arises in trademark matters when a party defends against a trademark infringement claim on the theory that the original trademark holder fumbled away its trademark rights through inattention. In such typical circumstances, the common law allows for a laches defense only if the defendant meets "three affirmative requirements: (1) a substantial delay by a plaintiff prior to filing suit; (2) a plaintiff's awareness that the disputed trademark was being infringed; and (3) a reliance interest resulting from thedefendant'scontinued

> development of good-will during this period of delay." *Id.*
>
> While the common law definition of laches does not cleanly apply in light of the procedural posture of this case, it can be easily modified: Pro-Football's laches claim is only available [**116] under the common [*137] law if (1) the Native Americans delayed substantially before commencing their challenge to the "redskins" trademarks; (2) the Native Americans were aware of the trademarks during the period of delay; and (3) Pro-Football's ongoing development of goodwill during the period of delay engendered a reliance interest in the preservation of the trademarks.

Harjo III, 57 U.S.P.Q.2d at 1144. Pro Football takes the position that the Court "must separately consider the equities of applying laches as to the two-year delay associated with the Redskins' 1990 registration, the fourteen-year delay associated with the 1978 registration, the eighteen year delay associated with the 1974 registrations, and the twenty-five year delay associated with the 1967 registration." Pl.'s Reply at 2. The Court agrees with Pro-Football's assessment. Accordingly, for each of these time periods, the Court must determine if Pro-Football has met the three prong test articulated above. Pro-Football bears the burden of proving laches, because it is an affirmative defense. *Bridgestone/Firestone Research, Inc. v. Automobile*

Club De L'Quest De La France, 245 F.3d 1359, 1361 (Fed. Cir. 2001). [**117]

1. Laches as an Available Defense

Before turning to the three-prong analysis, the Court notes that it finds that laches is a defense available to Pro-Football. Defendants continue to argue that a laches defense is unavailable in the context of a *section 2(a)* petition for cancellation; particularly where a "public interest" is vindicated. Defs.' Mot. at 34-36. The Court's December 11, 2000, Memorandum Opinion found that laches was an available defense in *section 2(a)* proceedings, but like all equitable defenses, was contingent on the facts and circumstances of each case. *See Harjo III, 57 U.S.P.Q.2d at 1145* ("The Court agrees with Pro-Football that the *Lanham Act* does not expressly preclude laches claims raised in opposition to cancellation petitions like that brought by the Native Americans."); *see also id.* (observing that the laches claim should be viewed in the context of each case once a factual record can be developed). The Defendants' arguments do not give the Court pause to reconsider that decision. The Court concludes that on the basis of the unique facts of this case, which arise in the context of a cancellation proceeding, the laches defense applies. [**118] In other words, as is appropriate in all laches cases, the Court's holding is specific to the facts and circumstances of this case.

The case that Defendants rely on to argue that laches is inapplicable actually holds that a laches defense is applicable in the context of a *section 2(a)* petition. *Bridgestone, 245 F.3d at 1363.* The Defendants attempt to read the case, however, as stating that where a "public" interest is involved,

laches is unavailable. Defs.' Mot. at 35. The Court disagrees and finds that such an interpretation stretches the words of the Federal Circuit. In *Bridgestone*, the petitioner arguing for cancellation asserted that in a case of "false suggestion," a public interest is involved, and, therefore, a laches defense is inapplicable. *Bridgestone, 245 F.3d at 1363.* The Federal Circuit remarked that false suggestion cases do not involve the public interest. *Id.* The Defendants infer from this statement that in cases where a "public" interest is involved, laches should never apply. The *Bridgestone* court, however, never stated that the laches defense is unavailable in cases involving the public interest. The court merely observed [**119] that a "false suggestion" claim did not implicate the public interest.

[*138] Defendants also point out that the *Bridgestone* court observed that in the context of *section 2(d)* likelihood of confusion cases, courts have permitted a "tardy challenge to a registered mark." *Id.* (citing *Ultra-White Co. v. Johnson Chem. Indus., Inc., 59 C.C.P.A. 1251, 465 F.2d 891, 893-94 (C.C.P.A. 1972); Chun King Corp. v. Genii Plant Line, Inc., 56 C.C.P.A. 740, 403 F.2d 274, 276 (C.C.P.A. 1968)).* Reviewing these cases, the Court observes that in the likelihood of confusion context, the courts have been generous to tardy filings because of "the public interest expressed in *§ 1052*" which "is the dominant consideration." *Ultra-White, 59 C.C.P.A. 1251, 465 F.2d 891, 893-94. Section 2(d) of the Lanham Act* states that a trademark should not be cancelled for likelihood of confusion unless the mark, "consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name

previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the [**120] applicant, *to cause confusion, or to cause mistake, or to deceive.*" *15 U.S.C. § 1052(d)* (emphasis added). Given the strong public interest in avoiding deception or mistake, a court in balancing the equities is likely to be more chary before applying the laches defense in the likelihood of confusion case scenario. Indeed, even in a disparagement case, a court may be willing to invoke the public interest behind *section 2(a)* before applying it to the facts and circumstances of the case. However, the public interest is somewhat more narrowly defined in that context because it applies to a more narrow segment of the general population than in the likelihood of confusion cases.

The problem with Defendants' argument is that it has no limit. Any public interest that seeks vindication under *section 2(a)* would not be subject to a laches defense. As discussed at the July 23, 2003 motions hearing:

> THE COURT: So let me see if I understand it, if I can interrupt. Your view, then, is if you are asserting a public interest of this nature, basically it doesn't matter when you bring it. So, if you know that back in 1967 it's disparaging you could decide not to do [**121] anything about it and bring it whenever you choose. That's the crux of your argument?
>
> MR. LINDSAY: That is correct, Your Honor.

Tr. 7/23/2003 at 81. The Court cannot agree that the law permits such an unreasonable outcome. Pro-Football has enjoyed trademark protections since 1967. The Seventh Circuit in the *Hot Wax* case captured nicely the problem inherent in the defense counsel's argument, when discussing why a laches claim should apply in *Lanham Act* cases even if the claim would be viable under the state statute of limitations:

> In the context of the *Lanham Act*, this framework makes particularly good sense. The notion of a "continuing wrong," which is so prevalent in *Lanham Act* cases, provides a strong justification for the application of the doctrine of laches in appropriate circumstances regardless of whether the plaintiff has brought suit within the analogous statute of limitations. Under the notion of a continuing wrong, "only the last infringing act need be within the statutory period." *Taylor v. Meirick, 712 F.2d 1112, 1118 (7th Cir. 1983)*. Without the availability of the application of laches to a claim arising from a continuing wrong, [**122] a party could, theoretically, delay filing suit indefinitely. It would certainly be inequitable to reward this type of dilatory conduct and such conduct would necessarily warrant application of laches in [*139] appropriate circumstances. Thus, we conclude that whether a *Lanham Act* claim has been brought within the analogous state statute of limitations is

> not the sole indicator of whether laches may be applied in a particular case.

Hot Wax, 191 F.3d at 821-22. The notion that Pro-Football's trademarks would be subject to attack at any point in time would seriously undermine the entire policy of seeking trademark protection in the first place. McCarthy, *supra*, § 2:3 ("Trademarks play a crucial role in our free market economic system. By identifying the source of goods or services, marks help consumers to identify their expected quality and, hence, assist in identifying goods and services that meet the individual consumer's expectations. . . . Trademark counterfeiting . . . if freely permitted, . . . would eventually destroy the incentive of trademark owners to make the investments in quality control, promotion and other activities necessary to establishing strong [**123] marks and brand names. It is this result that would have severe anticompetitive consequences.") (quoting William F. Baxter, Statement before the Senate Committee on the Judiciary concerning S. 2428 (a bill to strengthen the laws against counterfeiting of federally registered trademarks), Sept. 15, 1982). This result is particularly true given the fact that the Defendants claim that the marks have been disparaging during this entire time frame and readily admit that they have been aware of the trademarks during this entire time frame.

For all of these reasons the Court finds that a laches defense is appropriate in a disparagement case. However, as with all equitable defenses, the

Court concludes that the defense is subject to the particular facts and circumstances of each case.

* * *

The Court now turns to the merits of Pro-Football's laches argument. The Court articulated a general three-prong test for laches in the context of a trademark proceeding that the Court of Appeals for the District of Columbia Circuit articulated in the *NAACP* case. Essentially, to demonstrate laches Pro-Football must show that Defendants' delay in bringing the cancellation proceeding was unreasonable, [**124] and that prejudice to Pro-Football resulted from the delay.*Bridgestone, 245 F.23d at 1361; Hot Wax, 191 F.3d at 820.* This test is not materially different from the standard articulated in *NAACP*. The first two steps of the *NAACP* test, substantial delay and notice, form the unreasonable delay prong of the *Bridgestone* case. Finally, the third step of the *NAACP* test, development of goodwill during the period of delay, is the prejudice element in the *Bridgestone* case. As the *Bridgestone* court observed, "economic prejudice arises from investment in and development of the trademark." *Id. at 1363.*

2. Substantial Delay

The Court finds that the Defendants substantially delayed in bringing their challenge to the marks. In the case of the first trademark, Defendants waited over twenty-five years to bring this case. Defendants "do not dispute that they have long known about and objected to the name of the Washington football franchise." Defs.' Opp'n at 23. This length of time is greater than other cases where

courts have applied a laches doctrine. *NAACP, 753 F.2d at 138* (determining that thirteen-year delay was unreasonable [**125] and that claim was barred by laches); *Dakota Indus., Inc. v. Dayton Hudson Corp., 37 Fed. Appx. 846, No. 01-3425, 2002 WL 1339854, at *1 (8th Cir. June 20, 2002)* (finding that a ten-year delay barred claim). In this case, the Washington Redskins have been using their name since 1937 and [*140] have had their name trademarked since 1967.

The Court finds that for all six trademarks the delay in bringing the cancellation proceeding was substantial. The marks were registered in 1967, 1974, 1978, and 1990. In the case of the trademarks registered in 1967, 1974, an 1978, the delay was substantial on its face. However, given the context of this case, the Court concludes the delay for all the trademarks was substantial. The Defendants had notice of the marks when the marks were published for comment and when the marks were published for registration.

While the two-year delay for the "REDSKINETTES" mark may seem not particularly lengthy on its face, the Court has explained that the context of this case is different from many other trademark cases. In addition, the Washington Redskins cheerleaders have been using the term "REDSKINETTES" since 1962. Therefore, this is not a case where the mark was introduced [**126] in 1990; rather, it had been in use for approximately thirty years at the point the Defendants brought their cancellation proceeding. Moreover, the two-year delay does not exist in a vacuum. There are five other trademarks being challenged, all of which contain the term "Redskins." In fact, the TTAB

concluded that "while petitioners have framed their allegations broadly to include in their claim of disparagement all matter in the subject marks that refers to Native Americans, their arguments and extensive evidence pertain almost entirely to the 'Redskins' portion of respondent's marks." *Harjo II, 50 U.S.P.Q.2d at 1743.* The very first trademark at issue is "The Redskins," and this mark was first registered in 1967. Accordingly, the Court finds that the delay in bringing the instant cancellation proceeding for all of the marks, including the "REDSKINETTES" mark, first registered in 1990, was substantial. This delay, with no action on the part of the Defendants to challenge the trademarks in a legal proceeding has engendered a presumption that Pro-Football reasonably relied on such inaction. *NAACP, 753 F.2d at 139* ("The passing of almost thirteen years [**127] without any clear reservation of rights by the Association creates a presumption of reasonable reliance.").

3. Notice

The Court determines that Defendants had twelve separate occasions of constructive notice when the six marks were each published and registered. Publication of the marks in the *Official Gazette* constitutes constructive notice of the applications at issue. *National Cable Television Ass'n, Inc. v. American Cinema Editors, Inc., 937 F.2d 1572, 1581 (Fed. Cir. 1991)* ("Logically, laches begins to run from the time action could be taken against the acquisition by another of a set of rights to which objection is later made. In an opposition or cancellation proceeding the objection is to the rights which flow from registration of the mark."); *see also*

15 U.S.C. § 1072 (*Lanham Act* provides that registration on the Principle Register "shall be constructive notice of the registrant's claim of ownership"). The TTAB has expanded the Federal Circuit's view to state that laches in the context of a cancellation proceeding begins to run at the date the trademarks are published. *Turner v. Hops Grill & Bar, Inc., 1999 TTAB LEXIS 416, 52 U.S.P.Q.2d 1310, 1312-13* & n.3 (T.T.A.B. 1999) [**128] ("laches starts to run when the mark in question is published for opposition"). In this case, therefore, laches began to run from the point the first trademark was published in 1967. In all, therefore, the six marks provided twelve separate constructive notifications.

[*141] Defendants contend that because they are not a competing claimant to a trademark, they should not be charged with constructive notice. Defs.' Opp'n at 24 ("Unlike a holder of a private and competing trademark, they had no reason to become personally conversant in the details of trademark law and could neither afford nor had the incentive to retain counsel to monitor the publication of trademarks on their behalf."). Contrary to Defendants' argument, the Supreme Court has held that a "party's poverty or pecuniary embarrassment was not a sufficient excuse for postponing the assertion of his rights." *Leggett v. Standard Oil Co., 149 U.S. 287, 294, 37 L. Ed. 737, 13 S. Ct. 902, 1893 Dec. Comm'r Pat. 345 (1893)*. Additionally, ignorance of one's legal rights is not a reasonable excuse in a laches case. *See, e.g., Jones v. United States, 6 Cl. Ct. 531, 532-33 (Cl. Ct. 1984)* ("Where laches is raised, knowledge of the [**129] law is imputed to all

plaintiffs. Consequently, professed ignorance of one's legal rights does not justify delay in filing suit.").

Defendants seek to strip Pro-Football, a business, of the protections of federal trademark law. As the Court observed of Defendants at the July 23, 2003, motions hearing, "all of them are well educated, some are attorneys." Tr. 7/23/2003 at 77. As Defendants note, laches is an "*equitable* doctrine." Defs.' Opp'n at 23 (emphasis in original). Given that Defendants are sophisticated individuals who are seeking to strip a corporation of the protections of federal law for its trademarks, the Court is not open to Defendants' argument that because they just learned of their legal rights under *section 2(a)*, that the Court should not follow the constructive notice requirements. If Defendants use of federal trademark laws would cause the same type of damage as a competitor's actions would, then Defendants should be held to the same standards; particularly when they claim that they have been on notice about the disparaging nature of these trademarks since 1967.

The Court finds that Defendants were also aware of the trademarks during the period of delay and [**130] therefore also had actual notice. Defendants state in their opposition that they "do not dispute that they have long known about and objected to the name of the Washington football franchise." Defs.' Opp'n at 23. Moreover, as discussed earlier, Defendants have known about the Washington Redskins football franchise for many years. [35]

35 Defendants seek to argue that while aware of the team names, they were unaware of the trademarks. Defs. Opp'n Stmt. P 45. The Court

> finds the fact that they had knowledge of the use of the team name is sufficient to supply actual knowledge of the trademarks being used in the marketplace.

Accordingly, the Court finds that Defendants were aware of the trademarks during the period of delay under a theory of actual or constructive notice. [36] Based on [*142] the substantial delay, the fact that Defendants were on notice of the marks, and the fact that Defendants have no reasonable excuse for their delay in taking action, the Court concludes that Defendants' delay was undue. *Bridgestone, 245 F.3d at 1361* [**131] ("To prevail on its affirmative defense, Bridgestone was required to establish that there was undue or unreasonable delay. . . ."). As the *Bridgestone* court stated: "constructive notice, widespread commercial use (knowledge of which is not denied by the Automobile Club), and the passing of twenty-seven years after registration, accompanied by the absence of a reasonable excuse by the Automobile Club for its inaction, require that the Automobile Club be charged with undue delay in seeking cancellation of Bridgestone's trademark registration." *Id. at 1362.* The Court finds that constructive and actual notice on the part of Defendants, widespread use of Pro-Football's trademarks, and the over twenty-five years that have passed since first notice of the mark, accompanied by an insufficient excuse from Defendants for their delay, requires this Court to find undue delay on the part of Defendants.

> 36 Defendants also argue that the Court cannot apply the doctrine of constructive notice to Defendant Mateo Romero, who was born in

1966. Defendants, in support of this argument, make a fair point of the difficulty of the Court applying laches in the context of a disparagement case, because a "'substantial composite'" of a disparaged group is by definition a fluid entity, joined together for the purposes of *section 2(a)* by a consistent defining concept (disparagement) rather than a constant membership (because individuals in the group are born, age, and die)." Defs.' Opp'n at 25. The argument, however, highlights the fact that during the time periods at issue a substantial composite of Native Americans may not have found the trademark at issue disparaging. A later substantial composite of Native Americans that finds the marks disparaging may be precluded because the relevant test is at the times the trademarks are issued.

Pro-Football correctly observes that the Defendants essentially argue that no court could ever apply a laches defense to a disparagement claim. Pl.'s Reply at 6 n.6 (noting that even a 100-year delay would not prevent a potential disparagement claim "because of the potential of a claim being brought by some as of yet unborn person who might claim disparagement"). The Court, however, has already rejected Defendants' view that laches is inapplicable to a disparagement proceeding. Rather than taking such an extreme position, that laches never applies to a disparagement proceeding, the Court takes a more modest approach: a finding of laches depends on the facts and circumstances of each case.

[**132] **4. Prejudice**

The Court finds that Defendants' delay in bringing the cancellation proceeding prejudices Pro-Football. Defendants argue that the final prong of the test set forth in *NAACP* is not applicable to the facts of this case because "the Court must look not only to the existence of a reliance interest, but to whether the defendant will be prejudiced if the plaintiff prevails." Defs.' Opp'n at 26 (citing *Bridgestone, 245 F.3d at 1362*). Pro-Football contends, to the contrary, that it "need not prove that it will suffer some negative consequence if the cancellations are sustained." Pls.' Reply at 13 (capitalization altered).

There is no question that in order to prove a laches defense, some form of prejudice must be shown. "Mere delay in asserting a trademark-related right does not necessarily result in changed conditions sufficient to support the defense of laches. There must also have been some detriment due to the delay." *Bridgestone, 245 F.3d at 1362*. The Court reads *NAACP* to suggest this proposition because the case that the *NAACP* relied on to set forth the laches defense, *Saratoga Vichy Spring Co., Inc. v. Lehman, 625 F.2d 1037 (2d Cir. 1980)*, [**133] held that a "defendant's proof in its laches defense must show that plaintiff had knowledge of defendant's use of its marks, that plaintiff inexcusably delayed in taking action with respect thereto, *and that defendant will be prejudiced by permitting plaintiff inequitably to assert its rights at this time*." *Id. at 1040* (internal quotation marks and citations omitted) (emphasis added); *see also* McCarthy, *supra*, § 31:12 ("The cases are legion to the effect that mere delay, without

resulting injury to defendant, is not sufficient to prevent relief for infringement."). The key question, however, is what is required in demonstrating injury or prejudice.

In *Bridgestone*, the Federal Circuit described the prejudice element as "prejudice [*143] at trial due to loss of evidence or memory of witnesses, and economic prejudice based on loss of time or money or *foregone opportunity*." *Bridgestone, 245 F.3d at 1362*. [37] With regard to the question of economic prejudice, the Federal Circuit observed that in trademark cases, unlike patent cases, in order to prove laches a defendant does not need to demonstrate with specific evidence that it relied on the [**134] plaintiff's silence. *Id. at 1363*; *see also* McCarthy, *supra*, § 31:13 ("However, the Federal Circuit, citing its own patent precedent, has held that a laches defense in a trademark case can be proven even in the absence of evidence that the registrant actually knew of the potential petitioner and relied to its detriment on that party's failure to challenge the registration or use over a long period of time.") (citing *Bridgestone*). Instead, as long as a defendant has demonstrated a plaintiff's undue delay, "economic prejudice to the defendant may ensue whether or not the plaintiff overtly lulled the defendant into believing that the plaintiff would not act, or whether or not the defendant believed that the plaintiff would have grounds for action." *Bridgestone, 245 F.3d at 1363*.

37 Because the Court finds economic prejudice, it does not consider whether trial prejudice would also result in this case due to Defendants' undue delay. Nevertheless, the

> Court points out that defending this lawsuit against evidence that, due to the twenty-five year delay, does not directly address the legal question at issue, would represent a hardship to Pro-Football.

[**135] Therefore, the test for economic prejudice in a trademark case is the following:

> Economic prejudice arises from investment in and development of the trademark, and the continued commercial use and economic promotion of a mark over a prolonged period adds weight to the evidence of prejudice. *See Hot Wax, Inc. v. Turtle Wax, Inc., 191 F.3d 813, 821 (7th Cir.1999)* (the longer the use and the lengthier the period of delay, the lighter the burden of showing economic prejudice in support of the defense of laches).

Id. at 1363. In other words, prejudice is equated with investment in the trademark that theoretically could have been diverted elsewhere had the suit been brought sooner. *Hot Wax, 191 F.3d at 824* ("Had Hot Wax successfully pressed its claims in a timely manner, Turtle Wax certainly could have invested its time and money in other areas or simply renamed its products."). Moreover, where the length of time is great in bringing the claim, "prejudice is more likely to have occurred and less proof of prejudice will be required." *Hot Wax, 191 F.3d at 824* (internal quotation marks and citation omitted); *NAACP, 753 F.2d at 139* [**136] (lengthy passage of time supports presumption of reliance).

There is no dispute that in this case Pro-Football has invested heavily in the marketing and development of its brand during the period of delay. Defs.' Opp'n at 31 ("The Native American Parties acknowledge . . . Pro-Football and NFLP's advertising expenditures since 1967, the revenue earned from merchandise bearing the Marks, and their considerable revenue from tickets and TV contracts.") In the instant case, because the delay in bringing the cancellation proceeding was so substantial, a presumption is created that Pro-Football was entitled to rely on the security of the trademarks at issue. In 1967, the NFL was still a nascent industry. Had this suit been brought at that point, Pro-Football may have acquiesced and changed the name. The twenty-five year delay, where Pro-Football has invested so heavily in the marks, has clearly resulted in economic prejudice.

[*144] It is no answer for Defendants to argue that "because cancellation of the registrations does not prohibit Pro Football from using or enforcing the Marks, and the Native American Parties are not seeking to establish control or ownership of the Marks, there is no basis [**137] to conclude that Pro Football's past investment or future revenues from the Marks will be jeopardized." Defs.' Opp'n at 31. Defendants' contention would never permit a laches defense in a cancellation proceeding. While Pro-Football's expert points out that it is rare that there will necessarily be a loss of goodwill in the brand name due to a cancellation proceeding because the corporation that has invested so heavily in the mark will likely continue to use it, Pl.'s Opp'n, Ex. 13, Gilson Tr. at 179, 181, past investment in the mark will be jeopardized by uncertainty surrounding the

brand name. Therefore, an economic cost exists when a trademark is cancelled that adversely affects prior investment in the brand. *See* Snyder Dep. at 174-75, 190-92, 195-96. Indeed, in addition to caselaw, common sense dictates that Pro-Football will suffer some economic hardship. Otherwise, there would be no point to this litigation being used as a vehicle to force Pro-Football to change the name of the team. [38]

> 38 The deposition of Daniel Snyder, which the Court has reviewed, indicates that there are a number of practical reasons why loss of trademark protection would have a detrimental effect on Pro-Football's other revenue streams. Snyder Dep. at 174-75; 190-92; 195-96 (observing loss of sponsorships due to uncertainty over trademarks).

[**138] For the foregoing reasons, the Court concludes that based on the undisputed material facts, Pro-Football is entitled to summary judgment on its laches claim. There is no dispute that the record demonstrates both undue delay and economic prejudice. The Court does not adopt Defendants' argument that laches does not apply because of the unique circumstances of this case. Their contention on this score is without reasonable boundaries. Accordingly, laches bars the Defendants' cancellation petition.

V. SUMMARY OF ANALYSIS

The Court's decision today only focuses on the evidence supporting the TTAB's decision and Defendants' delay in bringing this proceeding. This opinion should not be read as a making any

statement on the appropriateness of Native American imagery for team names. The Board premised its disparagement conclusion on a paucity of actual findings of fact that were linked together through inferential arguments that had no basis in the record. Contrary to the TTAB's ruling, this Court finds that Defendants did not carry their burden of proof in the TTAB proceeding. The evidentiary findings of the TTAB did not rise to the level of "substantial evidence" to support their [**139] ultimate conclusion that the six trademarks at issue were disparaging to a substantial composite of Native Americans.

The legal question before the TTAB was whether the six trademarks, when used in connection with Pro-Football's entertainment services, "may disparage" a substantial composite of Native Americans at the time the marks were registered starting in 1967. The findings do not come close to shedding any light on the legal inquiry. There is no evidence in the record that addresses whether the use of the term "redskin(s)" in the context of a football team and related entertainment services would be viewed by a substantial composite of Native Americans, in the relevant time frame, as disparaging. In addition, none of the TTAB's findings related to the linguists' expert testimony help explain [*145] whether the term "redskins," when used in connection with the "Washington Redskins" football team, disparaged Native Americans during the relevant time frame.

The only other findings of fact that the TTAB made involved the Ross survey. The TTAB found that the survey methodology was sound, that the survey was nothing more than a survey of attitudes

as of the time the poll was conducted [**140] in 1996, and that the survey adequately represents the views of the two populations sampled. This survey, aside from its extrapolation flaws, says nothing about whether the term "redskin(s)" when used in connection with Pro-Football's football team disparages Native Americans. Furthermore, the survey provides no information about the relevant time periods. The survey is completely irrelevant to the analysis.

Besides making findings of fact that did not address the legal conclusion, the TTAB did not hear live testimony; instead the TTAB predicated its decision on a cold factual record. With the reasoning laid entirely out in front of it, the TTAB rarely credited one side's evidence at the expense of another or provided an explanation as to why it accepted the evidence or the weight it gave the evidence. In this case, the TTAB could have easily articulated its reasoning based on the substance of the record before it. Ultimately, the evidence in the case does not answer the legal question of whether the trademarks, in the context of their use during the relevant time frames, may have disparaged Native Americans. The evidence chips away at the sides of this legal question but never helps [**141] answer it directly.

This is undoubtedly a "test case" that seeks to use federal trademark litigation to obtain social goals. The problem, however, with this case is evidentiary. *The Lanham Act* has been on the books for many years and was in effect in 1967 when the trademarks were registered. By waiting so long to exercise their rights, Defendants make it difficult for any fact-

finder to affirmatively state that in 1967 the trademarks were disparaging.

VI. CONCLUSION

The TTAB's finding of disparagement is not supported by substantial evidence and must be reversed. The decision should also be reversed because the doctrine of laches precludes consideration of the case. Accordingly, the Court grants summary judgment for Plaintiffs on their First, Second, and Fifth Causes of Action. The Court denies summary judgment to Defendants on these Causes of Action. As the Court has no need to reach the constitutional claims raised by Pro-Football, these claims are rendered moot.

Date: September 30, 2003

/s/

COLLEEN KOLLAR-KOTELLY

United States District Judge

LexisNexis

LEXSEE 50 U.S.P.Q.2D 1705

Suzan Shown Harjo; Raymond D. Apodaca; Vine Deloria, Jr.; Norbert S. Hill, Jr.; Mateo Romero; William A. Means; and Manley A. Begay, Jr. v. Pro-Football, Inc.

Cancellation No. 21,069 to Registration Nos. 1,606,810; 1,085,092; 987,127; 986,668; 978,824; and 836,122 n1

n1 Throughout this proceeding, petitioners have included a reference to Registration No. 1,343,442 in the caption of all filings. However, as indicated in the October 5, 1992, order of the Board instituting this proceeding, the petition to cancel, filed September 10, 1992, was not instituted as to Registration No. 1,343,442 because it was moot at the time of filing. Registration No. 1,343,442, which issued

June 18, 1985, for the mark SKINS for "entertainment services in the form of professional football games and exhibitions" in International Class 41, was canceled as of August 20, 1992, under the provisions of Section 8 of the Trademark Act.

Trademark Trial and Appeal Board

1999 TTAB LEXIS 181; 50 U.S.P.Q.2D (BNA) 1705

May 27, 1998, Hearing

April 2, 1999, Decided

DISPOSITION:
[*1]

Decision: As to each of the registrations subject to the petition to cancel herein, the petition to cancel under Section 2 (a) of the Act is granted on the grounds that the subject marks may disparage Native Americans and may bring them into contempt or disrepute. As to each of the registrations subject to the petition to cancel herein, the petition to cancel under Section 2 (a) of the Act is denied on the ground that the subject marks consist of or comprise scandalous matter. The registrations will be canceled in due course.

COUNSEL:

Michael A. Lindsay and Joshua J. Burke of Dorsey & Whitney for petitioners.

John Paul Reiner, Robert L. Raskopf, Marc E. Ackerman, Claudia T. Bogdanos and Lindsey F. Goldberg of White & Case for respondent.

JUDGES:

Before Sams, Cissel and Walters, Administrative Trademark Judges. n2

> n2 Assistant Commissioner Philip Hampton, II, who heard the oral argument in this case, resigned prior to the issuance of this decision. Therefore, Administrative Trademark Judge Robert Cissel has been substituted for Assistant Commissioner Hampton as a member of the panel deciding this case. The change in the composition of the panel does not necessitate a rehearing of the oral argument. *See, In re Bose*, 772 F.2d 866, 227 USPQ 1, 4 (Fed. Cir. 1985).

[*2]

OPINION BY: WALTERS

OPINION:

THIS OPINION IS CITABLE AS PRECEDENT OF THE T.T.A.B.

Opinion by Walters, Administrative Trademark Judge:

Table of Contents

Introduction

The Pleadings

Summary of the Record

The Parties

Preliminary Issues

1997 NCAI Resolution

Constitutionality of Section 2(a) of the Trademark Act

Indian Trust Doctrine

Protective Order

Respondent's Motion to Strike Notice of Reliance and Testimony Depositions

Respondent's Motion, in its Brief, to Strike Testimony and Exhibits

1. Objections to Testimony and Exhibits in their Entirety

2. Objections to Specified Testimony and Exhibits

3. Objections to Notice of Reliance Exhibits

Summary of the Arguments of the Parties

Petitioners

Respondent

The Evidence

The Parties' Notices of Reliance

Petitioners

1. Summary of Petitioners' Witnesses and Evidence

2. Testimony of the Seven Petitioners

3. Harold Gross

4. Resolutions by Organizations

5. History Expert

6. Social Sciences Experts

Respondent

1. Summary of Respondent's Witnesses and Evidence

2. Respondent's Witnesses

Linguistics Experts

1. Denotation and Connotation

2. Use of the Word "redskin(s)"

3. [*3] Dictionary Definitions of "redskin"

4. Use of "redskin(s)" in Modern Context

5. Findings of Fact Regarding Linguists' Testimony

Film Expert

Survey Evidence

1. Petitioners' Survey

2. Respondent's Rebuttal

3. Findings of Fact Regarding Survey

Applicable Legal Principles

Section 2(a)

Scandalous Matter

Matter Which May Disparage

Matter Which May Bring Persons ... into Contempt or Disrepute

Legal Analysis

Disparagement

Contempt or Disrepute

Scandalousness

Decision

Introduction

Suzan Shown Harjo, Raymond D. Apodaca, Vine Deloria, Jr., Norbert S. Hill, Jr., Mateo Romero, William A. Means, and Manley A. Begay, Jr. filed their petition to cancel the registrations of the marks identified below, all owned by Pro-Football, Inc.:

> THE WASHINGTON REDSKINS n3 and REDSKINS n4 for "entertainment services - namely, presentations of professional football contests";
>
> REDSKINETTES for "entertainment services, namely, cheerleaders who perform dance routines at professional football games and exhibitions and other personal appearances" n5;
>
> [SEE ILLUSTRATION IN ORIGINAL]
>
> for "entertainment services - namely, football exhibitions rendered [*4] live in stadia and through the media of radio and television broadcasts" n6;
>
> and the following two marks for "entertainment services - namely,

presentations of professional football contests":

[SEE ILLUSTRATION IN ORIGINAL] n7

and

[SEE ILLUSTRATION IN ORIGINAL] n8

n3 Registration No. 978,824, issued February 12, 1974, in International Class 41. Sections 8 and 15 affidavits accepted and acknowledged, respectively. Registration renewed for ten years from February 12, 1994.

n4 Registration No. 1,085,092, issued February 7, 1978, in International Class 41. Sections 8 and 15 affidavits accepted and acknowledged, respectively. Registration renewed for ten years from February 7, 1998.

n5 Registration No. 1,606,810, issued July 17, 1990, in International Class 41. Section 8 affidavit accepted.

n6 Registration No. 836,122, issued September 26, 1967, in International Class 41. Sections 8 and 15 affidavits accepted and acknowledged, respectively. Registration

renewed for twenty years from September 26, 1987.

n7 Registration No. 986,668, issued June 18, 1974, in International Class 41. Section 8 affidavit accepted. Registration renewed for ten years from June 18, 1994.

n8 Registration No. 987,127, issued June 25, 1974, in International Class 41. Sections 8 and 15 affidavits accepted and acknowledged, respectively. Registration renewed for ten years from June 25, 1994.

[*5]

The Pleadings

Petitioners allege that they are Native American n9 persons and enrolled members of federally recognized Indian tribes. As grounds for cancellation, petitioners assert that the word "redskin(s)" n10 or a form of that word appears in the mark in each of the registrations sought to be canceled; that the word "redskin(s)" "was and is a pejorative, derogatory, denigrating, offensive, scandalous, contemptuous, disreputable, disparaging and racist designation for a Native American person"; that the marks in Registration Nos. 986,668 and 987,127 "also include additional matter that, in the context used by registrant, is offensive, disparaging and scandalous"; and that registrant's use of the marks in the identified registrations "offends" petitioners and other Native Americans. Petitioners assert, further, that the marks in the identified registrations "consist of or comprise

matter which disparages Native American persons, and brings them into contempt, ridicule, and disrepute" and "consist of or comprise scandalous matter"; and that, therefore, under Section 2(a) of the Trademark Act, *15 U.S.C. 1052(a)*, the identified registrations should [*6] be canceled.

n9 We adopt the term "Native American" throughout this opinion, except when quoting from evidence, testimony or the parties' briefs.

n10 Throughout this opinion we use "redskin(s)" to include both the singular and plural forms of the word "redskin." If any legal conclusions are to be reached regarding distinctions that may exist between the singular and plural forms of "redskin," such issues will be addressed separately herein.

Respondent, in its answer, denies the salient allegations of the petition to cancel and asserts n11 that "through long, substantial and widespread use, advertising and promotion in support thereof and media coverage, said marks have acquired a strong secondary meaning identifying the entertainment services provided by respondent in the form of professional games in the National Football League" n12; and that "the marks sought to be canceled herein cannot reasonably be understood to refer to the Petitioners or to any of the groups or organizations to which they belong [as] the marks refer to the Washington Redskins football team which is owned by Respondent and thus cannot be interpreted as disparaging any of the Petitioners or

as bringing [*7] them into contempt or disrepute." n13

n11 In its answer as filed, respondent asserted eleven "affirmative defenses," ten of which were challenged by petitioners in a motion to strike. The Board, deciding petitioners' motion on March 11, 1994 (*pub'd. at 30 USPQ2d 1828),* struck all of respondent's affirmative pleadings except those set forth herein.

n12 In deciding not to strike this "defense," the Board stated that proof that respondent's marks have acquired "secondary meaning" would not establish a good defense to petitioners' claims under Section 2(a). However, in view of respondent's explanation of this paragraph in its answer, the Board concluded that it is not a "secondary meaning" defense. Rather, it is "a mere elaboration of respondent's denial of the allegations of paragraphs 1, 2 and 3 of the petition to cancel."

n13 As with the preceding allegation, this allegation is also essentially an elaboration of respondent's denial of petitioner's allegations, rather than an affirmative defense.

Summary of the Record

The record consists of: the pleadings; the files of the involved registrations; numerous discovery and testimony depositions on behalf [*8] of petitioners

and respondent, respectively, all with accompanying exhibits n14; and numerous exhibits made of record by petitioners' and respondent's notices of reliance. Both parties filed briefs on the case, petitioners filed a reply brief, and an oral hearing was held.

n14 Petitioners and respondent stipulated (under an agreement filed June 3, 1997, and modified July 18, 1997), *inter alia*, to the admission of all discovery depositions as trial testimony; and to the admission as trial or rebuttal testimony of the depositions of certain specified witnesses despite the fact that their depositions were taken outside the appropriate periods for taking those depositions. The parties also stipulated that such depositions would remain subject to objections properly raised.

The Parties

Petitioners are seven Native American persons. Each petitioner is an enrolled member of a different federally recognized Indian tribe. Further, each petitioner is active in his or her respective tribal community and belongs to, or has belonged to, tribal organizations as well as national organizations that are composed of Native American persons, or national organizations that are interested [*9] in issues pertaining to Native American persons, or both.

Respondent is the corporate owner of the Washington Redskins, a National Football League

football team located in the Washington, D.C. metropolitan area. Respondent is the owner of the six registrations that are the subjects of this petition to cancel.

Preliminary Issues

Before turning to the merits of this case, there are several outstanding procedural and evidentiary issues that we must address. As the record reveals, the parties have been extremely contentious, and the evidence and objections thereto are voluminous. Further, in their zeal to pursue their positions before the Board, it appears that the parties have continued to argue, through the briefing period and at the oral hearing, certain issues that have already been decided by the Board in this case. In particular, both parties have continued to argue their positions regarding the admissibility of, and weight that should be accorded to, a 1997 resolution of the National Congress of American Indians (NCAI). Additionally, respondent has devoted a significant portion of its lengthy brief to its argument regarding the constitutionality of Section 2(a) of [*10] the Trademark Act. We address these two points and the remaining procedural and evidentiary issues below.

1997 NCAI Resolution

The Board, in its decision of February 6, 1998 (*pub'd. at 45 USPQ2d 1789*), denied, *inter alia*, petitioners' motions to reopen testimony (1) to introduce, by way of the testimonial deposition of W. Ron Allen, a resolution adopted by the National Congress of American Indians (NCAI) on June 8-11, 1997, and accompanying documents, and (2) to

introduce two issues of the periodical *Copy Editor* and related documentation; and granted respondent's motion to strike W. Ron Allen's testimonial deposition and accompanying exhibits. To the extent that it may be necessary to do so, we reaffirm that decision of the Board and, thus, in reaching our decision herein, we have not considered the aforementioned evidence or the parties' further arguments in connection therewith.

Constitutionality Of Section 2(a) Of The Trademark Act

In its order of March 11, 1994 (*pub'd at 30 USPQ2d 1828, 1832-1833),* the Board granted petitioners' motion to strike, *inter alia*, respondent's "affirmative defenses" asserted in paragraphs [*11] 11, n15 12 n16 and 13 n17 of respondent's answer. Respondent states in its brief that it "recognizes the Board's decision that to strike Section 2(a) from the Lanham Act as unconstitutional is beyond its authority ... [but] the Board nonetheless remains obliged to apply the statute's terms in a constitutional manner" (respondent's brief, n. 29, *emphasis in original*). Respondent contends that "cancellation of Respondent's registrations would curb Respondent's First Amendment right to communicate through its trademarks and would therefore impermissibly regulate commercial speech ..." (*id.* at p.26); and that "as applied to Respondent, the terms 'scandalous' and 'disparage' are also unconstitutionally broad" (*id.*) and, therefore, respondent's First and Fifth Amendment rights are abridged. Finally, respondent argues that a Board determination in favor of petitioners would "amount

to impermissible viewpoint discrimination" in violation of the First Amendment (*id.* at p. 28).

n15 This paragraph reads as follows: "Petitioners' claims under Section 14 of the Lanham Act, *15 U.S.C. § 1064*, are barred because they are based upon Section 2(a) of the Lanham Act, *15 U.S.C. § 1052(a)*, which abridges the Respondent's right to freedom of speech provided by the First Amendment of the United States Constitution. Respondent's registered marks are a form of speech protected by the First Amendment of the United States Constitution and thus cannot be regulated or canceled merely because these Petitioners may find them objectionable."

n16 This paragraph reads as follows: "Petitioners' claims are barred because the statutory language of Section 2(a) of the Lanham Act, *15 U.S.C. § 1052(a)*, relied upon by Petitioners in connection with the cancellation petition herein under Section 14 of the Lanham Act, *15 U.S.C. § 1064*, is unconstitutionally overbroad."

n17 This paragraph reads as follows: "Petitioners' claims are barred because the statutory language of Section 2(a) of the Lanham Act, *15 U.S.C. § 1052(a)*, relied upon by Petitioners in connection with the cancellation petition herein under Section § 14 of the Lanham Act, *15 U.S.C. § 1064*, is unconstitutionally void for vagueness."

[*12]

Respondent contends, essentially, that the constitutional arguments in its brief are distinguished from its stricken "affirmative defenses" because the "affirmative defenses" comprise a general attack on the constitutionality of Section 2(a), whereas the arguments in respondent's brief challenge the constitutionality of Section 2(a) "as applied to respondent." We believe that this is a distinction without a difference. Rather, we find respondent's constitutionality arguments propounded in its brief to be, in substance, the same as, or encompassed by, the "affirmative defenses" asserted in paragraphs 11, 12 and 13 of respondent's answer. First, respondent's argument in its brief that the cancellation of its registrations would curb its First Amendment right to communication and impermissibly regulate commercial speech is contained within the broad language of respondent's "affirmative defense" asserted in paragraph 11 of its answer. Further, the "defense" specifically identifies the effect on respondent and is not stated in general terms.

Second, respondent's arguments in its brief that the terms "scandalous" and "disparage" are overbroad and vague are contained within the unqualified [*13] language of paragraphs 12 and 13 of respondent's answer.

Third, even though it is not expressly identified therein, we find that respondent's assertion of "impermissible viewpoint discrimination" in violation of the First Amendment is encompassed by the very broadly pleaded "affirmative defense"

asserted in paragraph 11 of respondent's answer, wherein respondent asserts a First Amendment violation generally. n18

n18 In alleging "impermissible viewpoint discrimination," respondent acknowledges the Board's statements in *In re Old Glory Condom Corp., 26 USPQ2d 1261, 1220 n.3 (TTAB 1993),* that the issuance of a registration is neither an endorsement of the goods on which the mark is used, nor an implicit government pronouncement that the mark is a good one, from an aesthetic or any other viewpoint. However, respondent then cites *Sons of Confederate Veterans, Inc. v. Glendening, 954 F. Supp. 1099, 1104 (D. Md. 1997),* and argues that a decision for petitioners in the case before us would not be a viewpoint-neutral decision as required by the First Amendment. In the cited case, the court noted that, regardless of the forum (*i.e.*, public, limited or designated public, or private), any government regulation of speech must be viewpoint-neutral. In that case, in response to complaints of negative racial connotations, the Maryland Motor Vehicle Administration (MVA) suspended and recalled license plates, issued to members of the Sons of Confederate Veterans, which displayed a logo containing the Confederate battle flag. Finding that the Confederate battle flag does not mean the same thing to everyone, the court concluded that, in halting the issuance of the license plates, the MVA had advanced the view of those offended by the flag and discouraged the

> viewpoint of those proud of it, which constituted impermissible viewpoint discrimination.
>
> The logical conclusion of respondent's line of reasoning in the case before us is that all Board decisions pertaining to Section 2(a) scandalousness or disparagement constitute viewpoint discrimination since the Board must find that a challenged mark either is or is not scandalous or disparaging. This is, essentially, an attack on the constitutionality of Section 2(a). As we have already stated in this case, the Board is without authority to determine the constitutionality of Section 2(a).

[*14]

Again, to the extent that it may be necessary, we reaffirm the Board's decision in striking respondent's affirmative defenses in paragraphs 11, 12 and 13 of its answer. Further, that decision is equally applicable to the constitutional arguments asserted by respondent in its brief. However, should respondent's aforementioned arguments ultimately be found to differ from those set forth in respondent's answer, we find such arguments unpersuasive, as the Board has no authority to determine, either generally or with respect to respondent, whether Section 2(a) is overbroad or vague, or to declare provisions of the Trademark Act unconstitutional. *See, In re McGinley, 660 F.2d 481, 211 USPQ 668, 672 (CCPA 1981), aff'g 206 USPQ 753 (TTAB 1979).* Thus, we have given no further consideration to respondent's arguments regarding the constitutionality of Section 2(a).

Indian Trust Doctrine

Petitioners maintain that the Indian trust doctrine should be applied by the Board in determining the Section 2(a) issues raised in this case. The Indian trust responsibility is a judicially created doctrine that has evolved from its first appearance in Chief [*15] Justice Marshall's decision in *Cherokee Nation v. Georgia, 30 U.S. (5 Pet.) 1 (1831).* There, in an action to enjoin enforcement of state laws on lands guaranteed to the Cherokee Nation by treaties, Chief Justice Marshall observed that Indian tribes, rather than being foreign states, "may, more correctly, perhaps, be denominated domestic dependent nations . . . in a state of pupilage," and concluded that "their relation to the United States resembles that of a ward to his guardian." *Id. at 17.*

The trust doctrine is by no means clear or consistent in basis or application. n19 Courts have defined the scope of the federal government's fiduciary duties by looking to treaties, statutes, the federal common law of trusts and a combination of these sources for guidance. n20 Based on a treaty or statute, they have applied the doctrine in connection with the application of federal criminal laws to tribal members on reservations, n21 to allowing Indian hiring preferences in the Bureau of Indian Affairs n22 and to the dissolution of Indian tribes' governing structures. n23 When looking to the common law of trusts, courts typically identify a trustee (the United [*16] States), a beneficiary (the Indian tribes or the Indians) and a trust corpus. In most cases, the trust corpus comprises Indian funds, n24 Indian lands n25

or their appurtenances such as timber, n26 hunting, n27 and fishing rights. n28

n19 *See*, D. McNeill, *Trusts: Toward an Effective Indian Remedy for Breach of Trust*, 8 Am. Ind. L. Rev. 429, 430 (1980).

n20 *See*, N. Newton, *Enforcing the Federal-Indian Trust Relationship After Mitchell*, *31 Cath. U.L. Rev. 635, 638 (1982).*

n21 *United States v. Kagama, 118 U.S. 375 (1886)* (upholding constitutionality of the Major Crimes Act as an exercise of congressional guardianship power).

n22 *Morton v. Mancari, 417 U.S. 535 (1974)* (denying an equal protection challenge against Indian hiring preferences).

n23 *Board of Commissioners v. Seber, 318 U.S. 705 (1943).*

n24 *Seminole Nation v. United States, 316 U.S. 286 (1942)* (Seminole trust fund for per capita payments).

n25 *United States v. Creek Nation, 295 U.S. 103 (1935)* (Creek land sold to non-Indians following an incorrect federal survey of reservation boundaries).

n26 *See, Mitchell v. United States, 445 U.S. 535 (S.Ct. 1980)* (timberlands of Quinault Indian Reservation).

n27 *Menominee Tribe v. United States, 391 U.S. 404 (1968)* (reservation lands implicitly secured rights to hunt).

n28 *Alaska Pacific Fisheries v. United States, 248 U.S. 78 (1918)* (fishing rights of Metlakahtla Indians on Annette Islands in Southeastern Alaska).

[*17]

The Supreme Court decisions of *Mitchell v. United States, 445 U.S. 535 (1980)*, and *Mitchell v. United States, 463 U.S. 206 (1983)*, pertaining to the same facts but different statutes, establish a fiduciary obligation in instances where a treaty, executive order or agreement contains language concerning a trust or a trust responsibility. In determining whether a trust obligation exists, these cases require consideration of (a) the underlying statutes, agreements, treaties or executive orders, (b) actual supervision over the property or rights in question and (c) the elements of a common law trust. Thus, in determining whether a trust obligation exists, at a minimum, a tribunal would have to search for support in the underlying statute, treaty, agreement or executive order for a trust obligation.

However, officials of the executive branch of the federal government have undertaken actions that affect Indians and Indian tribes based on a statute when the authorizing or underlying statute is silent as to a trust or fiduciary obligation. Most reported decisions addressing such actions involve officials of the Bureau of Indian Affairs or the Bureau of [*18] Land Management, both of which have jurisdiction

over Indian lands, forests, etc. which form part of a traditional trust corpus. Where the doctrine has been applied, it is based solely on a judicially imposed trust responsibility. n29 Other cases have found no trust relationship or have narrowly applied the trust relationship. n30

n29 *See, e.g. Lane v. Pueblo of Santa Rosa, 249 U.S. 110 (1919)* (the Court enjoined the Secretary of the Interior from disposing of tribal lands under the general public land laws); *Cramer v. United States, 261 U.S. 219 (1923)* (the Court voided a federal land patent that 19 years earlier had conveyed lands occupied by Indians to a railway, even though the Indians' occupancy of the lands was not protected by any treaty, executive order, or statute; the Court found the trust responsibility limited the general statutory authority of federal officials to issue land patents); *United States v. Creek Nation, 295 U.S. 103 (1935)* (money damage award affirmed to the Creeks for the taking of lands which had been excluded from their reservation and later sold to non-Indians following an incorrect federal survey of reservation boundaries); *Navajo Tribe of Indians v. United States, 624 F.2d 981 (Ct. Cl. 1980)* (the government's argument that the fiduciary obligation only arises on an express or statutory term of trust is irrelevant to claims involving accounting for mismanagement and disposition of Navajo funds and property when government has taken on or controls or supervises such funds

and property); and *Manchester Band of Pomo Indian, Inc. v. United States, 363 F. Supp. 1238, 1245-46 (N.D. Cal. 1973)* (the duty to make trust property income productive arises from the trust relationship between an Indian tribe and the United States; it exists even in the absence of a specific statute). Recognizing a fiduciary duty in *Pyramid Lake Paiute Tribe v. Navy, 898 F.2d 1410 (9th Cir. 1990)* (finding Navy's outlease program did not violate the affirmative obligation to conserve endangered species under the Endangered Species Act, court recognized that Secretary of Interior has a fiduciary duty to preserve and protect the Pyramid Lake fisheries).

n30 *See, e.g., Gila River Pima-Maricopa Indian Community v. United States, 427 F.2d 1194 (Ct. Cl. 1970), cert. denied, 400 U.S. 819 (1970)* (no duty to provide adequate educational facilities, instructors and instruction in particular subjects created by affirmative acts of providing Indian education, health services and administration); and *Virgil v. Adrus, 667 F.2d 931 (10th Cir. 1982)* (recognizing broad government fiduciary responsibility to Indian tribes, court nevertheless found trust relationship did not require provision of free lunches to all Indian children because no express provision in any statute or treaty requiring government to provide free lunches).

[*19]

It is well established as a corollary to the trust doctrine that the meaning of *certain* treaties,

agreements, statutes and administrative regulations must be construed favorably to Indians. See, *Jones v. Meehan, 175 U.S. 1, 10-11 (1899); Choate v. Trapp, 224 U.S. 665 (1912);* n31 *Alaska Pacific Fisheries v. United States, 248 U.S. 78 (1918);* and *United States v. Santa Fe Pacific Railroads, 314 U.S. 339 (1941), reh'g denied, 314 U.S. 716 (1942).* More recently, the Supreme Court recognized in *Northern Cheyenne Tribe v. Hollowbreast, 425 U.S. 649 (1976),* that "statutes passed for the benefit of the Indians are to be liberally construed, and all doubts are to be resolved in their favor." This suggests that the liberal construction doctrine does not apply to every statute, but only those which are primarily directed to Indians, Indian assets or Indian affairs. n32

n31 Extending this principle to Indian agreements, which took the place of Indian treaties. See, C. Decker, *The Construction of Indian Treaties, Agreements, and Statutes,* 5 Am. Ind. L. Rev. 299, 301 (1977).

n32 While treaties and agreements are bilateral dealings, wherein the tribes are involved with representatives of the United States, this is not the case with acts of Congress. In *Rosebud Sioux Tribe v. Kneip, 430 U.S. 584 (1977),* the Court noted the "general rule" that "doubtful expressions are to be resolved in favor of the weak and defenseless people who are wards of the nation, dependent upon its protection and good faith," *Id. at 586,* but went on to point out:

> But the 'general rule' does not command a determination that reservation status survives in the face of congressionally manifested intent to the contrary . . . . In all cases 'the face of the Act,' the 'surrounding circumstances,' and the 'legislative history,' are to be examined with an eye towards determining what congressional intent was . . . .

Id. at 587. Accordingly, application of the liberal construction rule to statutes should be based on congressional intent.

[*20]

Petitioners, members of federally recognized Indian tribes, have asserted, *inter alia*, that under the Indian trust doctrine, the Board owes them "a higher degree of care and deference in construing the provisions of Section 2(a) than it would otherwise owe persons not belonging to federally recognized Indian tribes." In support of this contention, petitioners argue that the trust relationship between the federal government and Native Americans is broadly defined, citing *Pyramid Lake Paiute Tribe v. Navy, 898 F.2d 1410 (9th Cir. 1990)*, wherein the

court states that "while most cases holding the government to this [fiduciary] duty have involved Indian property rights, the government's trustee obligations apparently are not limited to property." *Id. at 1420-21.*

Respondent argues, on the other hand, that a fiduciary duty arises only when there is an agreement between the federal government and an Indian tribe in an area where the Indians have a specific economic interest, citing *Mitchell v. United States, 463 U.S. 206 (1983)* for the proposition that, when there is no statute, regulation, writing, agreement or implied obligation [*21] governing the relationship between the Patent and Trademark Office (PTO) and Native Americans that would impose any sort of fiduciary duty on the Board, the trust doctrine does not apply. n33

> n33 While respondent's trial brief is silent on this issue, we refer to respondent's arguments in opposition to the motion for leave to file an *amicus* brief in this case.

We find that the Indian trust doctrine is inapplicable to the case before us and we decline to apply it herein. We have found no decisional law addressing the Indian trust doctrine in the context of a patent, trademark or copyright case. Thus, we have considered this as an issue of first impression in relation to the Trademark Act. The majority of cases relied upon by petitioners for application of the trust doctrine herein involve statutes or treaties specifically directed towards Native Americans,

which is not the case with the Trademark Act. Nor do we find any language in the Trademark Act of 1946, as amended, or its legislative history, that specifically obligates the federal government to undertake any fiduciary responsibilities on behalf of Native Americans.

Further, we find no basis for petitioners' contention [*22] that the trust relationship applies even in the context of a statute, such as the Trademark Act, that has broad application to both Native Americans and non-Native Americans. Petitioners rely on the *Pyramid Lake* case in this regard, which is distinguishable from the case herein since the claims in that case involved a body of water, Pyramid Lake, which was specifically reserved for the Tribe based on an Executive Order signed by President Grant in 1874. Thus, *Pyramid Lake* involves an item of trust property that was specifically identified in the creation of the trust, which is not the case before us. n34 Here, Indian land, water, fish, timber or minerals, i.e. typical elements of an Indian trust corpus, are not in issue. No specific item of Native American intellectual property is in issue. In fact, the subject registrations are not owned by petitioners or even by Native Americans - the registrations are owned by non-Native Americans. Thus, under a common law trust analysis, the trust doctrine cannot apply since there is no identifiable trust corpus.

n34 We note the case of *Hornell Brewing Co., Inc. v. Brady, 819 F. Supp. 1227 (E.D.N.Y. 1993)*, wherein the court found that the Indian

> trust doctrine did not apply in connection with a First Amendment challenge to Pub. L. 102-393, § 633, prohibiting labeling of distilled spirits, wine and malt beverage products bearing the name "Crazy Horse." In *Hornell*, the plaintiff placed the label "Crazy Horse Malt Liquor" on a series of alcoholic beverages pursuant to a Certificate of Label Approval from the Bureau of Alcohol, Tobacco and Firearms. "Crazy Horse" is the name of an Indian chief who was known for urging his people not to drink alcohol. After public outcry, Congress enacted Pub. L. 102-393, § 633. While *Hornell* ultimately found the statute unconstitutional under the First Amendment, the court did *not* accept the government's argument that the statute was constitutional in view of the trust relationship with American Indians. Specifically, the court noted that while cases have applied the trust relationship in connection with various classifications, the challenged classifications "in some way treated Native Americans differently from the rest of the population. . . . [and thus] the cases are not analogous to Public Law 102-393, § 633." *Id. at 1236.*

[*23]

As for petitioners' argument that evidence submitted by Native Americans -- in any context -- is to receive greater weight than other evidence, we find no authority for that proposition in the decisional law applying the trust doctrine, even in actions involving typical Indian trust property such as tribal funds or tribal lands. n35 Thus, we find no

basis for extending the Indian trust doctrine to the Trademark Act in the case before us. n36

n35 Petitioners contend that the Indian trust doctrine should be applied in this case under either of two conditions: (a) if "the Board were to consider the evidence more evenly balanced" or (b) "to the extent that any doubt remains as to the cancelability" of the subject marks. Petitioners provide no legal basis for this proposition. Moreover, in this case, we do not "consider the evidence more evenly balanced" and our decision does not involve any doubt.

n36 We do not decide the question of whether the Indian trust doctrine applies, generally, to the Trademark Act. Our decision relates only to the case herein.

Protective Order

Petitioners filed two exhibits under notice of reliance that are labeled "Confidential, Filed Under [*24] Seal Subject To Protective Order" (Exhibit No. 7, "Respondent's Licensing Agreements"; and Exhibit No. 25.001, "3/27/72 Pro-Football, Inc. Minutes of Regular Meeting"). Additionally, the testimony deposition of John Kent Cooke contains several noted pages that have been separately bound and designated as confidential. n37 However, the record does not contain a protective order pertaining to these exhibits and testimony. n38

n37 Additionally, these pages refer to several exhibits submitted in connection with this deposition and indicate that the referenced exhibits are also confidential.

n38 The Board, in its decisions of December 15, 1995, and October 24, 1996, on various motions of the parties, respectively, granted petitioners' motion for a protective order only to "the extent that petitioners need not respond to those discovery requests denied in respondent's motion to compel" and granted respondent's motion for a protective order only to the extent that certain depositions were considered complete and conditions were specified for the taking of certain other depositions. Neither order pertains to the submission of confidential documents by either party and the record does not contain such a protective order.

[*25]

In this regard, we note the relevant provisions of Trademark Rule 2.125(e), *37 CFR § 2.125(e)*:

> Upon motion by any party, for good cause, the Trademark Trial and Appeal Board may order that any part of a deposition transcript or any exhibits that directly disclose any trade secret or other confidential research, development, or

> commercial information may be filed under seal and kept confidential under the provisions of § 2.27(e).

Neither petitioners nor respondent requested a protective order with respect to these exhibits, nor did the parties file a stipulated protective order. Within thirty days from the date of this decision, petitioners and/or respondent are directed to prepare a protective order, preferably upon terms mutually agreeable to them, for the Board's consideration upon motion, including an explanation of why the exhibits and testimony proposed to be considered confidential are deemed to be confidential in nature. We will keep petitioners' exhibits and Mr. Cooke's testimony and exhibits which are designated "confidential" under seal until we decide a motion for a protective order if one is submitted or, if no motion is submitted [*26] within the specified period, we will place petitioners' Exhibits Nos. 7 and 25.001 and Mr. Cooke's testimony and exhibits in the cancellation file.

Respondent's Motion To Strike Notice Of Reliance And Testimonial Depositions

On March 27, 1997, respondent filed a "Motion for Discovery Sanctions" based upon petitioners' alleged failure to produce during discovery several specified sets of documents and materials which were introduced as evidence during petitioners' testimony period. Respondent requested that the Board (1) preclude petitioners from introducing the documents into evidence during the testimony period; (2) modify petitioners' notice of reliance to delete the documents; and (3) strike testimony

related to the documents by petitioners' witnesses. The Board, in its order of July 28, 1997, determined that the subject motion would be treated as a motion to strike a notice of reliance and testimonial depositions and that it would be determined at the time of final decision. Thus, we consider this motion now.

In particular, respondent seeks exclusion of (1) a 1993 resolution of the National Congress of American Indians (1993 NCAI resolution) n39 and documents and [*27] testimony of Joann Chase, Susan Harjo and Raymond Apodaca related thereto; (2) a resolution of the Portland, Oregon, Chapter of the American Jewish Committee (Portland resolution) and documents and testimony of Judith Kahn related thereto; (3) a resolution of Unity '94 (Unity resolution), an organization described as a coalition of four minority journalist associations, and documents and testimony of Walterene Swanston related thereto; and (4) a videotape and related documents created by Susan Courtney (Courtney videotape) and testimony of Susan Courtney and Geoffrey Nunberg related thereto.

n39 Respondent identifies this resolution by its title "Resolution in Support of the Petition for Cancellation of the Registered Service Marks of the Washington Redskins AKA Pro-Football Inc." This resolution, No. EX DC-93-11, was passed by the Executive Council of the National Congress of American Indians (NCAI) and is distinguished from another 1993 resolution, No. NV-93-143, entitled "Resolution

> to Justice Department Investigation of Human Rights Violations," passed by the NCAI General Assembly, which is also of record in this case.

Respondent argues, under Trademark Rule 2.120(g)(1) [*28] and *Fed. R. Civ. P. 37(b)(2)(B)*, that the aforementioned documents were not produced during discovery. Respondent maintains that, by not producing these documents prior to the close of discovery and not requesting an extension of the discovery period, petitioners have violated the Board's trial order setting the closing date for discovery. n40 Respondent asserts that, as a result, it was prejudiced and could not properly prepare for trial. Respondent has also raised certain other specific objections with regard to each of the items it seeks to exclude.

> n40 The Board, in its order of July 28, 1997, rejected respondent's arguments concerning petitioners' alleged non-compliance with an order and report and recommendation of the United States District Court for the District of Columbia in view of the Board's lack of jurisdiction to enforce such an order.

Respondent has made several very technical objections that we find to be without merit. We find that petitioners adequately disclosed information pertaining to the aforementioned documents during discovery and that petitioners have not violated any orders of the Board in relation thereto. [*29]

Additionally, we find respondent's further objections specified herein to be without merit.

In particular, regarding the 1993 NCAI resolution, the record reveals that both petitioners and NCAI (a non-party) disclosed copies of the 1993 NCAI resolution during discovery; that both petitioners and NCAI disclosed during discovery what further minimal information each had regarding the resolution n41; and that the differences between the several copies of the resolution disclosed are insignificant.

> n41 The Board has never ordered petitioners to provide additional discovery referring or relating to the NCAI 1993 resolution. Respondent does not identify any specific document request for which petitioners have withheld documents. As Document Request No. 3 appears to be the only document request that covers the 1993 resolution and related communications, the discussion herein is limited to the same. The Board's December 15, 1995 order at p. 3 specifically states with respect to Document Request No. 3, that "petitioners have already provided all responsive documents and things within their possession, custody and control" and denies respondent's motion to compel regarding this request. Thus, at least with respect to discovery requests concerning the NCAI resolution, petitioners have responded in full and the requests are not the subject of any Board or court order.

> Further, the Board does not have the authority to hear any complaints about NCAI's failure to produce documents as NCAI is not a party herein. Nor is there is any evidence in the record for treating petitioners and NCAI as one; *e.g.*, that they are in collusion, that one controls the actions of the other or that petitioners have initiated the cancellation proceeding in their capacity as officers or representatives of NCAI.

[*30]

We conclude that the 1993 NCAI resolution submitted by petitioner as an exhibit to Mr. Apodaca's testimony has been properly authenticated by Mr. Apodaca as a copy of the resolution that was passed by the Executive Council of the NCAI, and that the authenticity of this document has been corroborated by the testimony of Ms. Joann Chase, Executive Director of NCAI, based on the regularly kept records of NCAI.

Finally, with regard to the 1993 NCAI resolution, we conclude that respondent's assertion pertaining to the circumstances under which the resolution was adopted (*e.g.*, whether persons voting on the resolution understood the specific nature of the referenced registrations and cancellation proceeding) goes to the probative value of the document rather than to its authenticity and, thus, its admissibility. Similarly, we are not persuaded that the resolution is irrelevant by respondent's argument that this resolution does not pertain to opinions held during the relevant time periods. The 1993 NCAI resolution is not irrelevant. Evidence concerning the

significance of the word "redskin(s)" before and after the relevant time periods may shed light on its significance during those [*31] time periods.

Thus, respondent's motion to strike the 1993 NCAI resolution and related testimony and documentation is denied.

Regarding the Portland and Unity resolutions and the Courtney videotape, we note, at the outset, that respondent does *not* allege that petitioners have failed to provide the documents pursuant to one of respondent's discovery requests. Instead, by alleging that petitioners violated the Board's scheduling order, n42 respondent appears to rely on the automatic disclosure requirements of *Fed. R. Civ. P. 26(a)(3)* requiring, within a specified time frame, the disclosure of documents to the opposing party which the disclosing party anticipates will be used at trial. Although Trademark Rule 2.120(a) provides that the provisions of the Federal Rules of Civil Procedure relating to discovery shall apply in Board proceedings, the Office has determined that several provisions of the Federal Rules do not apply to the Board, including *Fed. R. Civ. P. 26(a)(3). See, Effect of December 1, 1993 Amendments to the Federal Rules of Civil Procedure on Trademark Trial and Appeal Board Inter Partes* [*32] *Proceedings*, 14 TMOG 1159 (February 1, 1994). *See also, Trademark Trial and Appeal Board Manual of Procedure*, Section 419, *para.* (7), and cases cited therein. Petitioners were not under any obligation to prepare a list of trial witnesses and documents. Therefore, the fact that the resolutions were not specifically named in the list of documents proffered to respondent is of no consequence.

> n42 Respondent references the Board's order of October 24, 1996, which decided a motion to compel and several discovery disputes, and included a scheduling order resetting the close of discovery and trial dates. We find that petitioners have not violated the scheduling order. Further, we do not find any reference in the remaining portion of the order that could be understood to require production of the resolutions or videotape discussed herein.

Further, the procedure set forth in *Fed. R. Civ. P. 34* for the production of documents pertains only to discovery from parties. It does not pertain to the discovery of documents *not* in the possession of a party. Except under certain circumstances not present in this case, a party does not [*33] have an obligation to locate documents that are not in its possession, custody or control and produce them during discovery. n43 There is no indication in this record that petitioners had copies of either the Portland and Unity resolutions or the Courtney videotape in their possession, custody or control during the discovery period; thus, petitioners were not under any obligation to produce a copy of the Unity '94 or Portland Chapter resolutions during discovery. They also were not under any obligation, under *Fed. R. Civ. P. 26*, to identify the documents in advance of trial. n44

n43 In fact, *Fed. R. Civ. P. 34(c)* directs a party seeking discovery of third-party documents to the subpoena procedure authorized by *Fed. R. Civ. P. 45*. A Rule 45 subpoena would not have involved petitioners. See J. Moore, A. Vestal and P. Kurland, *Moore's Manual Federal Practice and Procedure*, § 15.11 (1998).

n44 Further, we find respondent's contentions disingenuous. Although a party has an obligation to amend its discovery responses as information becomes available to it, amendment was not the issue herein. Well prior to the close of discovery, petitioners notified respondent of their intention to rely on "resolutions from various organizations protesting use of the term 'redskins' and Indian names in sports"; and of their intention to rely on a montage of films, naming at least some of the films it would include, and that petitioners' expert, Dr. Nunberg, would rely, in part, on cinematic evidence in forming his opinions. However, there is no indication herein that respondent sought more specific information or that petitioners refused to comply. We note, further, that the Courtney videotape was not completed until shortly before Ms. Courtney's deposition. Petitioners gave the videotape to respondent within a reasonable time after its completion, albeit shortly before Ms. Courtney's deposition.

[*34]

With respect to the Portland resolution, we conclude that Ms. Kahn's testimony is adequate to authenticate this resolution. Additionally, we are not persuaded by respondent's arguments that the resolution is irrelevant. As we have stated with respect to the 1993 NCAI resolution, evidence concerning the significance of the word "redskin(s)" before and after the relevant time periods may shed light on its significance during those time periods. We have given no further consideration to respondent's arguments in the context of the admissibility of this evidence.

With respect to the Courtney videotape, we are not persuaded that alleged flaws in the methodology employed by Ms. Courtney in compiling the film montage contained on the Courtney videotape render the videotape inadmissible. Ms. Courtney is presented by petitioners as an expert in film, and she testified that the methods she employed in compiling this film montage both met the parameters of the job as described to her and are consistent with standards in her field for compiling such a montage. Respondent has provided no evidence suggesting otherwise. Further, neither Dr. Nunberg nor Ms. Courtney, in their testimony, present [*35] this montage as other than a sample of films in the Western genre wherein the word "redskin" appears. This is not a survey and, as such, it is not subject to the standards established for such undertakings. We find the film montage does not run afoul of the principles established in *Daubert v. Merrell Dow Pharmaceuticals, Inc., 509 U.S. 579 (1993)*. Any deficiencies in the methodology used in preparing this videotape pertain to its probative value rather than to its admissibility.

Thus, respondent's motion to strike the Unity '94 resolution, the Portland resolution, the Courtney videotape, and related testimony and documents is denied. In short, respondent's motion to strike is denied in its entirety.

Respondent's Motion, In Its Brief, To Strike Testimony And Exhibits

In addition to those objections addressed above in relation to its earlier motion to strike, n45 respondent, in its brief, renews numerous objections to the entire testimony of certain witnesses, to specified statements of certain witnesses, and to specified exhibits introduced in connection with the testimony of certain witnesses. Additionally, respondent objects to specified exhibits submitted [*36] by petitioners' notices of reliance. Respondent moves to strike the aforementioned testimony and exhibits. These objections are considered below.

> n45 Objections raised in respondent's brief that are addressed herein in connection with respondent's earlier motion to strike are not considered again.

Before turning to the specific objections, we address two general points pertaining to several of respondent's objections. First, respondent has made numerous objections aimed at excluding various witnesses' views on the nature and use of the word "redskin(s)." We emphasize that witnesses' opinions on the specific questions of whether "redskin(s)" is scandalous, disparaging, or falls within the other

pleaded proscriptions of Section 2(a) are not determinative. The Board must reach its own conclusions on the legal issues before it, based on the record in each case. The Board will not simply adopt the opinions of particular witnesses on the ultimate questions of scandalousness or disparagement, even if such witnesses are experts. *See, Saab-Scania Aktiebolag v. Sparkomatic Corp., 26 USPQ2d 1709 (TTAB 1993)* and cases cited therein. Thus, rather than excluding this evidence, [*37] we have considered such statements as reflecting the witnesses' views and we have not accorded these statements determinative weight as to the ultimate issues before us.

Second, respondent made a number of objections on the basis of relevance, contending, variously, that the challenged testimony or exhibit is (1) unrelated to the use of "redskin(s)" by the Washington team; (2) unrelated to the use of the word "redskin(s)"; (3) only one individual's view, which is not representative of the majority of Native Americans; (4) outside the relevant time period; and/or (5) unrelated to any issue in this proceeding.

Except as otherwise indicated herein, we find respondent's objections on the stated grounds of relevance to be without merit. While respondent contends, in part, that "redskin(s)," as used and registered in connection with its football team, connotes *only* its football team, petitioners contend otherwise. Thus, evidence of uses of the word "redskin(s)" that are unrelated to the use of that word in connection with respondent's football team are relevant to the development of petitioners' case. Similarly, the views of individuals are cumulative

and are not inadmissible simply [*38] because they cannot possibly, alone, be representative of the views of the majority of Native Americans. While several witnesses may claim that their individual views are also representative of other Native Americans' views, such statements have been taken for what they are, namely, the views of particular individuals.

Respondent's objections on the grounds of relevance that certain evidence is unrelated to the use of "redskin(s)" because it is outside the relevant time period, and/or is unrelated to any issue in this proceeding, are not well taken. As stated herein, evidence concerning the significance of the word "redskin(s)" before and after the relevant time periods may shed light on its significance during those time periods. Thus, it is relevant for petitioners to submit testimony and exhibits from various time periods that address the attitudes of both Native Americans and the majority culture in the United States towards Native Americans, n46 including evidence pertaining to a wide range of derogatory and/or stereotypical imagery and words.

n46 This reasoning in favor of admissibility is equally applicable to evidence regarding the word "redskin(s)" long prior to the issuance of the subject registrations, as well as evidence relating to the period after the issuance of the subject registrations. We have considered the probative value of such evidence in the context of the entire record before us.

[*39]

1. Objections to Testimony and Exhibits in Their Entirety.

Respondent seeks to exclude entirely certain testimony and exhibits. First, as is the case in many instances when a survey is introduced as evidence in litigation, respondent has raised a multitude of objections and perceived flaws regarding a survey introduced by petitioners, and contends that these flaws render the survey inadmissible. We find that petitioners' survey evidence is admissible and any deficiencies in the survey go to its probative value. The survey was designed and directed by an established expert in the field of trademark-related surveys, and was introduced through his testimony. The survey's methodology is adequately established as acceptable in the field, so that it is admissible as evidence herein. While we agree that several of respondent's criticisms have some merit, we note that even a flawed survey may be received in evidence and given some weight if the flaws are not so severe as to deprive the survey of any relevance. *See, Lon Tai Shing Co. Ltd. v. Koch & Lowy, 19 USPQ2d 1081 (SDNY 1990);* and *Helene Curtis Industries Inc. v. Suave Shoe Corp., 13 USPQ2d 1618 (TTAB 1989).* [*40] We discuss the merits and flaws of the study and its probative value below in the context of our analysis of the substantive issue before us.

Respondent contends that the depositions of petitioners' expert witnesses, Geoffrey Nunberg, Susan Courtney, Teresa LaFromboise, Arlene Hirschfelder and Frederick Hoxie, are inadmissible because each witness' disclosure statement under *Fed. R. Civ. P. 26* was written by petitioners'

attorneys, rather than by the witness, and was not signed by the witness. This objection has no merit. As discussed herein, the pertinent portions of *Fed. R. Civ. P. 26* are inapplicable to Board proceedings and, thus, no disclosure statement is required.

Further, respondent contends that Dr. Nunberg's statements concerning the disparaging nature of the word "redskin" lack a scientific basis; and that Dr. LaFromboise's testimony lacks the requisite standards for expert testimony and is not grounded in scientific method as it is anecdotal in nature. We are not persuaded that the aforementioned statements of Dr. Nunberg or the testimony of Dr. LaFromboise are inadmissible due to lack of [*41] scientific "basis" or "method." The nature of the witnesses' respective expertise and the basis for their opinions are adequately established and, further, neither witness claimed to base his or her testimony on a scientific study or survey. Any purported inadequacy that may exist in the testimony, such as the anecdotal nature of portions of Dr. LaFromboise's testimony, goes to the weight to be given to that testimony.

Respondent contends that Ms. Hirschfelder, as a teacher, and Dr. Hoxie, as a history professor, lack the qualifications to testify as experts on the linguistics topics that they address, and that there is no scientific basis for the opinions they express. We find Ms. Hirschfelder's expertise as an educator specializing in Native American studies and curriculum, including the effects of stereotyping on children, to be adequately established and sufficient to accept her testimony as an expert in this area. Similarly, we find Dr. Hoxie's expertise as a

historian specializing in the history of Native Americans in the United States to be adequately established and sufficient to accept his testimony as an expert in this area. We find respondent's objections as to lack of [*42] scientific basis for the opinions of these two witnesses to be without merit.

Respondent seeks to exclude a 1992 resolution of the Central Conference of American Rabbis (Petitioners' Exhibit 4.001) as irrelevant because it was adopted "outside the relevant time period" and was "passed by a group that does not have a single American Indian member." Respondent also seeks to exclude a 1972 letter by Harold Gross on behalf of the Indian Legal Information Development Services (Petitioners' Exhibit 32.007) as irrelevant because "at the time [the organization] had only 'at a maximum, seven' American Indian members"; the organization is no longer in existence; and "the sentiments expressed in the letter cannot be said to represent the views of any tribal chief or tribal leader, and plainly not the United States or American Indian population." For the reasons previously stated regarding respondent's objections on the grounds of relevance, we do not exclude, on the asserted grounds, either the 1992 resolution of the Central Conference of American Rabbis or the 1972 letter by Harold Gross.

2. Objections to Specified Testimony and Exhibits.

Respondent seeks to exclude specified testimony [*43] responsive to alleged objectionable questions by petitioners' attorney, and specified exhibits introduced in connection with testimony. These 75 pages of objections are identified in respondent's

Appendix A to its brief. Respondent objects to various questions by petitioners' attorney on the ground that such questions are leading, under *Fed. R. Evid. 611(c)*, and/or on the discretionary grounds that such questions are vague, lacking in foundation, argumentative, asked and answered, compound questions, questions calling for speculation or legal conclusions, and/or incomplete quotes or hypotheticals.

Having reviewed the allegedly objectionable questions, we find no merit to respondent's objections. Further, in view of the manner and frequency with which these types of objections were interposed by respondent throughout the questioning of witnesses by petitioners' attorneys, we find little purpose to these objections as made by respondent's attorney other than, possibly, obfuscation.

Respondent also objects to specified questions as requiring expert opinions of non-experts, and objects to specified testimony as hearsay or irrelevant. Respondent's objections [*44] to testimony exhibits include, variously, that such exhibits were never produced, n47 and/or are untimely, incomplete or irrelevant.

n47 As respondent does not identify any specific discovery requests, we assume respondent is referring to the automatic disclosure requirements of *Fed. R. Civ. P. 26(a)(3)* which, as discussed previously in

relation to respondent's earlier motion to strike, is inapplicable to Board proceedings.

We find respondent's specified objections to testimony on the basis of hearsay to be well taken as the specified questions clearly call for testimony as to the statements of third parties, asserted for the truth of the statements, and such testimony given does not fall into any of the exceptions to hearsay. Thus, we have not considered this evidence.

However, we find respondent's remaining objections pertaining to testimony, and exhibits thereto, to be without merit and we have not excluded evidence objected to on the alleged ground that expert opinions are sought from non-experts, or on the alleged grounds of lack of production, timeliness, completeness or, as previously discussed, relevance. Respondent does not [*45] specify its reasons for these objections in each case, nor are the reasons apparent. Regarding the allegation that petitioners asked for expert opinions from non-experts, we do not believe that the questions asked either seek opinions for which one would have to be an expert or seek opinions outside the expert's area of expertise. Additionally, as previously stated, all such opinions have been given weight based on our consideration of the background of the witness and in the context of the witness' testimony as a whole. As discussed in relation to respondent's earlier motion to strike, respondent's claims of lack of production are not well taken, as respondent has not identified any pertinent discovery requests to which petitioners' allegedly objectionable exhibits should have been responsive, and there is otherwise no general obligation on petitioners in Board

proceedings to disclose during discovery evidence to be used at trial. Further, we find the alleged incomplete evidence sufficiently complete for the purposes for which it is offered.

3. Objections to Notice of Reliance Exhibits.

Respondent also seeks to exclude specified exhibits submitted by petitioners' notices of [*46] reliance. These 52 pages of objections are identified in respondent's Appendix B to its brief. The objections are on several grounds, primarily relevance and hearsay.

We have considered each of respondent's objections and find them to be without merit. We note, in particular, that our previous discussion of relevance applies equally to the objections by respondent to the vast majority of these exhibits on the same grounds of relevance and we do not exclude any exhibits on this ground.

Regarding respondent's objections on the ground of hearsay, we reference our discussion, *infra*, concerning the extent to which the exhibits proffered by both parties are amenable to submission by notice of reliance. *See, Trademark Trial and Appeal Board Manual of Procedure (TBMP)*, Sections 707 and 708, and *37 CFR 2.122(e)*. Newspaper articles cannot be submitted by notice of reliance to establish the truth of the statements contained therein. Although respondent's objections to the newspaper articles on the ground of hearsay are therefore sustained to the extent that we have not considered the articles for the truth of their statements, they are still admissible for what [*47] they show on their face.

Thus, we have not excluded any of petitioners' newspaper articles.

Respondent objects to petitioners' Exhibits 93-105, consisting of videotapes, on the ground of timeliness. However, contrary to respondent's contentions, petitioners timely submitted Exhibits 93-105 with petitioners' notice of reliance on February 18, 1997, and this evidence has been considered. n48 The submission objected to contains excerpts from the videotapes previously submitted as Exhibits 93-105 and is characterized by petitioners as a "demonstrative exhibit." Since this excerpted version is untimely, as well as allegedly duplicative, it has not been considered.

> n48 Videotapes are not usually admissible by notice of reliance. However, as indicated, *infra*, this evidence has been considered properly submitted by notice of reliance in this case.

Further, respondent's objection, on the ground of relevance, that the videotapes comprising Exhibits 93-105 consist of excerpts that are taken out of context, is not a basis for excluding the videotape evidence. Excerpts are, by definition, taken from a larger whole and, thus, are out of context. This evidence has, of course, been viewed [*48] in terms of the entire record, wherein respondent has had its opportunity to provide the appropriate "context" for these excerpts.

Summary of the Arguments of the Parties

Petitioners

Petitioners state that the issues in this cancellation proceeding are whether petitioners have standing to file these petitions to cancel and whether, at the time respondent's registrations issued, the registered marks consisted of or comprised scandalous matter, or matter which may disparage Native Americans, or matter which may bring Native Americans into contempt or disrepute.

Petitioners contend that the subject registrations are *void ab initio* and that the word "redskin(s)" "is today and always has been a deeply offensive, humiliating, and degrading racial slur." Petitioners contend that "a substantial composite of the general public considers 'redskin(s)' to be offensive" and that "the inherent nature of the word 'redskin(s)' and Respondent's use of [its marks involved herein] perpetuate the devastating and harmful effects of negative ethnic stereotyping." Petitioners contend, further, that Native Americans "have understood and still understand" the word 'redskin(s)' [*49] to be a disparaging "racial epithet" that brings them into contempt, ridicule and disrepute.

Petitioners contend that the Board must consider "the historical setting in which the word 'redskin(s)' has been used." In this regard, petitioners allege that "the history of the relationship between Euro-Americans and Native Americans in the United States has generally been one of conflict and domination by the Euro-Americans"; that "beneath this socioeconomic system lay an important cultural belief, namely, that Indians were 'savages' who must be separated from the Anglo-American colonies and

that Anglo-American expansion would come at the expense of Native Americans"; that, in the 1930's, government policies towards Native Americans began to be more respectful of Native American culture; that, however, these policies were not reflected in the activities and attitudes of the general public, who continued to view and portray Native Americans as "simple 'savages' whose culture was treated mainly as a source of amusement for white culture"; and that it was during this time that respondent first adopted the name "Redskins" for its football team.

Petitioners presented the testimony of its [*50] linguistics expert, Dr. Geoffrey Nunberg, regarding the usage of the word "redskin(s)." Petitioners contend that the primary denotation of "redskin(s)" is Native American people; that, only with the addition of the word "Washington," has "redskin(s)" acquired a secondary denotation in the sports world, denoting the NFL football club; that the "offensive and disparaging qualities" of "redskin(s)" arise from its connotations; and that these negative connotations pertain to the word "redskin(s)" in the context of the team name "Washington Redskins." Regarding whether the negative connotations of "redskin(s)" are inherent or arise from the context of its usage, petitioners contend that "redskin(s)" is inherently offensive and disparaging.

Petitioners argue that the evidence supports their conclusions that, since the first written uses of the word, "redskin(s)" "has been and is used with connotations of violence, savagery, and oppression"; and that the usage "suggests a power relationship, with the whites in control, and the Indians in a

position of servitude or capture," and the usage "connects Indians with savagery." Petitioners allege the following:

> The term "redskin(s)" rarely [*51] appears in formal writing, such as judicial decisions, scholarly dissertations, government documents, or papers of diplomacy, where such terms as 'uncivilized' and 'savages' frequently appeared. The term has been reserved for informal writings as a slur of the most demeaning sort and as an epithet to influence the sensibilities of the general public. American newspapers ... reveal vivid examples of the offensive and disparaging use of "redskin(s)" as a term associated with violence, savagery, racial inferiority, and other negative ethnic stereotypes.

Petitioners argue that the frequency with which the word "redskin(s)" appears in the context of savagery, violence and oppression is explained by the negative connotation of that word which is not conveyed by such terms as "Indian," "Native American," or "American Indian"; and that the repeated appearance of "redskin(s)" in this context reinforces

its derogatory character. Petitioners' evidence in this regard includes newspaper articles, film excerpts, dictionaries and encyclopedias. Petitioners' linguistics expert, Dr. Nunberg, testified, *inter alia*, that "lexicographers considered the word 'redskin' from the '60s onward [*52] as a disparaging word which is variously labeled contemptuous, offensive, disparaging"; and that newspaper writers avoid using the word "redskin(s)", not because it is "too informal for use, even in the popular press," but because it is "a loaded pejorative term."

Petitioners contend that sports team names are chosen to reflect the team's location or to sound "fierce ... so as, in a symbolic way, to strike fear into the hearts of opponents." Petitioners' expert witness, Dr. Nunberg, states that "Redskins," as part of respondent's team's name, falls into the latter category and is intended to "evoke the sense of an implacable and ferocious foe"; that this association derives from the otherwise negative connotations of savagery and violence attributable to the word "redskin(s)"; and that the word "redskin(s)" as it appears in the team name "Washington Redskins" has not acquired "a meaning that somehow is divorced from or independent of its use in referring to Native Americans."

Respondent

Respondent begins by arguing that petitioners must establish their case under Section 2(a) by clear and convincing evidence; that petitioners' evidence is biased and flawed and falls far short [*53] of this standard of proof; and that petitioners' evidence does not focus on either the appropriate time period or

population and contains other specified inadequacies.

Respondent contends that the word "redskin(s)" "has throughout history, been a purely denotative term, used interchangeably with 'Indian'." In this regard, respondent argues that "redskin(s)" is "an entirely neutral and ordinary term of reference" from the relevant time period to the present; and that, as such, "redskin(s)" is "[synonymous] with ethnic identifiers such as 'American Indian,' 'Indian,' and 'Native American'." Respondent also states that, through its long and extensive use of "Redskins" in connection with professional football, the word has developed a meaning, "separate and distinct from the core, ethnic meaning" of the word "redskin(s)," denoting the "Washington Redskins" football team; and that such use by respondent "has absolutely no negative effect on the word's neutrality - and, indeed, serves to enhance the word's already positive associations - as football is neither of questionable morality nor *per se* offensive to or prohibited by American Indian religious or cultural practices."

Respondent [*54] states that while "the term 'redskin,' used in singular, lower case form references an ethnic group, [this] does not automatically render it disparaging when employed as a proper noun in the context of sports."

In response to petitioners' contentions, respondent argues that while "'redskin' may be employed in connection with warfare, [this] is but a reflection of the troubled history of American Indians, not of any negative connotation inherent in the term itself." Respondent argues that "'redskin' is

not always employed in connection with violence"; that, when "redskin" appears in a violent context, the neutrality of the word "redskin" is apparent from the fact that, as it appears in the evidence of record, the word "Indian" or "Native American" can be substituted therefor without any change in meaning; and, further, that it is often the negative adjective added to this neutral term that renders the entire phrase pejorative.

Respondent contends, further, that its evidence establishes that Native Americans support respondent's use of the name "Washington Redskins"; and that Native Americans "regularly employ the term 'redskin' within their communities."

Respondent concludes [*55] that its marks "do not rise to the level of crudeness and vulgarity that the Board has required before deeming the marks scandalous," nor do its marks disparage or bring Native Americans into contempt or disrepute. Respondent argues that disparagement requires intent on the part of the speaker and that its "intent in adopting the team name was entirely positive" as the team name has, over its history, "reflected positive attributes of the American Indian such as dedication, courage and pride." Similarly, respondent notes that third-party registrations portraying Native Americans and the United States nickel, previously in circulation for many years, portraying a Native American are similar to respondent's "respectful depiction in the team's logo"; and that petitioners have not established that this logo is scandalous, disparaging, or brings Native Americans into contempt or disrepute.

The Evidence

Particularly in view of the size of the record in this case, we find it useful to review the testimony and evidence submitted by the parties. First, we discuss the parties' notices of reliance. Then, except for the testimony and related exhibits of the parties' linguistics experts [*56] and marketing and survey experts, we summarize the testimony and related exhibits of, first, petitioners' witnesses and, second, respondent's witnesses. Next, we discuss the testimony and related exhibits of both parties' linguistics experts and draw conclusions in relation thereto. Finally, we discuss and draw conclusions regarding petitioners' survey, the testimony and other exhibits of petitioners' survey expert, and the testimony and related exhibits of respondent's marketing and survey expert in rebuttal.

The Parties' Notices of Reliance

A substantial amount of evidence was submitted by petitioners' and respondent's notices of reliance. We are dismayed by the parties' apparent unfamiliarity with, or disregard for, the Rules of Practice pertaining to the submission of notices of reliance before this Board. Except for responses to the opposing party's interrogatories, n49 third-party registrations, n50 and excerpts from dictionaries and encyclopedias, n51 newspapers n52 and books, n53 petitioners' and respondent's proffered exhibits are not amenable to submission by notice of reliance. *See, Trademark Trial and Appeal Board Manual of Procedure (TBMP)*, Sections 707 [*57] and 708, and *37 CFR 2.122(e)*. Certain "printed publications" are amenable to submission by notice of reliance because

such publications are considered, essentially, self-authenticating, although such publications must be identified as to their source and date of publication. In particular, the printed publications which may be placed in evidence by notice of reliance are books and periodicals available to the general public in libraries or of general circulation among members of the public or that segment of the public which is relevant to an issue in a proceeding. These printed publications do not include press releases by or on behalf of a party n54; press clippings, which are essentially compilations by or on behalf of a party of article titles or abstracts of, or quotes from, articles; studies or reports prepared for or by a party or non-party n55; affidavits or declarations; or, as a general rule, catalog advertising or product information. n56 Similarly, photographs, n57 videotapes, n58 transcripts, n59 letters, n60 resolutions, n61 contracts or minutes of meetings, n62 memoranda by or to the parties, n63 and, as a general rule, program guides n64 or [*58] yearbooks n65 are not admissible by notice of reliance as printed publications; nor are such documents otherwise admissible by notice of reliance.

n49 Petitioners submitted several of respondent's responses to petitioners' interrogatories.

n50 Petitioners submitted copies of third-party registrations.

n51 Petitioners submitted excerpts defining the word "redskin" from dictionaries and

encyclopedias, including volumes dated 1910, 1955, and various years from 1966-1996. Respondent submitted excerpts from dictionaries defining the word "redskin," including volumes from various years from 1965-1981; and an excerpt from the *American Heritage School Dictionary*, 1977, containing separate entries for "redskin" and "Redskin."

n52 While excerpts from newspapers are properly made of record by notice of reliance, such excerpts do not establish the truth of the statements contained therein. Rather, newspaper excerpts, considered in the context of the record and the issues in this case, are evidence only of the manner in which the term is used therein and of the fact that the public has been exposed to the articles and may be aware of the information contained therein. Thus, we have considered these excerpts for these purposes only. Additionally, excerpts that are unidentified as to either source or date have not been considered, as the extent to which such material is genuine and available to the public cannot be ascertained.

From newspapers, petitioners submitted articles, pictures, cartoons and advertisements pertaining to respondent's football team and its fans, including some material that is either undated or unidentified as to source, and including material from, variously, 1941-1994; articles featuring stories about the racial integration of respondent's team (including material from 1957-1961, 1969, 1986); editorials opposing respondent's team's name

(including material from 1969, 1979-1988, 1992); stories about protests by individuals and groups opposed to respondent's team's name (including material from 1987-1992); and excerpts of articles and headlines featuring the term "redskin(s)" as a reference to Native Americans and about the 19<th> century armed conflicts between the U.S. Government and Native Americans in the Western parts of the United States, including some undated material and including material from, variously, 1879-1891, 1913, 1922, 1932-1937, 1970-1974, and 1991-1992.

Respondent submitted excerpts of two newspaper articles and headlines featuring the term "redskin(s)" as a reference to Native Americans and about the 19<th> century armed conflicts between the U.S. Government and Native Americans in the Western parts of the United States, from 1890; articles and photographs from newspapers regarding respondent's football team, from various years from 1940-1994; and a 1992 newspaper article reporting a poll regarding respondent's team's name.

n53 Respondent submitted excerpts from *Ulysses*, by James Joyce; *Redskin*, by Elizabeth Pickett; "Paleface and Redskin," *The New Republic*, 1977; "Paleface and Redskin," essays by Philip Rahv, 1957; "Commentary: Research, Redskins, and Reality," by Vine Deloria, Jr., *The American Indian Quarterly*, Fall 1991; and a book cover of *Red Earth White Lies*, by Vine Deloria, Jr.

n54 Respondent submitted an undated press release regarding respondent's team and petitioners submitted several press releases.

n55 Certainly, a report by a government agency would be amenable to submission by notice of reliance as an official record. While petitioners submitted a report of the Michigan Department of Civil Rights, we have no information in the record that establishes whether this report can be considered an official record.

n56 Advertisements in newspapers or magazines available to the general public in libraries or in general circulation can be made of record by notice of reliance. Petitioners submitted advertisements for sports team clothing and accessories, alleged to be from National Football League (NFL) catalogs, one advertisement is dated 1985, and the remaining ads are undated. We have no information in the record regarding whether this evidence would so qualify for submission in this case.

n57 Petitioners submitted undated photographs alleged to be of the "Redskins Marching Band" and "Redskinettes" cheerleaders at respondent's team's football games. Respondent submitted photographs alleged to be of various schools and a motel featuring Native American-related names, themes and/or imagery.

n58 Petitioners submitted videotapes of NFL films and game clips and respondent submitted a videotape containing an excerpt from the 1996 movie *Courage Under Fire*.

n59 Petitioners submitted a film transcript; a transcript of a *60 Minutes* program; and documents transcribing the lyrics and musical score to respondent's team's fight song, *Rosie the Redskin*, both original and modified lyrics.

n60 Petitioners submitted, from respondent's files, letters expressing opposition to respondent's team name, dated, variously, from 1986-1993, and letters from respondent responding thereto; and 1993-1994 letters to respondent from an organization identified in the letters as the *Redskin Review*, and credentials letters. Respondent submitted letters expressing support for respondent's team name, dated, variously, from 1988-1992; and letters from Jack Kent Cooke regarding team issues, from 1983, 1987, 1992.

n61 Petitioners submitted resolutions of three organizations, from 1992 and 1994; and respondent submitted 1992 resolutions from alleged tribal organizations and letters from alleged tribal chiefs in support of respondent's team's name or in reference to other alleged uses of the name "Redskins" by sports teams.

n62 Petitioners submitted minutes of a meeting of Miami University officials; minutes of a meeting of respondent's board of directors; a copy of a Boston proclamation of 1755; and

copies of various contractual agreements between respondent and its musician and cheerleader groups.

n63 Respondent submitted a 1993 memo pertaining to a radio survey regarding respondent's team's name.

n64 To the extent that program guides are magazines available to the general public, these documents could be submitted by notice of reliance. Petitioners submitted covers of respondent's football team's game program guides featuring realistic portraits of identified Native American individuals, including an undated page from an opening game and cover pages from, variously, 1955-1960; covers of respondent's football team's game program guides featuring cartoons with caricatures of Native Americans, including several undated pages indicating "15<th> and 17<th> years," and pages from, variously, 1938-1958; and press guides and program guides from, variously, 1948-1990. Respondent submitted cover pages of respondent's football team's game program guides featuring realistic portraits of identified Native American individuals, from, variously, 1956-1960. However, the record contains no information indicating the extent to which these program guides may be in general circulation to the public.

n65 Petitioners submitted excerpts from "Washington Redskins" yearbooks, *Redskins Magazine*, and *Pro! Magazine*. These yearbooks

and magazines may be in general circulation to the public and, thus, amenable to submission by notice of reliance. However, the record contains no information in this regard.

[*59]

Both parties submitted material that is not properly made of record by notices of reliance, but neither party has objected on this basis to the material submitted by the other; in fact, both parties have treated all of this material as being properly made of record by notice of reliance. Thus, we have considered all such material of both parties as part of the record in this case. n66

n66 We have separately addressed, *supra*, respondent's objections to the admissibility of evidence on grounds other than whether the matter is proper for submission by notice of reliance.

We hasten to add that much of this evidence has been submitted without proper foundation and, thus, its probative value is severely limited. We note, however, that some of these exhibits were identified and authenticated by witnesses during their testimony and, therefore, have been considered, properly, in that context.

Petitioners

1. Summary of Petitioners' Witnesses and Evidence.

Each of the petitioners testified. Several witnesses, namely, Joanne Chase, of the National Congress of American Indians, Judith Kahn, of the American Jewish Committee of Portland, Oregon, Elliott Stevens, of the [*60] Central Conference of American Rabbis, and Walterene Swanston, formerly of Unity 94, a coalition of minority journalist organizations, testified as to resolutions that were passed by their respective organizations. Harold Gross, formerly of the Indian Legal Information Development Service, testified about correspondence and a meeting between his organization and Edward Bennett Williams, who owned the "Washington Redskins" *football* team at the time of this meeting and correspondence. Several witnesses testified in their areas of expertise: Geoffrey Nunberg in linguistics, Susan Courtney in film, Ivan Ross in trademark surveys, Frederick Hoxie in American history, Teresa LaFromboise in multicultural counseling issues, and Arlene Hirschfelder in Native American educational issues. The discovery and testimony depositions of the petitioners and witnesses, and exhibits in connection therewith, are of record. n67

n67 To the extent that the Board has excluded certain portions of testimony or individual exhibits, or portions thereof, in connection with objections made by the parties, these issues will not be discussed again herein. Rather, the discussion presumes that the excluded material has not been considered.

[*61]

2. Testimony of the Seven Petitioners.

Each of the petitioners testified that he or she is a Native American who is a registered member of a federally recognized Indian tribe. The petitioners described incidents when the word "redskin(s)" was directed at them, or at other Native Americans in their presence, by non-Native Americans in what they described as derogatory manners. These incidents were described as occurring at various times during petitioners' lives, beginning with the petitioners' childhoods, which go back, in some cases, to the 1950's. Each petitioner described feelings of anger and humiliation, among other feelings, that he or she experienced in these situations.

Each of the petitioners expressed his or her opinion about the word "redskin(s)," both as a term defined as "a Native American" and as part of the name of respondent's football team. To summarize some of these opinions, petitioners were unanimous that "redskin(s)" is a racial slur that is objectionable in any context referring to Native Americans; that the petitioners are not honored by the inclusion of the word "Redskins" in respondent's football team's name; that the manner of use of the team name [*62] by respondent, and the use of Native American imagery by respondent, the media and fans is insulting; that the part of respondent's marks that includes a portrait of a Native American portrays a stereotypical image; and that the mark REDSKINETTES is demeaning to Native American women.

Mr. Apodaca identified and authenticated the 1993 resolution of the National Congress of

American Indians (NCAI), No. EX DC-93-11, entitled "Resolution in Support of the Petition for Cancellation of the Registered Service Marks of the Washington Redskins AKA Pro-Football Inc.," which was introduced in connection with the testimony of Joanne Chase, of the NCAI. The resolution includes, and indicates NCAI's familiarity with, the petition to cancel in this case, the marks in the challenged registrations, and the context in which those marks are used. The resolution supports the petition to cancel and states that "the term REDSKINS is not and has never been one of honor or respect, but instead, it has always been and continues to be a pejorative, derogatory, denigrating, offensive, scandalous, contemptuous, disreputable, disparaging and racist designation for Native Americans," and that "the use of the [*63] registered service marks [in the challenged registrations] by the Washington Redskins football organization, has always been and continues to be offensive, disparaging, scandalous, and damaging to Native Americans."

A copy of a 1992 resolution by the Oneida Tribe, of which Mr. Hill is a member, was properly introduced in connection with Mr. Hill's testimony. It refers to, *inter alia*, the "Washington Redskins," and condemns the "use of Indian mascots in any form for any purpose, especially athletic teams, as being disrespectful and racist in implication and destructive of the self-esteem of Indian children," and resolves "to stop, in any lawful way, the insensitive and defamatory use of Indian characters, images and names for commercial or other public purposes such as professional sports teams like the Washington Redskins..."

3. Harold Gross.

Harold Gross testified that he was the director of the Indian Legal Information Development Service (ILIDS) n68 in 1972; that on January 15, 1972, he wrote a letter on behalf of his Native American colleagues to Edward Bennett Williams, the then-owner of the "Washington Redskins" football team, urging Mr. Williams to change the name [*64] of the football team n69; and that he and a group of seven individuals n70 met with Mr. Williams to express the group's view that the team's name is disparaging, insulting and degrading to Native Americans and to request that certain specified changes be made. n71 Mr. Gross testified that, as a result of this meeting, Mr. Williams agreed only to change certain of the lyrics of the team song, *Hail to the Redskins.*

n68 Mr. Gross testified that the ILIDS was a legislative oversight program located in Washington D.C. with a mission to train young Native Americans interested in careers in journalism, law or public affairs in the legislative process and to provide legislative information to the Native American tribes through a monthly magazine. ILIDS was founded in 1971 and folded into another organization, the Institute for Development of Indian Law, in 1973.

n69 The record includes a copy of this letter and subsequent letters between Mr. Gross and Mr. Williams, including a letter from Mr.

Williams forwarding to Mr. Pete Rozelle, the then-Commissioner of the National Football League, a copy of Mr. Gross' original letter.

n70 The record indicates that these individuals were from the following organizations: National Congress of American Indians (NCAI), Americans for Indian Opportunity, Youth Programs of the Bureau of Indian Affairs, the publication *Legislative Review*, American Indian Movement, and American Indian Press Association.

n71 The record indicates that this group requested not only an end to the use of the nickname "Redskins," but also that a new name be sought; that the use of "Indian-stereotyped images and language" in commercial promotion and advertising cease; that half-time performances, cheerleader garb and performances, and the team song be revised; and that the Washington team "actively encourage other professional sports organizations to cease the use of similar stereotyped degradation of America's Indian peoples."

[*65]

Mr. Gross expressed his personal opinion that the word "redskin(s)" is "a derogatory, denigrating epithet, ... a racial slur which is used to describe Native Americans"; and that the effect of the use of the word "redskin(s)" as part of the team name is to "promulgate a stereotyped view of Native Americans ... to a very large audience of people who have very

little knowledge otherwise of the existing culture of Native Americans."

4. Resolutions By Organizations.

Through the testimony of Judith Kahn, Director of the American Jewish Committee of Portland, Oregon, (AJCP), petitioners established that the AJCP is a membership organization with a stated mission to work with Jewish and non-Jewish groups on issues pertaining to civil rights and bigotry; and that on September 2, 1992, the Board of Directors of the AJCP unanimously passed a proclamation, which is of record herein, noting, *inter alia*, the team name "Redskins," and condemning the use of "racial or ethnic stereotypes in the names, nicknames, or titles of business, professional, sport or other public entities" as "dehumanizing and promoting practices that trivialize and demean people, religious beliefs and symbols"; [*66] opposing such use "when the affected group has not chosen the name itself'; and encouraging such entities "to end their use of offending stereotypes."

Through the testimony of Rabbi Elliot Stevens, Executive Secretary and director of publications for the Central Conference of American Rabbis (CCAR), petitioners established that in April, 1992, the CCAR unanimously passed a resolution entitled "Racism," of record herein, which resolved to "call upon the Washington Redskins and the Atlanta Braves to change formally their names and to renounce all characterizations based on race or ethnic background," and to "call upon the Washington Redskins and the Atlanta Braves to undertake

programming in the private sector to combat racial stereotyping in the larger society."

Through the testimony of Walterene Swanston, petitioners established that Ms. Swanston, a journalist, was the coordinator, between 1993 and 1995, of Unity 94, a coalition of four minority journalists associations representing Asian journalists, Black journalists, Hispanic journalists and Native American journalists; that Unity 94 held a convention in Atlanta in 1994, which was attended by approximately 6,000 people, to "demonstrate [*67] that there are talented qualified journalists of color" and to provide training and workshops for members; and that, immediately prior to the convention, the Unity 94 Board of Governors passed by a majority vote a resolution entitled the "Mascot Resolution." The resolution, of record herein, calls upon various news and media organizations to, *inter alia*, "officially discontinue the use of Native American and other culturally offensive nicknames, logos and mascots related to professional, college, high school and amateur sports teams." The resolution notes favorably the policy of two newspapers to refrain from using the names "Redskins and the derivation Skins, Redmen, Braves, Indians, Tribe and Chiefs" to refer to sports teams.

Through the testimony of Joanne Chase, Executive Director of the NCAI since April, 1994, petitioners introduced from the records of the NCAI a resolution passed by the General Assembly of the NCAI at its meeting of December 3, 1993. The resolution, No. NV-93-143, entitled "Resolution to Justice Department Investigation of Human Rights Violations," calls for "the abolition of Indian

nicknames, mascots and images and commercial use of these by sporting [*68] industries, colleges, universities and automobile manufacturers" and requests "the Justice Department to investigate any human and civil rights violations by colleges, universities, and public institutions that exploit Indian imagry (*sic*) and lifestyles."

5. History Expert.

The record establishes Dr. Frederick Hoxie as petitioners' expert in Native American history. Dr. Hoxie testified that he based his opinions in this case on the published historical literature of the period and he summarized his opinions in the following three points: (1) that, beginning in the British colonial period of the 17<th> and 18<th> centuries and continuing into the 19<th> century period of American expansion, government policies and public attitudes towards Native Americans were based on the belief in the fundamental inferiority of the Native American people and their culture; (2) that, beginning in the late 19<th> century with the development of the field of anthropology and as reflected in federal Indian policy in the 1930's and 1940's, there have been efforts to overcome this "racist philosophy or viewpoint" concerning Native Americans and to view Native Americans as equal to Anglo-Americans [*69] and deserving of equal membership in American society, and to view Native American culture as a legitimate cultural tradition; and (3) "that the word 'redskin' is an artifact of the earlier period and really has no place in modern life."

Dr. Hoxie described the development of the relationship between Native Americans and Anglo-

Americans, beginning with the British settlers on the east coast of North America in the 17<th> century and continuing through to the present, as based on the clear policy, first, of the colonies, and subsequently of the new American government as it expanded west across the Appalachian Mountains, that their settlements should be purely European/Anglo-American and that expansion would require the displacement of the Native American people. This view was supported by the commonly held belief that Native Americans were savages, *i.e.*, that the Native Americans were not Christians and were uncivilized.

The new American government negotiated with the Native Americans to create clear boundaries for separate areas of Native American settlement. During the early 19<th> century, referred to by historians as the Removal Era, the eastern tribes were forcibly evicted [*70] from land east of the Mississippi. Under the Removal Act of 1830, Native Americans were moved to settlements in Oklahoma and, later, to sections of Nebraska and Kansas.

In the mid-1800s, the outcome of the Mexican-American War and the California gold rush, respectively, "vastly increased the size of the United States [and] stimulated an extraordinary interest in settlement of the trans-Mississippi west ... placing tremendous pressure on American Indian communities." To address this problem, the U.S. government transferred the Office of Indian Affairs from the War Department to the Interior Department, which was newly-created in 1849. The Office of Indian Affairs administered programs that funded missionaries to establish schools in Indian

communities that Native American children were required to attend; and established regulations of Native American life. Dr. Hoxie finds these policies representative of the codification into government policy of the Anglo-American view that Native Americans "were inferior people who required forcible education and preparation for civilized life." Dr. Hoxie testified that the process of American western expansion, the creation of Indian reservations [*71] and of a bureaucracy to administer reservation life, and the pacification of tribes that militarily resisted American expansion, began in the 1850's and peaked in the 1880's.

Dr. Hoxie referred to the time period from the late 1880's to the 1930's as a period marked by government policies of assimilation, *i.e.*, "forced incorporation of Indian people into American society by forcing them through this process of emulating Anglo-American standards of civilization." During the same time period, government regulations outlawed Native American religions and individuals were punished for practicing these religions.

Dr. Hoxie testified that at the end of the 19<th> century, American scholars and political and religious leaders realized that separation of Anglo-American and Native American populations was no longer practical, and they began to question the assumption that Native American people and their culture were backward. Further, during the 1920's and 1930's, American anthropologists began to argue that Native American culture should be valued. In 1934, the passage of the Indian Reorganization Act ended the process of land allotment established in 1887 by the Dawes Act and allowed [*72] Native

American communities to organize their own governments. Subsequent Executive Orders ushered in a period during which Native American religious practices were tolerated and Native American cultural traditions were made part of the educational curriculum of Indian schools. These governmental policies recognizing the equality of Native American people and their culture have continued to evolve to the present time.

Dr. Hoxie testified that he has encountered the word "redskin(s)" in American popular writing of the 19<th> century, including newspapers and settlers' writings. He concluded by expressing the opinion that, as used in these contexts, the word "redskin(s)" is a disparaging reference to Native Americans because it refers to them as backward, uncivilized, savage people. Dr. Hoxie added that he has not seen the word "redskin(s)" used by historical scholars as part of their original prose or, during the modern period, by the Bureau of Indian Affairs (BIA) or its predecessors; rather, scholars and the BIA have used the words American Indian, Native American and Indian. Dr. Hoxie opined, further, that in the modern context the word "redskin(s)" remains disparaging as it is [*73] "an artifact of an earlier period during which the public at large was taught to believe that American Indians were a backward and uncivilized people." Dr. Hoxie concluded by expressing his personal opinion that, for this same reason, the use of the word "redskin(s)" by respondent's football team is inappropriate and disparaging.

6. Social Sciences Experts.

In addition to several written articles, petitioners presented the testimony of two social sciences experts, Teresa LaFromboise and Arlene Hirschfelder. Their testimony addresses, *inter alia*, petitioners' claims that "redskin(s)" is a racial slur; that the use of racial slurs perpetuates negative ethnic stereotyping; and that such stereotyping is extremely damaging to the self esteem and mental health of the targeted group. Proof of psychological distress suffered by petitioners or, generally, Native Americans, is not a necessary element of the Section 2(a) claims herein. Thus, we do not draw any conclusions in this regard. We find that both witnesses discuss negative stereotyping, in the context of their respective specialties, based essentially on their assumptions that the word "redskin(s)" is a racial slur. As the [*74] disparaging nature of "redskin(s)" is the legal question before us, we consider their testimony in this regard simply as adding to the record two additional individual opinions as to the nature of the word "redskin(s)."

We turn first to the testimony of Arlene Hirschfelder, an educator and consultant in the field of Native American studies, who expressed her opinion that Native Americans are portrayed in educational curricula, children's literature and toys, in a stereotypical manner, primarily as savages who are a "violent, war-like, provocative" people. She concluded that such stereotyping has a negative effect on the self-esteem of Native American children.

Ms. Hirschfelder expressed her personal opinion that the word "redskin(s)" is an offensive, disparaging and insulting word and that, even as

used in connection with the Washington football team, "Redskins" connotes Native Americans.

Petitioners presented the testimony of Dr. Teresa LaFromboise, an associate professor of counseling psychology and chair of Native American Studies at Stanford University, whose areas of specialty are multicultural counseling and research in Native American mental health. Dr. LaFromboise testified [*75] as to the negative effects of ethnic stereotyping and discrimination against Native Americans as a minority culture in the United States. She concluded that stereotyping has a detrimental effect on the mental health of people who are stereotyped because stereotyping "objectifies" and "dehumanizes" the individual, which "can lead to serious psychological disturbance such as depression, low self-esteem." Dr. LaFromboise noted that "there is a lot of evidence [in the education literature] of low self-esteem [among Native Americans] in terms of depression"; that this depression is reflected in the suicide rate among Native American adults and adolescents, which is three times greater than among the general population; and that, among Native American children, the suicide rate is five times greater than among children in the general population.

Dr. LaFromboise expressed her personal opinion that the name "Redskins," as used by respondent's football team, is a negative ethnic stereotype that communicates a message that "Indian people are ferocious, strong, war-like, brave."

Respondent

1. Summary of Respondent's Witnesses and Evidence.

John Kent Cooke and Richard Vaughn [*76] testified on behalf of respondent. Also testifying for respondent were two linguistics experts, David Barnhart and Ronald Butters; and a marketing and survey expert, Jacob Jacoby. Of record are exhibits submitted in connection with testimony and evidence submitted by respondent's notices of reliance.

2. Respondent's Witnesses.

John Kent Cooke, executive vice-president of respondent, Pro-Football, Inc., and a director in respondent's holding company, Jack Kent Cooke, Incorporated, testified that the "Washington Redskins" team was originally located in Boston; that the team was originally known as the "Boston Braves" and, in 1933, was renamed the "Boston Redskins"; and that the team moved to Washington, D.C. in 1937 and was renamed the "Washington Redskins." Without elaborating, Mr. Cooke stated that he is generally aware of college and high school teams that are named "Redskins"; however, he stated that those teams are not sponsored by or otherwise related to the "Washington Redskins" team.

Mr. Cooke testified that the team does not have a mascot. He acknowledged that, during the 1980's, an individual named Zema Williams, known as Chief Z, was a self-described mascot and received [*77] free tickets to games, a practice that was stopped by Mr. Cooke when he became aware of it in 1987. Mr.

Cooke also acknowledged that an individual dressed in a Native American motif, known as Princess Palemoon, sang the national anthem at some "Redskins" games in the mid-1980's; that she was not formally associated with the team; and that, due to some controversy as to whether she was a Native American person, her performances were stopped.

Mr. Cooke testified that respondent provides support for the "Washington Redskins" Band, a volunteer band that performs at "Redskins" games and whose costumes include Native American-style headdresses. Additionally, respondent has a contractual relationship with the "Redskinettes" cheerleaders, which is an independent, incorporated entity that is authorized to use specified trademarks of respondent in ways approved by respondent.

Mr. Cooke testified that the song "Hail to the Redskins" has been played at "Redskins" games since 1938; that certain of the lyrics to the song were changed prior to his tenure, which began in the 1980's; that the lyrics were changed to be sensitive to respondent's fans; and that the phrase "Braves on the warpath" in [*78] the song refers to the football team "marching down the football field to score points to win a game" rather than referring, in this context, to Native Americans.

Mr. Cooke acknowledged that respondent's logo design depicts a Native American wearing feathers; and that "the Washington Redskins are named after or are associated with Native Americans." He expressed his opinion that, in playing football in the National Football League and representing the nation's capital, the team name and logo "reflect the

positive attributes of Native Americans"; and that those attributes include "dedication, courage and pride." Mr. Cooke stated that respondent has guidelines for its own use of its trademarks, and use by its licensees, to ensure uniformity and to project a professional, clean-cut and wholesome team image. n72

n72 In relation to a joint advertising campaign with McDonald's, respondent set out the following parameters for the use of "the Redskins name, logo and image," which Mr. Cooke testified remain the standard:

- Reserved and Tasteful.

- Redskins Logo Not to be Changed in any way.

- No Caricatures.

- No Indian Costumes or Headresses.

- No War Chants, Yelling, Derogatory Indian Language (i.e., "Scalp the Cowboys," etc...).

- Use of "Hail to the Redskins" must be Presented Tastefully.

- Film and Photography used Must be Beneficial to the Redskins' Image.

- No Smart-Elect (sic) Language or Humor.

- No Insulting Language or Humor.

[*79]

Mr. Cooke testified that, since the 1950's, respondent has surveyed television broadcasts to determine listenership and audience share. However, respondent has never commissioned studies of fans' beliefs and attitudes towards the team. n73 Mr. Cooke stated that respondent has received communications both from people opposed to the use of the word "Redskins" as part of the team name and from people supporting the team name.

n73 Mr. Cooke and Mr. Vaughn testified that they knew of a radio survey and a newspaper poll, both pertaining to the "Redskins" team name, and taken independently of respondent. However, we have given no weight to the results of the survey and poll as reported by Mr. Vaughn, and as referred to in communications made of record by notice of reliance, because there is no foundation established in the record for evidence regarding the survey or poll and, thus, no basis for the Board to consider the reliability of the methodology used, or the results reached, in the survey or poll.

Mr. Cooke expressed his opinion that the word "redskin(s)" means the "Washington Redskins" football club and nothing else, regardless of whether it appears in singular or plural form; [*80] that, except in connection with peanuts, he has heard the word "redskin(s)" only in reference to the football club; and that he could not answer the question of whether it would be appropriate to use the word "redskin(s)" in addressing a Native American person. Mr. Cooke testified that he does not recall anyone ever telling him that he or she considers the word "redskin(s)" offensive as a reference to Native Americans.

Respondent also presented the testimony of Richard Vaughn, director of communications for the "Washington Redskins" football team. Mr. Vaughn testified that, in responding to letters received about the team name, he usually writes that the "Redskins" name has always been very respectful; that the team is proud of its tradition; and that Native Americans have always been depicted respectfully by the team.

Mr. Vaughn expressed his personal opinion that the word "redskin(s)" means the "Washington Redskins" football team; and that, while he has heard the word used to refer to Native Americans in Western movies, it was neither disparaging or scandalous, nor complimentary or descriptive. Referring to newspaper cartoons representing the "Washington Redskins" football team [*81] through various caricatures of a Native American, Mr. Vaughn opined that the cartoons are not disrespectful to anyone because they are about football. He acknowledged that such representations

"are not something that we would use," and he described the reproduction of several of these cartoons in the "Redskins" yearbooks as respectfully reflecting the team's history and traditions.

Linguistics Experts

Petitioners presented the testimony of Geoffrey Nunberg, who the record establishes as a linguistics expert. Respondent offered, in rebuttal, the testimony of David Barnhart and Ronald Butters, who are also established in the record as linguistics experts.

1. Denotation and Connotation.

These experts explained, essentially, that linguistics is the study of language and its uses, both generally and within particular populations or historical contexts; and that lexicography is the branch of linguistics concerned with the meanings of words with respect to the production of dictionaries.

In explaining the concepts of denotation and connotation of words, the three experts essentially agree that words may be denotative, a neutral description of a thing or phenomenon, out [*82] of context and without suggesting significant additional meanings; or connotative, describing a thing or phenomenon and evoking a mental image or association which may be positive, negative or neutral; and that the connotation of a word may change over time. The parties' linguistics experts principally disagree over whether a word can be intrinsically negative in connotation, as posited by Dr. Nunberg, or whether, as respondent's witnesses

posit, one must always look to the context in which a word is used to determine its connotation and whether that connotation is neutral, positive or negative. n74 However, it is unnecessary for us to determine whether "redskin(s)" is intrinsically positive, negative or neutral, as the record includes numerous examples of the use of the term "redskin(s)," all of them in a "context." Further, as we indicate *infra*, Section 2(a) requires us to consider the term or other matter at issue in the context of the marks in their entireties, the services identified in the challenged registrations, and the manner of use of the marks in the marketplace. Thus, we consider the meaning of the word "redskin(s)" in this context.

> n74 We note that Dr. Butters' position in this regard is mitigated by his acknowledgment that some terms, for example, "kike" and "nigger," are "almost always offensive and disparaging."

[*83]

2. Use of the word "redskin(s)."

Regarding the word "redskin(s)," Dr. Nunberg testified that, throughout its approximately 300 years of use, "redskin(s)" has been and is "a connotative term that evokes negative associations, or negative stereotypes, with American Indians." Dr. Nunberg based his opinion on his review of historical documents, namely, citations of the word in the press, books, and encyclopedias from the late 1800's

through the first half of this century; from contemporary citations (*i.e.*, the latter half of this century) in the press and in other publications; from use of the word in movies from 1920 to the present; from dictionary entries; and from use of the word in news articles and correspondence associated with this proceeding. n75

> n75 Dr. Nunberg testified that newspaper articles were relevant to reflect both the educated use and the widely circulated use of a word; and that newspaper and television usage influence the way words are used and understood.

Dr. Nunberg concluded that all occurrences of the word "redskin(s)" as a reference to Native American people in 19<th> and early 20<th> century news accounts in this record are in contexts of savagery, [*84] violence and racial inferiority; and that, thus, the word must have been considered a disparaging word for Native Americans during this period. Dr. Nunberg finds similar allegedly negative connotations in historical examples of the use of the word "redskin(s)" in the *Oxford English Dictionary* (2<nd> edition, 1986), and in a report in the *Encyclopedia Britannica* (11<th> ed. 1910). n76 He notes that certain words, such as "redskin(s)," carry negative connotations, regardless of the context in which they appear; and that, therefore, such words are not likely to be found in a positive context.

> n76 This edition says the following about the term redskin(s): "Other popular terms for the American Indians which have more or less currency are 'red race,' 'red man,' 'redskin,' the last not in such good repute as the corresponding German, 'rothaute,' or French, 'peaux rouges,' which have scientific standing."

Dr. Nunberg concluded that, in all the materials he reviewed, both historical and modern, he did not find a single denotative or neutral reference to "redskin(s)" as a reference to Native Americans. He noted that he found several occurrences wherein the word "redskin(s)" itself [*85] is the subject of discussion and it appears in quotes.

On the other hand, considering the same historical and contemporary material in the record, respondent's experts disagree with Dr. Nunberg's conclusion that the word "redskin(s)" has always been a connotative word of disparagement, or that the evidence of use of the word "redskin(s)" to refer to Native Americans reflects a negative connotation. Rather, Mr. Barnhart described several of the same passages discussed by Dr. Nunberg as connotatively neutral, or even positive, uses of the word "redskin(s)" and concluded that the word "Indian" could easily be substituted therefor without changing the connotation. Dr. Butters, while agreeing that much of the quoted language disparages Native Americans, concluded that it is not the word "redskin(s)" alone that is disparaging. Rather, he concludes that it is the context in which the word appears that portrays Native Americans in a disparaging manner, and that the word "Indian" could be easily substituted in each instance. Dr.

Butters states that "Native American," "Indian," and "redskin" are all acceptable words, but that "redskin" is the least formal of the three words and is "only a [*86] respectful minor variant alternative for 'American Indian.'"

Dr. Butters testified that the traditional meaning of "redskin(s)" as identifying Native Americans is and always has been "an overwhelmingly neutral, generally benign alternative designator for the indigenous peoples of North America"; that, during the second half of this century, the word has taken on "an important, powerfully positive new meaning" identifying the Washington, D.C. professional football team; that "redskin(s)" primarily refers to the football team in contemporary American English n77; and that the connection between the contemporary meaning of "redskin(s)" as a football team with the original meaning as a Native American is greatly attenuated. Dr. Barnhart's testimony is in agreement with this position.

n77 Dr. Nunberg conceded that the majority of references to "redskin(s)" in newspapers from the 1950's to the present pertain to the football team. However, he stated that this does not lead to a conclusion that the reference to the football team is the dominant meaning; rather, it simply means that "redskin(s)" is extremely rare in the press as a reference to Native Americans and that the press must have strong reasons for avoiding such use of the term.

[*87]

3. Dictionary definitions of "redskin(s)."

Regarding dictionary definitions of "redskin(s)" and usage labels therefor, Dr. Nunberg considered definitions of the word "redskin(s)" in a number of different dictionaries, focusing on the several dictionaries that include usage labels indicating that the word is offensive or disparaging. Regarding the inconsistent application of usage labels among the dictionaries of record, he testified that dictionaries often do not include usage labels for offensive words; that space is a factor determining the use of such labels; and that no conclusions can be drawn from the lack of a usage label in other dictionary excerpts defining "redskin(s)".

Claiming that the majority of dictionary entries of record do not include usage labels indicating that the word "redskin(s)" is offensive or disparaging, n78 respondent's linguists contend that dictionaries that have applied such labels to the word "redskin(s)" as it refers to Native Americans have done so incorrectly. n79 Rather, both of respondent's linguists contend that, as a reference to Native Americans, the word "redskin(s)" is merely informal, has no negative connotations absent a negative [*88] context, and remains synonymous with "Indian." n80

n78 We note that, in grouping the dictionary excerpts by publisher, approximately half of the entries include usage labels.

n79 Dr. Butters acknowledged that this is the only incorrect dictionary label he could identify.

n80 While maintaining his view that "redskin(s)" is an acceptable, informal word, Mr. Barnhart acknowledged that the usage labels appearing in some dictionaries over the last ten to fifteen years may indicate some shift in usage of the word "redskin(s)" outside of the sports context. Similarly, Dr. Butters acknowledged that, in the 1980's, he began to see scholars, such as historians, sociologists and archeologists, making reference to the word "redskin(s)" as a word that one should probably avoid using.

Regarding the inconsistent application of usage labels among the dictionaries of record, Mr. Barnhart testified that usage labels are decided upon by the editor of a dictionary based on a study of the contexts in which a word appears, including cumulative quotations, interviews, questionnaires, on-line news services, broadcast transcripts and film; and that limited dictionary space and the time constraints [*89] of editing all contribute to usage labeling decisions. n81 He stated, further, that unlabeled words are assumed to be standard English; and that it is not unreasonable for lexicographers to disagree about the application of usage labels.

n81 However, Mr. Barnhart noted that no project with which he has been associated has

misapplied a usage label or omitted a usage label due to time or space constraints.

4. Use of "redskin(s)" in modern context.

All three linguistics experts spent a substantial amount of time discussing their opinions on the meanings of the words "scandalous," "disparaging," and "offensive," the extent to which "disparaging" and "offensive" are synonymous, and whether the word "redskin(s)" is scandalous, disparaging and/or offensive. Predictably, Dr. Nunberg concluded that the word "redskin(s)" has been scandalous, disparaging and offensive from at least 1967 to the present n82; whereas Mr. Barnhart and Dr. Butters came to the opposite conclusion.

n82 Dr. Nunberg noted that this conclusion is not affected by the fact that Native Americans may use this term to refer to themselves, as there is a long history of ethnic groups or other groups taking disparaging terms and using them defiantly.

[*90]

In support of his position, Dr. Nunberg discussed a linguistic concept called "transfer function" which describes a process where one sense of a word is extended to yield another sense of the word. For example, with respect to sports team names, Dr. Nunberg testified that the transfer is a metaphorical one in which certain properties of the core or original meaning of the word are exploited in forming an

extended use of that word to acquire another denotation. Referring specifically to the "Washington Redskins," Dr. Nunberg concluded that "redskin(s)" conveys a savage, ferocious impression and this original association is relied upon for its efficacy as the name of the football team. n83

n83 Dr. Nunberg testified that he studied and listed the names of professional sports teams and concluded that these names fell in two general categories, namely, names which relate to the local community and names of people, animals or inanimate objects; that this latter group of names usually sound "fierce, ferocious, savage, inhuman, implacable so as in a symbolic way to strike fear into the hearts of opponents"; and that "Washington Redskins" and other Indian names fall into this latter category. In this regard, Dr. Nunberg refers to the headlines of newspaper articles about the football team and notes that the headlines all reflect the theme of Indians on the warpath. Dr. Nunberg concluded that these headlines indicate the "degree to which the association of the team name and the use of the word to refer to Indians remains vivid and salient in the minds of sports writers and to the general public"; and that, therefore, while "Redskins" may have acquired another meaning as a football team, the meaning is not divorced from, or independent of, its use to refer to Native Americans.

[*91]

Respondent's linguistics experts reiterated their opinion that the word "redskin(s)" is a standard, albeit informal, English word that refers to Native American persons; that "redskin" and Native American are completely synonymous; and that, while the predominant use of the word "redskin(s)" is to refer to the football team, the lack of use of the word to refer to Native Americans is not an indication that the word is offensive as it pertains to Native Americans.

Dr. Butters acknowledged that, under some circumstances, some, but not the majority, of Americans today would find the word "redskin(s)" offensive as a reference to Native Americans. However, he indicated that the word had no such negative connotations prior to 1967, when the movement towards "political correctness" in language began.

Dr. Nunberg disagreed with respondent's witnesses' claim that the word "redskin(s)" is merely informal as it pertains to Native Americans, noting that such a conclusion does not explain the fact that it never appears in a neutral denotative context. Dr. Nunberg indicated that linguists characterize words along a spectrum which ranges from informal, through specialized and standard, to formal. [*92] Dr. Nunberg stated, however, that placement of a word on this spectrum does not indicate connotation; for example, designation of a word only as "informal" does not indicate whether it has a positive or negative connotation.

6. Findings of fact regarding linguists' testimony.

Each party has offered the testimony of linguistics experts about the denotation and connotation of "redskin(s)" as a reference to Native Americans and as it appears in the name of respondent's football team. To some extent, this testimony is self-serving and the opinions of the different individuals seem to negate each other's assertions, which offsets whatever probative value could be attributed to this portion of their testimony. However, we find that there are certain points upon which the parties' experts agree and, further, that certain conclusions can be drawn regarding some areas of disagreement.

There is no dispute among the linguistics experts that the word "redskin(s)" has been used historically to refer to Native Americans, and is still understood, in many contexts, as a reference to Native Americans; that, from at least the mid-1960's to the present, the word "redskin(s)" has dropped out [*93] of written and most spoken language as a reference to Native Americans; that, from at least the mid-1960's to the present, the words "Native American," "Indian," and "American Indian" are used in spoken and written language to refer to Native Americans; and that, from at least the mid-1960's to the present, the word "redskin(s)" appears often in spoken and written language only as a reference to respondent's football team.

The experts agree the evidence of record establishes that, until at least the middle of this century, spoken and written language often referred to Native Americans in a derogatory, or at least condescending, manner and that references to Native Americans were often accompanied by

derogatory adjectives and/or in contexts indicating savagery and/or violence. There is no dispute that, while many of these usage examples refer to Native Americans as "Indians," the word "Indian" has remained in the English language as an acceptable reference to Native Americans during the second half of this century. The question remaining, about which the parties' experts, predictably, disagree, is the significance of the word "redskin(s)" in written and spoken language from the 1960's [*94] to the present, both as a reference to Native Americans and as part of the name of respondent's football team. In this regard, the experts draw conclusions regarding the application of the legal standards in this case that are not binding on the Board or the courts. Thus, we have not considered these conclusions. *See, The Quaker Oats Company v. St. Joe Processing Company, Inc., 232 F.2d 653, 109 USPQ 390 (CCPA 1956);* and *American Home Products Corporation v. USV Pharmaceutical Corporation, 190 USPQ 357 (TTAB 1976).*

However, the experts made several statements in reaching their conclusions that bear scrutiny. For example, while respondent's linguistics experts contend that the word "redskin(s)" is merely an informal term, petitioners' expert notes, credibly, that such a characterization does not address the issue of whether the connotation of "redskin(s)" in any given instance is negative, neutral or positive. Nor does the characterization of the word "redskin(s)" as informal adequately address the question of why the word appears, on this record, to have entirely dropped out of spoken and written language since, at least, the 1960's, except in [*95] reference to respondent's football team.

Looking to dictionary definitions of the word "redskin(s)," the experts agree that the many dictionaries in evidence, including dictionaries from the time periods when each of the challenged registrations issued, define "redskin" as a Native American person; that one dictionary also defines "Redskin" as respondent's professional football team; and that several dictionaries, dating from 1966 to the present, include usage labels indicating that the word "redskin" is an offensive reference to Native Americans, whereas several other dictionaries, dating from 1965 to 1980, do not include such usage labels in defining "redskin." Predictably, the experts' opinions differ as to the significance to be attached to the usage labels, or the lack thereof. We find these contradictory opinions of little value in resolving this dispute. Thus, we have considered the dictionary definitions themselves in the context of the entire record.

Film Expert

Susan Courtney n84 testified that she was hired by Geoffrey Nunberg, in connection with his testimony as a linguistics expert for petitioners in this case, to conduct a study of the use of the word "redskin(s)" [*96] in American film. Ms. Courtney compiled a filmography, *i.e.*, a bibliography of films, of fifty-one Western genre films that were produced up to and including the 1970's. Based primarily on availability, she viewed twenty of the films listed in her filmography to determine whether the word "redskin(s)" is used in any of the viewed films. She cataloged her results and prepared both a video containing excerpts of the viewed films wherein the word "redskin(s)" is used, and an interpretive index

describing the excerpted scenes and the use of the word "redskin(s)" therein. She offered her opinion that the excerpted films are representative both of the Western genre in American film and of the manner in which Native Americans are depicted in American film.

> n84 At the time she compiled this study, Ms. Courtney was a Ph.D candidate at the University of California at Berkeley in the Rhetoric Department. She was specializing in American cinema and the representation of gender and race in film, literature and other cultural contexts.

Ms. Courtney stated that, in the twenty films viewed, she looked for any usage of the word "redskin(s)", either positive or negative, but that she did [*97] not find any instance in which the word "redskin(s)" is used in a positive manner. Ms. Courtney drew the conclusion from her research viewing these films that the word "redskin(s)" is significantly different from other words that refer to Native American people. She stated that, in the films, the word "redskin(s)" is often coupled with negative adjectives such as "dirty," or "lying"; or that the word is used in the context of violence, savagery, or dishonesty; and that the word "Indian" could not reasonably be substituted for the word "redskin(s)" and retain the same connotation. She noted that she did not track the use of words other than "redskin(s)" in her research, so she cannot conclude that the word "Indian" is not also used in a derogatory manner.

Survey Evidence

1. Petitioners' Survey.

Ivan Ross, a market research and consumer psychologist, described the methodology and results of a telephone survey that he designed and supervised on behalf of petitioners. He stated that the purpose of the survey was to determine the perceptions of a substantial composite of the general population and of Native Americans to the word "redskin(s)" as a reference to Native Americans. [*98] Three hundred one American adults, representing a random sample of the general population, and 358 Native American adults were surveyed. Both groups included men and women ages 16 and above. These individuals were identified according to a random sampling procedure, which Dr. Ross described in the record. Dr. Ross described the Native American population as a stratified sample, wherein census reports were used to identify the twenty states with the largest numbers of Native Americans, from which the Native American sample was chosen according to a random sample plan. Dr. Ross testified that the Native American sample reflected a consistent mix of rural and urban Native Americans; and included both registered members of Indian tribes and non-registered individuals who identified themselves as Native American.

Individuals in both population groups were read a list, in varying order, of the following terms: "Native American," "Buck," "Brave," "Redskin," "Injun," "Indian," and "Squaw." With respect to each term, participants were asked whether or not they, or others, would be "offended" by the use of the term

n85 and, if so, why. Dr. Ross testified that he chose these terms as representative [*99] of a spectrum of acceptability, positing that, in general, "Native American" would be likely to be considered acceptable and "Injun" would be likely to be considered pejorative. Dr. Ross testified that, for the question, he chose the word "offensive" as most likely to reflect, to those unfamiliar with trademark law, the behavioral concepts embodied in the terms "scandalous" and "disparaging" in the trademark law. Dr. Ross stated that asking participants whether others might be offended is an accepted additional means of obtaining the speaker's opinion, based on the assumption that the speaker may be circumspect in answering a direct question.

n85 This question was changed so that it was posed to participants, variably, with either the positive or the negative option stated first.

Dr. Ross tabulated the results three different ways. First, he grouped together responses to both questions "is it offensive to you" and/or "is it offensive to others." He also tabulated the results considering responses only to the question "is it offensive to you" and he separately tabulated responses only to the question "is it offensive to others." In all cases, and in both population groups, the [*100] tabulated order of "offensiveness" of the terms was the same, although the percentage of the sample finding each term "offensive" differed between the two population groups. Following is the tabulation of only those responses indicating that the speaker was personally offended.

Number and percentage answering "yes, offensive to me":

	General Population Sample (total sample=301) Yes	Native America (total sample=3 Yes
INJUN	149 (49.5%)	181 (50.6%)
REDSKIN	139 (46.2%)	131 (36.6%)
SQUAW	109 (36.2%)	169 (47.2%)
BUCK	110 (36.5%)	99 (27.7%)
BRAVE	30 (10.0%)	25 (7.0%)
INDIAN	8 (2.7%)	28 (7.8%)
NATIVE AMERICAN	6 (2.0%)	10 (2.8%)

2. Respondent's Rebuttal.

In response to petitioners' survey and testimony of Dr. Ross, respondent presented the testimony of Jacob Jacoby, a psychologist and expert in the area of marketing and trademark surveys. Not surprisingly, Dr. Jacoby presented a detailed attack on the design of the survey, its implementation, and the tabulation of results. For example, regarding the questions asked, Dr. Jacoby contended, *inter alia*,

that the questions asked were leading and [*101] not neutral; that the list of words referring to Native Americans contained an insufficient number of words; that, in using the term "offensive" in its questions, the survey did not ascertain the appropriate information for a determination under Section 2(a); and that research shows that proxy respondents, *i.e.*, asking what others think, leads to ambiguous results. Regarding the sampling procedure, Dr. Jacoby contended, *inter alia*, that the Native American sample is too geographically limited to be representative; that the method for determining whether a participant is Native American is flawed; that the birthday sample method employed violates the randomness of the survey and, further, that the age parameters include participants who could not reflect the state of mind of people in 1967; and that there was a less than 50% response rate to the survey, which renders it a very weak probability survey. Regarding the tabulation of the results of the survey, Dr. Jacoby contends, *inter alia*, that certain responses were incorrectly tabulated as positive responses, in particular, those responses dependent upon the context in which the word may be used, and those responses indicating [*102] that others may be offended.

Dr. Jacoby concluded that the defects he has identified in the sampling plan, in the questions asked as part of the survey, and in the tabulation of the results render it completely unscientific. Dr. Jacoby expressed his opinion that the survey is further flawed because it sought the current views of its participants rather than their perceptions during the relevant time period; and it failed to obtain

perceptions of the word "redskin(s)" as used in the context of respondent's team name.

3. Findings of Fact regarding survey.

In view of the contradictory testimony of the parties' marketing experts regarding the extent to which petitioners' survey realized its stated objective, we find it useful at this time to state our factual conclusions regarding this survey. While a few of Dr. Jacoby's criticisms have some merit, we note that no survey is perfect and even a flawed survey may be received in evidence and given some weight if the flaws are not so severe as to deprive the survey of any relevance. *See, Lon Tai Shing Co. Ltd. v. Koch & Lowy, 19 USPQ2d 1081 (S.D.N.Y. 1990)* and cases cited therein; and *Selchow & Righter Co. v. Decipher, Inc., 598 F. Supp. 1489, 225 USPQ 77, 86 (E.D. Va. 1984).* [*103] After careful consideration of Dr. Ross' testimony, the survey report and the substantial survey data in the record, we find ample support for the viability of the survey methodology used, including the sampling plan, the principal questions asked, and the manner in which the survey was conducted. n86

n86 We specifically mention the use of the word "offensive" in the survey question as the linguistics and survey experts of both parties argued about whether "offensive" adequately reflects the meaning of "disparage," as used in Section 2(a). We find that the dictionary definitions of "disparage," as well as the testimony of these experts, indicates that the

> words are sufficiently similar in meaning to justify the use of "offensive" in the survey questions.

However, we agree that this survey is not without flaws. In particular, we are not convinced that a survey participant's conjecture about the views of "others" actually reflects the participant's personal views. We see little value to this question in the survey, and we find the survey results tabulated by merging positive answers to questions both about the participant's personal reaction to the word list and his opinion about [*104] others' reactions to be of questionable significance. Thus, we have given this portion of the survey results no weight. However, this flaw does not negatively affect the results of the survey as tabulated only for actual positive responses regarding participants' personal reactions to the word list. Further, our review of the transcripts of the actual interviews convinces us that the interviewers accurately transcribed results as either positive, negative, or no opinion. n87

> n87 In several instances, a participant responded that "yes" he or she would be offended by a certain term "depending upon the context" in which it was used. While, in hindsight, a follow-up question to clarify this response might have been useful, we find no error in tabulating this as a positive response.

We find no error in including adults aged 16 and above in the survey, even though the younger participants were not alive, or not adults, at the time

of registration of several of respondent's marks herein. Dr. Ross does not represent this survey as anything other than a survey of current attitudes as of the time the survey was conducted. We agree with Dr. Jacoby that a survey of attitudes as of the dates [*105] of registration of the challenged registrations would have been extremely relevant in this case, if such a survey could be credibly constructed. But neither party chose to undertake such a survey.

Similarly, a survey that considered participants' views of the word "redskin(s)" as used by respondent, the media and fans in connection with respondent's football team would have been extremely relevant. But, again, neither party chose to undertake such a survey.

Neither of these points diminishes the value of petitioners' survey for what it is - a survey of current attitudes towards the word "redskin(s)" as a reference to Native Americans. In this regard, we find that the survey adequately represents the views of the two populations sampled. While certainly far from dispositive of the question before us in this case, it is relevant and we have accorded some probative value to this survey, as discussed in our legal analysis, *infra*.

Applicable Legal Principles

The case herein is a petition to cancel several registrations, the oldest of which issued almost twenty-five years prior to the filing of this petition. For the reasons stated in the March 11, 1994, interlocutory [*106] decision addressing this issue (*Harjo, et al. v. Pro Football, Inc., 30 USPQ2d 1828,*

1832 (1994)) and reaffirmed herein, our decision on the Section 2(a) issues in this case pertains to the time periods when the subject registrations issued. n88 The Board must decide whether, at the times respondent was issued each of its challenged registrations, the respondent's registered marks consisted of or comprised scandalous matter, or matter which may disparage Native American persons, or matter which may bring Native American persons into contempt or disrepute. n89

n88 We note that, because petitioners allege that the term "redskin(s)" is, and always has been, a derogatory term in connection with Native Americans, we have considered the evidence pertaining to the entire period of history presented in the record, from the mid-nineteenth century to the present. Evidence concerning the significance of the term "redskin(s)" before and after the relevant time periods may shed light on its significance during those periods. Our opinion in this case is not inconsistent with the cases cited herein stating that the issue of scandalousness must be decided on the basis of "contemporary attitudes," as those cases are all *ex parte* cases wherein the issue of scandalousness is being addressed, similarly, "at the time of registration" or when registration was being sought.

n89 While respondent does not appear to contest this point, petitioners state that an issue in this case is whether petitioners have

established their standing, contending, of course, that they have. We previously found that petitioners had pleaded a legitimate interest in the outcome of this proceeding. *Harjo, et al. v. Pro Football, Inc., supra at 1830.* We now agree that petitioners have established by proper evidence their standing herein. *See, Bromberg, et. al. v. Carmel Self Service, Inc., 198 USPQ 176 (TTAB 1978);* and *Ritchie v. Simpson, No. 97-1371 (Fed. Cir. March 15, 1999) (1999 U.S. App. LEXIS 4153).*

[*107]

Section 2(a)

The relevant portions of Section 2 of the Trademark Act (*15 U.S.C. 1052*) n90 provide as follows:

> No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it -
>
> > (a) Consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with

> persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute;

n90 Respondent contends that because its constitutional rights would be abridged by cancellation of its registrations, petitioners should be required to establish their case by "clear and convincing" evidence. However, we have elsewhere in this opinion stated that the constitutional issues raised by respondent have not been considered because such issues are not properly before the Board.

It is well established that a registration is prima facie valid and that, in an opposition or cancellation proceeding, the challenger's burden of proof generally is a preponderance of the evidence. *See, Cerveceria Centroameicana, S.A. v. Cerveceria India, Inc., 892 F.2d 1021,* 13 USPQ2d1307, 1309 (Fed. Cir. 1989); and *Eastman Kodak Co. v. Bell & Howell Document Management Products Co., 994 F.2d 1569, 26 USPQ2d 1912 (Fed. Cir. 1993).* As noted by petitioners, the case cited by respondent in support of its contention, *Woodstock's Enters., Inc. v. Woodstock's Enters., Inc., 43 USPQ2d 1440 (TTAB 1997),* addresses the traditionally higher burden of proof required in fraud cases, which is not the issue herein. We are not aware of any authority that would warrant applying a

standard of proof other than a preponderance of the evidence to Section 2(a) issues.

[*108]

Scandalous Matter

The vast majority of the relevant reported cases involving that part of Section 2(a) with which we are concerned in this case were decided principally on the basis of whether the marks consisted of scandalous matter. We begin with a review of this precedent.

Faced with a "paucity of legislative history," to aid in interpreting the term "scandalous" in Section 2(a), one of the predecessor courts of our primary reviewing court found that it must look to the "ordinary and common meaning" of that term, which meaning could be established by reference to court and Board decisions, and to dictionary definitions. In particular, the Court looked to dictionary definitions extant at the time of the enactment of the Trademark Act in 1946, and noted that "scandalous" was defined as "'Giving offense to the conscience or moral feelings; exciting reprobation, calling out condemnation * * *. Disgraceful to reputation * * *.' [and] 'shocking to the sense of truth, decency, or propriety; disgraceful, offensive; disreputable, as *scandalous* conduct.'" *In re McGinley, 660 F.2d 481, 211 USPQ 668, 673 (CCPA 1981).* In a case predating the Trademark Act of [*109] 1946, the Court had looked to similar dictionary definitions of "scandalous," and concluded that the use of the mark MADONNA upon wine which is not limited to a religious use was "scandalous" under the relevant

provision of the 1905 Trademark Act. *In re Riverbank Canning Co., 95 F.2d 327, 37 USPQ 268, 269 (CCPA 1938).*

The Board has acknowledged that the guidelines for determining whether a mark is scandalous are "somewhat vague" and the "determination [of whether] a mark is scandalous is necessarily a highly subjective one." *In re Hershey, 6 USPQ2d 1470, 1471 (TTAB 1988);* and *In re Over Our Heads Inc., 16 USPQ2d 1653, 1654 (TTAB 1990).* Nonetheless, taking as their starting point the "ordinary and common meaning" of scandalous, as did the CCPA in *Riverbank Canning, supra,* and *McGinley, supra,* the U.S. Court of Appeals for the Federal Circuit and this Board have, in subsequent decisions, established some guidelines for determining whether matter is scandalous. In the context of an *ex parte* refusal to register the mark BLACK TAIL in connection with adult magazines, the Court of Appeals for the [*110] Federal Circuit summarized this guidance in *In re Mavety Media Group Ltd., 31 USPQ2d 1923, 1925 (1994),* as follows:

> The PTO must consider the mark in the context of the marketplace as applied to only the goods described in Mavety's application for registration. Furthermore, whether the mark BLACK TAIL, including innuendo, comprises scandalous matter is to be ascertained (1) from "the

> standpoint of not necessarily a majority, but a substantial composite of the general public," and (2) "in the context of contemporary attitudes." (*citations omitted.*)

While not often articulated as such, determining whether matter is scandalous involves, essentially, a two-step process. First, the Court or Board determines the likely meaning of the matter in question and, second, whether, in view of the likely meaning, the matter is scandalous to a substantial composite of the general public. Relevant precedent holds that the meaning of the matter in question cannot be determined by reference only to dictionary definitions, as many words have multiple definitions (denotative meanings), and the connotation of a word, phrase or graphics is usually dependent upon the context [*111] in which it appears. n91 See, *In re Mavety Media Group Ltd., supra at 1927.* Thus, the meaning of the matter in question cannot be ascertained without considering (1) the relationship between that matter and any other element that makes up the mark in its entirety and (2) the goods and/or services and the manner in which the mark is used in the marketplace in connection with those goods and/or services.

> n91 In the testimony of the linguistics experts herein, a distinction is made between the denotative and connotative meanings of words. We use the term "denotation" to signify the "literal," or dictionary, meaning of a word and the term "connotation" to signify the

> meaning of that word in a particular context, which may or may not be the same as the word's denotative meaning.

For example, finding that dictionary definitions alone were insufficient to establish that the mark BLACK TAIL, in connection with adult magazines, is scandalous, the Court in *In re Mavety Media Group Ltd., supra at 1927* , concluded that there were several definitions of "tail," only one of which was vulgar; that two of these definitions were equally plausible in connection [*112] with the identified magazines; and that the record was devoid of evidence demonstrating which of these definitions a substantial composite of the general public would choose. *See also, In re Hershey, supra n92; In re Thomas Laboratories, Inc., 189 USPQ 50 (TTAB 1975)* n93; and *In re Hepperle, 175 USPQ 512 (TTAB 1972)*. n94

> n92 In *Hershey*, the Board found, particularly in view of labels showing a design of a large-beaked bird directly below the mark, that dictionary definitions and six articles from the NEXIS database were insufficient to establish a vulgar meaning of "pecker" in the BIG PECKER BRAND mark, or that it would be so understood by a substantial composite of the general public.
>
> n93 In *Thomas Laboratories*, giving "fullest consideration to the moral values and conduct which contemporary society has deemed to be appropriate and acceptable," the Board found

not scandalous a mark consisting of a "cartoon-like representation of a melancholy, unclothed male figure ruefully contemplating an unseen portion of his genitalia" where the goods were identified as corrective implements for increasing the size of the human penis.

n94 In *Hepperle*, the Board found that, while ACAPULCO GOLD may be a synonym for marijuana, when the mark was applied to suntan lotion it was likely to suggest, to the average purchaser, in a normal marketing milieu, the resort city of Acapulco, which is noted for its sunshine.

[*113]

Additionally, while the decisional law may suggest that intent, or lack thereof, to shock or to ensure that the scandalous connotation of a mark is perceived by a substantial composite of the general public is one factor to consider in determining whether a mark is scandalous, there is no support in the case law for concluding that such intent, or a lack thereof, is dispositive of the issue of scandalousness. *See, In re Old Glory Condom Corp., 26 USPQ2d 1216 (TTAB 1993)* n95; and *In re Wilcher Corp., 40 USPQ2d 1929 (TTAB 1996)*. n96

n95 In *Old Glory*, the Board found the mark, OLD GLORY CONDOM CORP and design of American flag in the shape of condom, for condoms, not scandalous, noting that "the seriousness of purpose surrounding the use of

applicant's mark -- which (is made) manifest to purchasers on the packaging for applicant's goods -- is a factor to be taken into account in assessing whether the mark is offensive or shocking."

n96 In *Wilcher*, the Board found that the mark, DICKHEADS and a design which is a grotesque caricature of a man's face formed with a depiction of male genitalia, for restaurant services, was scandalous despite dictionary evidence indicating several possible connotations of the word portion of the mark, as the drawing "clearly and blatantly projects a vulgar connotation."

[*114]

Matter Which May Disparage

The plain language of the statute makes clear that disparagement is a separate and distinct ground for refusing or canceling the registration of a mark under Section 2(a). n97 However, there is relatively little published precedent or legislative history to offer us guidance in interpreting the disparagement provision in Section 2(a). n98 As with scandalousness, the determination of whether matter may be disparaging is highly subjective and, thus, general rules are difficult to postulate. However, we undertake an analysis similar to that undertaken by the Court and Board in relation to scandalousness to make our determination herein. As with scandalousness, we begin by considering the "ordinary and common" meaning of the term "disparage." Then, to determine whether matter may

be disparaging, we undertake a two step process of considering, first, the likely meaning of the matter in question and, second, whether that meaning may be disparaging.

n97 This is notwithstanding the fact that a number of older decisions appear to consider scandalousness and disparagement under Section 2(a) as a single issue wherein the questionable matter is determined to be scandalous, or not, because it is, or is not, disparaging. *See, In re Reemtsma CigarettenFabriken G.m.b.H., 122 USPQ 339 (TTAB 1959);* and *In re Waughtel, 138 USPQ 595 (TTAB 1963).*

n98 The following comments concerning disparagement in the legislative history of the Trademark Act of 1946, P.L. 79-489, Chapt. 540, July 5, 1946, 60 Stat. 427, are excerpted from a discussion of whether the disparagement provisions of Section 2(a) will protect associations from the use by unauthorized third parties of their names or insignia on goods. It follows a discussion of Section 2(c) regarding the use of the name, etc., of a deceased president of the United States. Hearings on H.R. 4744 Before the Subcommittee on Trademarks of the House Committee on Patents, 76<th> Cong., 1<st> Sess. 18-50 (1939):

MR. LANHAM. It seems to me that there might be a little doubt, Mr. Rogers, as to whether [Section 2(a)] is sufficiently comprehensive [to include within the connotation of the word 'institution' fraternal organizations and other various groups]. [Section 2(a)] prohibits disparaging persons, living or dead, institutions, beliefs, or national symbols.

MR. FENNING. I think there has been no real trouble with the 1905 statute as it stands now, as I understand it. The wording in the statute with respect to insignia has apparently been satisfactory, and it seems to me it might be just as well to carry it over. There may be controversy over what some people call disparagement.

MR. LANHAM. Of course, that is the very thing that subsection (a) was designed to meet.

MR. ROGERS. Yes, sir.

MR. FENNING. There is a good deal of question as to what disparagement is. If excellent athletic goods, for instance, are marketed with the name of the New York Athletic Club on them, that is not detrimental to the club.

MR. LANHAM. Of course, I am not sitting here in a judicial capacity, and I cannot construe that.

MR. ROBERTSON. Mr. Chairman, I have not any hesitation at all in saying that I do not think that section as presently drawn does cover the matter at all. The word "disparaging" is too comprehensive in meaning. For instance, it does not cover the use of an ex-President's name the use of it in a respectful manner on goods on which the family might not desire it used. That is not disparagement at all, but at the same time it does not cover that situation.

MR. FRAZER [*Assistant Commissioner of Patents*]. I would

like to make this suggestion with respect to the word "disparage." I am afraid that the use of that word in this connection is going to cause a great deal of difficulty in the Patent Office, because, as someone else has suggested, that is a very comprehensive word, and it is always going to be just a matter of the personal opinion of the individual parties as to whether they think it is disparaging. I would like very much to see some other word substituted for that word "disparage."

MR. LANHAM. That seems to me, in the light of administration, to be a very pertinent suggestion, and if you gentlemen can clarify that with verbiage you suggest it would be helpful.

The legislative history does not indicate whether the suggestions solicited by Mr. Lanham were made. Further, if made, they certainly were not adopted, as the word "disparage" appears in the Trademark Act of 1946 without further explanation. Thus, Congress essentially left to the courts and

Board the task of establishing the meaning of this provision of the statute and guidelines for its applicability.

[*115]

To establish the meaning of the term "disparage," we refer to dictionaries that were contemporaneous with the passage of the Trademark Act of 1946. "Disparage" is defined as follows: n99

> *Webster's New International Dictionary*, G. & C. Merriam Company (2<nd> ed. 1947) - 2. To dishonor by comparison with what is inferior; to speak slightingly of; to deprecate; to undervalue; 3. To degrade; lower; also (*chiefly passive*), to discourage by a sense of inferiority;

> *New "Standard" Dictionary of the English Language, Funk and Wagnalls Company* (1947) - 1. To regard or speak of slightingly. 2. To affect or injure by unjust comparison, as with that which is unworthy, inferior, or of less value or importance; as, I do not say this to *disparage* your country. 3. [*Rare*] To degrade in estimation by detractive language or by dishonoring treatment; lower; dishonor; as, such conduct *disparages* religion.

From these definitions we conclude that, in considering whether matter in a mark "may disparage ... persons, living or dead, institutions, beliefs, or national symbols," we must determine whether, in relation to identified "persons, living or dead, institutions, [*116] beliefs, or national symbols," such matter may dishonor by comparison with what is inferior, slight, deprecate, degrade, or affect or injure by unjust comparison.

> n99 We note that the meaning of "disparage" has not changed appreciably since the passage of the Lanham Act. The 1993 edition of the *Random House Unabridged Dictionary* defines "disparage" as "to speak of or treat slightingly; depreciate; belittle; to bring reproach or discredit upon; lower the estimation of."

Considering the "ordinary and common" meanings of the words "scandalous" and "disparage," we find that distinct differences in these meanings dictate that we apply different standards for determining disparagement from those enunciated by the Court and Board for determining scandalousness. In particular, the "ordinary and common meaning" of "scandalous" looks at the reaction of American society as a whole to specified matter to establish whether such matter violates the mores of "American society" in such a manner and to

such an extent that it is "shocking to the sense of truth, decency or propriety," or offensive to the conscience or moral feelings, of "a substantial composite of the general public." On [*117] the other hand, the "ordinary and common meaning" of the word "disparage" has an entirely different focus, as disparagement has an identifiable object which, under Section 2(a) of the Trademark Act, may be "persons, living or dead, institutions, beliefs or national symbols."

A further difference between scandalousness and disparagement is found in the language of Section 2(a). While Section 2(a) precludes registration of matter that is scandalous, it does not preclude registration of matter that is disparaging. It precludes registration of matter that **may be** disparaging. There is no legislative history or precedent that specifically addresses this distinction between the two statutory provisions. Respondent's linguistics experts herein have testified that, as they understand the meaning of the word "disparage," disparagement of someone or something usually requires some degree of intent by the speaker to cause offense, although, as petitioners' expert notes, this may be inferred from the circumstances and from evidence regarding the acceptability of the language or imagery used. Thus, we believe the use of the term "may" is necessary in connection with "disparage" [*118] in Section 2(a) to avoid an interpretation of this statutory provision that would require a showing of intent to disparage. Such a showing would be extremely difficult in all except the most egregious cases. Rather, this provision, as written, shifts the focus to whether the matter may be perceived as disparaging. n100

> n100 Thus, as with scandalousness, the intent, or lack thereof, to ensure that the disparaging connotation of matter in a mark is so perceived is merely one factor to consider in determining whether a mark may be disparaging. It is not dispositive of the issue of disparagement.

In seeking guidance for determining, under Section 2(a), whether matter may be perceived as disparaging, we look to the limited precedent of the courts and the Board on the issue of disparagement, as well as to the previously enunciated precedent on the related issue of scandalousness. As with most trademark issues, including scandalousness, the question of disparagement must be considered in relation to the goods or services identified by the mark in the context of the marketplace. *See, In re Riverbank Canning Co., supra at 269. See also, Doughboy Industries, Inc. v. The Reese Chemical Company, 88 USPQ 227 (Pat. Off. 1951),* [*119] wherein the Patent Office denied, *ex parte*, the registration of DOUGH-BOY for an anti-venereal medication. In that case, the Patent Office concluded that, as with scandalousness, the question of disparagement must be determined by reference to the particular goods in connection with which the mark is used. The Patent Office found the mark DOUGH-BOY, a name for American soldiers in the first World War, to be disparaging as used in connection with the identified goods, particularly in view of the packaging which pictured an American soldier.

To ascertain the meaning of the matter in question, we must not only refer to dictionary definitions, but we must also consider the relationship between the subject matter in question and the other elements that make up the mark in its entirety; the nature of the goods and/or services; and the manner in which the mark is used in the marketplace in connection with the goods and/or services.

If, in determining the meaning of the matter in question, such matter is found to refer to an identifiable "[person or] persons, living or dead, institutions, beliefs, or national symbols," it is only logical that, in deciding whether the matter may be [*120] disparaging, we look, not to American society as a whole, as determined by a substantial composite of the general population, but to the views of the referenced group. n101 The views of the referenced group are reasonably determined by the views of a substantial composite thereof. In this regard, we follow the precedent established by the Board in *In re Hines, 31 USPQ2d 1685, 1688 (TTAB 1994)*, n102 *vacated on other grounds, 32 USPQ2d 1376 (TTAB 1994)*, wherein the Board stated the following:

> In determining whether or not a mark is disparaging, the perceptions of the general public are irrelevant. Rather, because the portion of Section 2(a) proscribing disparaging marks targets certain persons, institutions or beliefs,

only the perceptions of those referred to, identified or implicated in some recognizable manner by the involved mark are relevant to this determination.

n101 It is very possible that disparaging matter may provoke a negative reaction from only the relevant group. Thus, matter that may disparage does not necessarily provoke the same widespread societal reaction as scandalous matter. However, if allegedly disparaging matter provokes a widespread negative societal reaction, it is reasonable to infer that the relevant group will, similarly, perceive the matter as disparaging. Further, depending on the facts, matter that may disparage can be found, also, to be scandalous under Section 2(a).

n102 In *Hines*, the Board found the mark BUDDA BEACHWEAR and design for various casual clothing items to be disparaging in view of the particular depiction of Buddha therein.

[*121]

Who comprises the targeted, or relevant, group must be determined on the basis of the facts in each case. For example, if the alleged disparagement is of a religious group or its iconography, the relevant group may be the members and clergy of that religion; if the alleged disparagement is of an

academic institution, the relevant group may be the students, faculty, administration, and alumni; if the alleged disparagement is of a national symbol, the relevant group may be citizens of that country. *See also, In re Reemtsma Cigarettenfabriken G.m.b.H., 122 USPQ 339 (TTAB 1959)* n103; *In re Waughtel, 138 USPQ 594, 595 (TTAB 1963)* n104; and *In re Anti-Communist World Freedom Congress, Inc., 161 USPQ 304, 305 (TTAB 1969).* n105

n103 The mark in *Reemtsma*, SENUSSI, which is the name of a Moslem group that forbids the use of cigarettes, for cigarettes, was found to be an affront to the members of this group and tended to disparage their beliefs.

n104 The mark in *Waughtel*, AMISH and design of an Amish man smoking a cigar, for cigars and cigar boxes, was found not to affront members of that sect or disparage their religious or moral beliefs because evidence established that nothing in Amish religious principles or teachings prohibits the raising or use of tobacco and, in fact, at least seventy-five percent of the male members of the Amish sect smoke cigars and/or chew tobacco.

n105 The mark in *Anti-Communist World Freedom Congress*, consisting of a design of a large "X" superimposed over a hammer and sickle design, for "patriotic educational services, namely, dissemination of information relative to United States laws concerning activities of the communist party," was found to

> disparage the national symbol of the Soviet Union. Applicant's intent to disparage the Communist Party rather than the Soviet Union was considered irrelevant.

[*122]

We distinguish *Hines* and the case herein from the case of *Greyhound Corp. v. Both Worlds, Inc., 6 USPQ2d 1635 (TTAB 1988).* In *Greyhound,* on summary judgment, the Board sustained the opposition on the grounds of scandalousness, disparagement, and likelihood of confusion. The mark in question was a design of a defecating greyhound dog, for polo shirts and T-shirts. Citing the *Restatement (Second) of Torts § 629* (1977), wherein disparagement is defined as the publication of a statement, which the publisher intends to be understood, or which the recipient reasonably should understand, as tending "to cast doubt upon the quality of another's land, chattels, or intangible things," the Board established the following standard:

> The two elements of such a claim [of disparagement] are (1) that the communication reasonably would be understood as referring to the plaintiff, and (2) that the communication is disparaging, that is, would be considered offensive or objectionable by a reasonable

person of ordinary sensibilities. (*citations omitted*)

The disparagement in the *Greyhound* case involved an "offensive" [*123] design that disparages a commercial corporate entity and, thus, is akin to the commercial disparagement of property described in *§ 629 of the Restatement (Second) of Torts, supra.* The disparaging trademark casts doubt upon the quality of opposer's corporate goodwill, as embodied in its running greyhound dog trademarks. The standard in that case, namely, the perception of a "reasonable person of ordinary sensibilities," may be appropriate in cases involving alleged disparagement of individuals or commercial entities. However, the standard enunciated in *In re Hines, supra,* namely, the perceptions of "those referred to, identified or implicated in some recognizable manner by the involved mark," is appropriate for determining whether matter may disparage a non-commercial group, such as a religious or racial group, or beliefs or national symbols.

Matter Which May Bring Persons Into Contempt Or Disrepute

We turn, finally, to the Section 2(a) provisions regarding contempt or disrepute. We find no guidance in the legislative history for interpreting this provision and note that this provision is addressed in the case law, generally, [*124] in a conclusory manner with few, if any, guidelines. In

view of the "ordinary and common" meanings of the words "contempt" and "disrepute," as they were defined in 1947 n106 and more recently, n107 we believe that the guidelines enunciated herein in connection with determining whether matter in a mark may be disparaging are equally applicable to determining whether such matter brings "persons, living or dead, institutions, beliefs, or national symbols into contempt or disrepute."

n106 In *Webster's New International Dictionary*, Unabridged, 2<nd> ed., G. & C. Merriam Company (1945), "*contempt*" is defined as "1. Act of contemning, or despising; the feeling with which one regards that which is esteemed mean, vile, or worthless; disdain; scorn; as, familiarity breeds contempt; 2. State of being despised; disgrace; shame ..."; and "*disrepute*" is defined as "*vt.* To bring into discredit; disesteem *obs.; n.* loss or want of reputation; ill character; low estimation; dishonor." In the *New Standard Dictionary of the English Language* (1947), Funk & Wagnalls Company, "*contempt*" is defined as "1. N. the act of despising, or of viewing or considering and treating as mean, vile, and worthless; hatred and scorn of what is deemed mean or vile; disdain; scorn; 2. The state of being despised; disgrace; shame"; and "*disrepute*" is defined as "lack or loss of reputation; ill repute; a bad name or character; disesteem."

n107 In the *Random House Dictionary of the English Language*, 2<nd> ed., unabridged

(1987), "*contempt*" is defined as "1. the feeling with which a person regards anything considered mean, vile, or worthless; disdain; scorn; 2. The state of being despised; dishonor; disgrace"; and "*disrepute*" is defined as "*n.* bad repute; low regard; disfavor (*usually* preceded by *in or into*): *some literary theories have fallen into disrepute; syn.* Disfavor, disgrace."

[*125]

Legal Analysis

We preface our analysis herein by emphasizing the very narrow nature of the question before us. We are determining whether, under the Section 2(a) grounds asserted, the service marks that are the subjects of the six registrations in this proceeding shall remain registered. We do not decide whether the subject marks may be used or whether the word REDSKINS may be used as part of the name of respondent's professional football team.

In all of the reported cases discussed above, the issue was whether the involved marks were scandalous or may be disparaging because of the marks' sexual explicitness or innuendo, vulgarity, religious significance, or reference to illicit activity. The case before us differs factually from the aforementioned types of cases in that petitioners contend, principally, that the word REDSKINS in the marks in question is "a deeply offensive, humiliating, and degrading racial slur" in connection with Native Americans. The primary focus of the parties' evidence and arguments is petitioners' allegation that the marks in the subject registrations

may disparage Native American persons. We therefore begin our analysis with petitioners' claim [*126] of disparagement.

Disparagement

As stated previously herein, our analysis is essentially a two-step process in which we ask, first: What is the meaning of the matter in question, as it appears in the marks and as those marks are used in connection with the services identified in the registrations? Second, we ask: Is this meaning one that may disparage Native Americans? As previously stated, both questions are to be answered *as of the dates of registration of the marks herein.* The oldest registration involved in this case is of the mark THE REDSKINS, in stylized script, issued in 1967. Registrations of three marks, THE WASHINGTON REDSKINS, WASHINGTON REDSKINS and a design including a portrait of a Native American in profile, and THE REDSKINS and a design including a portrait of a Native American in profile and a spear, issued in 1974. The registration of the mark REDSKINS issued in 1978, and the registration of the mark REDSKINETTES issued in 1990. Thus, while we have properly considered evidence spanning a broad period of time, we focus our determination of the issue of disparagement on the time periods, between 1967 and 1990, when the subject registrations issued.

As [*127] we must consider the question of disparagement in connection with the services identified in the subject registrations, we note that, although there are some minor differences in the identifications of services among the six

registrations herein, each registration can be described, generally, as pertaining to entertainment services in connection with, or in the nature of, professional football games.

1. Meaning of the Matter in Question.

While the marks in the majority of the subject registrations include matter in addition to the word "Redskins," the principal focus of the evidence and arguments in this case is the word "redskin(s)" as it appears in each mark. Therefore, we begin by looking at the meaning of the word "redskin(s)." It is clear from the dictionary definitions and other evidence of record herein, and respondent does not dispute, that one denotative definition of "redskin(s)" is a Native American person. n108 The evidence establishes the use of the term "redskin(s)" to refer to Native Americans since at least the midnineteenth century. Both parties agree that since approximately the 1930's, and certainly by the 1960's, the occurrences in print or in other media [*128] of "redskin(s)" as a term denoting Native Americans declined dramatically. However, there is no question, based on this record, that "redskin(s)" has remained a denotative term for Native Americans throughout this century, in particular, from the 1960's to the present. n109

n108 There is some indication in the record that "redskin(s)" also identifies a type of potato, a brand of motorcycle, and perhaps, a type of peanut, but there is no evidence in the record that any of these possible meanings of the word

"redskin(s)" would pertain to the word as it is used in respondent's marks in connection with the identified services.

n109 Evidence sufficient to warrant this conclusion includes, at a minimum, dictionary definitions and articles that refer to the word "redskin(s)" in connection with Native Americans.

Considering the meaning of the term "redskin(s)" in connection with the services identified in the challenged registrations, respondent contends that the term "Redskins," considered in connection with professional football games, denotes respondent's football team and its entertainment services. Respondent contends that, over its six decades of use, respondent's marks have [*129] "acquired a strong and distinctive meaning identifying respondent's entertainment services ... in the context of professional football"; n110 that "Redskins" has become "denotative of the professional football team"; and that, although "deriving from the original, ethnic meaning of 'redskin'," the word "'Redskins' was perceived in 1967, and today, to be a distinct word, entirely separate from 'redskin' and the core, ethnic meaning embodied by that term."

n110 As we stated in an interlocutory decision in this case, *Harjo et. al. v. Pro Football, Inc., supra at 1832,* proof that respondent's marks have acquired secondary meaning does not establish a defense to petitioners' claims under Section 2(a).

> However, as respondent expressly states, it "is not raising a traditional secondary meaning defense addressing the issue of the protectability of Respondent's marks." Rather, we view this contention in the context of respondent's arguments regarding the meaning of the word "redskin(s)."

We agree that there is a substantial amount of evidence in the record establishing that, since at least the 1960's and continuing to the present, the term "Redskins" has been used widely [*130] in print and other media to identify respondent's professional football team and its entertainment services. But our inquiry does not stop here. Our precedent also requires us to consider the manner in which respondent's marks appear and are used in the marketplace. In this regard, while petitioners concede that, from at least the 1960's to the present, the word "Redskins," in the context of professional sports, identifies respondent's football team, petitioners contend, essentially, that all professional football teams have themes that are carried through in their logos, mascots, nicknames, uniforms and various paraphernalia sold or used in connection with their entertainment services. Petitioners point to the Native American theme evident in respondent's logos and the imagery and themes used by respondent in connection with its football team and games. This imagery is also evident in the writings and activities of the media and in the activities and writings of the team's fans. Petitioners contend that, in view of the team's Native American theme, one cannot separate the connotation of "redskin(s)" as a reference to Native Americans from the connotation of that word as it identifies [*131]

respondent's football team and is used in connection with respondent's entertainment services.

Respondent correctly notes that the evidence herein establishes that the vast majority of uses of the word "redskin(s)" in the press and other media, since at least the 1960's, refer to respondent's professional football team, rather than to Native Americans. At the same time, we find that, in determining the meaning of the term "redskin(s)" as it appears in respondent's registered marks, it would be both factually incomplete and disingenuous to ignore the substantial evidence of Native American imagery used by respondent, as well as by the media and respondent's fans, n111 in connection with respondent's football team and its entertainment services. Respondent admits that it "does not claim that its marks bear no association with American Indians, nor that when the team name was first adopted in 1933 it connoted anything other than an ethnic group." However, the evidence simply does not support respondent's further contention that, in view of its use since 1933, the meaning of the word "Redskins," as part of its registered marks, is as "a purely denotative term of reference for the [*132] professional football team [with] no connotative meaning whatsoever." As used by respondent in connection with its professional football team and entertainment services, the word "Redskins," as it appears in the marks herein, clearly carries the allusion to Native Americans.

n111 Respondent argues vociferously, and correctly, that it is not responsible for the

> writings and actions of the media and respondent's fans. However, such evidence is relevant herein because it indicates the public's perceptions of the meanings attributable to, and associations made in connection with, respondent's service marks.

Two of the registered marks include a portrait that respondent acknowledges is a profile of a Native American and a spear that we presume is a Native American spear. We believe these two elements reinforce the allusion to Native Americans that is present in the word "Redskins" in both marks. Because of the manner of use of respondent's marks in connection with Native American themes and imagery, as discussed herein, this same allusion is also present in the marks that include the word "Washington," to indicate the full name of the football team, *i.e.*, "Washington Redskins. [*133] " Further, the registered mark, REDSKINETTES, clearly consists of the root word "redskin" with the diminutive or feminine "ettes" added as a suffix. Thus, our conclusions regarding the word "Redskins" are equally applicable to the mark REDSKINETTES.

We note that, in considering the meaning of the matter in question, respondent misunderstands the issue when it states, in reaction to newspaper headlines in the record, such as "Skins Scalp Giants, 23-7," that "no Redskins fan truly believes that the players huddled on the ten yard line are in fact tribal bounty hunters primed to scalp their opponents upon scoring a touchdown." Clearly, the connection being made between the quoted headline and respondent's football team by the media, fans,

and respondent itself is metaphorical rather than literal, as acknowledged by respondent's written statement (Cooke Exhibit 10, *see* Cooke testimony, vol. II, pgs. 90-91) that states, in part, "over the long history of the Washington Redskins, the name has reflected positive attributes of the American Indian such as dedication, courage and pride."

This is not a case where, through usage, the word "redskin(s)" has lost its meaning, in the field [*134] of professional football, as a reference to Native Americans in favor of an entirely independent meaning as the name of a professional football team. Rather, when considered in relation to the other matter comprising at least two of the subject marks and as used in connection with respondent's services, "Redskins" clearly both refers to respondent's professional football team and carries the allusion to Native Americans inherent in the original definition of that word. This conclusion is equally applicable to the time periods encompassing 1967, 1974, 1978 and 1990, as well as to the present time.

2. Whether the Matter in Question May Disparage Native Americans.

We turn, now, to the second part of our analysis, the question of whether the matter in question may disparage Native Americans. We have found that, as an element of respondent's marks and as used in connection with respondent's services, the word "redskin(s)" retains its meaning as a reference to Native Americans, as do the graphics of the spear and the Native American portrait. In view thereof, we consider the question of whether this matter may disparage Native Americans by reference to the

perceptions of Native Americans. [*135] Our standard, as enunciated herein, is whether, as of the relevant times, a substantial composite of Native Americans in the United States so perceive the subject matter in question. In rendering our opinion, we consider the broad range of evidence in this record as relevant to this question either directly or by inference.

Several of petitioners' witnesses expressed their opinions that the use of Native American references or imagery by non-Native Americans is, essentially, *per se* disparaging to Native Americans or, at the very least, that the use of Native American references or imagery in connection with football n112 is *per se* disparaging to Native Americans. We find no support in the record for either of these views. Consequently, we answer the question of disparagement based on the facts in this case by looking to the evidence regarding the views of the relevant group, the connotations of the subject matter in question, the relationship between that matter and the other elements that make up the marks, and the manner in which the marks appear and are used in the marketplace.

n112 Petitioners' linguistics expert expressed his opinion that names of football teams are chosen either to indicate geographic location or to indicate ferocity, and, thus, the choice of "Redskins" as a team name somehow establishes that the word carries negative connotations of savagery. We find this

reasoning to be circular and based primarily on conjecture.

[*136]

While petitioners' have framed their allegations broadly to include in their claim of disparagement all matter in the subject marks that refers to Native Americans, their arguments and extensive evidence pertain almost entirely to the "Redskins" portion of respondent's marks. We note that there is very little evidence or argument by either side regarding the other elements of respondent's marks that refer to Native Americans, namely, the spear design and the portrait of a Native American in profile. Both graphics are realistic in style. Respondent acknowledges that the portrait depicts a Native American individual, although it is unclear if it is a portrait of a real individual. There is no evidence that these graphics are used in a manner that may be perceived as disparaging, or that a substantial composite of the Native American population in the United States so perceives these graphics as used in the subject marks in connection with the identified services. n113 Thus, with respect to the spear design and the portrait of a Native American in profile, as these elements appear in two of the registered marks herein, we find that petitioners have not established, under Section 2(a), [*137] that this matter may disparage Native Americans.

n113 At least two of the petitioners testified that some types of feathers have religious significance to some Native American tribes

> and, thus, the secular use of such feathers is offensive. However, there is insufficient evidence regarding this allegation to warrant a conclusion that the mere representation of feathers in the marks herein may disparage Native Americans. Additionally, several of the petitioners testified that the portrait in two of the marks is a stereotypical representation of a Native American. There is insufficient evidence for us to conclude that this portrait is a stereotypical rendering of a Native American or that it may disparage Native Americans. The views of petitioners, alone, do not inform us of the views of a substantial composite of Native Americans.

The remaining question in relation to disparagement is whether the word "redskin(s)" may be disparaging of and to Native Americans, as that word appears in the marks in the subject registrations, in connection with the identified services, and during the relevant time periods.

We find petitioners have clearly established, by at least a preponderance [*138] of the evidence, that, as of the dates the challenged registrations issued, the word "redskin(s)," as it appears in respondent's marks in those registrations and as used in connection with the identified services, may disparage Native Americans, as perceived by a substantial composite of Native Americans. No single item of evidence or testimony alone brings us to this conclusion; rather, we reach our conclusion based on the cumulative effect of the entire record. We discuss below some of the more significant evidence in the record. We look, first, at the evidence

establishing that, in general and during the relevant time periods, the word "redskin(s)" has been a term of disparagement of and to Native Americans. Then we look at the evidence establishing that, during the relevant time periods, the disparaging connotation of "redskin(s)" as a term of reference for Native Americans extends to the word "Redskin(s)" as it appears in respondent's subject marks and as used in connection with respondent's identified services. We have considered the perceptions of both the general public and Native Americans to be probative. For example, we have found that the evidence supports the conclusion [*139] that a substantial composite of the general public finds the word "redskin(s)" to be a derogatory term of reference for Native Americans. Thus, in the absence of evidence to the contrary, it is reasonable to infer that a substantial composite of Native Americans would similarly perceive the word. This is consistent with the testimony of the petitioners.

We look, first, at the evidence often considered in the decisional law concerning Section 2 (a) scandalousness and disparagement, namely, dictionary definitions. Both petitioners and respondent have submitted excerpts defining "redskin" from numerous well-established American dictionary publishers from editions covering the time period, variously, from 1966 through 1996. Across the time period, the number of publishers including in their dictionaries a usage label indicating that the word "redskin" is disparaging is approximately equal, on this record, to those who do not include any usage label. For example, *Random House* publishers include the label "often offensive" in dictionaries published from 1966 onward. *American Heritage*

publishers indicate that "redskin" is "informal" in 1976 and 1981 editions and that it is "offensive [*140] slang" in 1992 and 1996 editions. The *World Book Dictionary* includes no usage label regarding "redskin" in either its 1967 or 1980 edition and more recent editions are not in evidence. From the testimony of the parties' linguistics experts, it is clear that each entry in a dictionary is intended to reflect the generally understood meaning and usage of that word. Thus, from the fact that usage labels appear in approximately half of the dictionaries of record at any point in the time period covered, we can conclude that a not insignificant number of Americans have understood "redskin(s)" to be an offensive reference to Native Americans since at least 1966. n114

> n114 In view of the contradictory testimony of the parties' linguistics experts regarding the significance of a lack of usage label for a dictionary entry, we cannot conclude that the lack of such labels in the other excerpts of record establishes that the word "redskin(s)" was *not* considered offensive during the relevant time period. Similarly, the single dictionary excerpt which contains a separate entry for "Redskins" defined as respondent's football team, does not affect this conclusion.

Discussing the substantial [*141] body of historical documents he reviewed in connection with his testimony herein, Dr. Geoffrey Nunberg, petitioners' linguistics expert, concluded that the word "redskin(s)" first appeared in writing as a

reference to Native Americans in 1699 and that, from 1699 to the present, the word "redskin(s)," used as a term of reference for Native Americans, evokes negative associations and is, thus, a term of disparagement. Additional evidence of record that is consistent with the opinions expressed Dr. Nunberg includes excerpts from various articles and publications about language. These writings include, often in a larger discussion about bias in language, the assumption or conclusion that the word "redskin(s)" as a term of reference for Native Americans is, and always has been, a pejorative term. n115

n115 See, for example, petitioners' exhibits entitled "Defining the American Indian: A Case Study in the Language of Suppression," by Haig A. Bosmajian, in the book, *Exploring Language*, by Gary Goshgarian (1983); by Irving Lewis Allen: *Unkind Words - Ethnic Labeling from Redskin to WASP* (1990) and *The Language of Ethnic Conflict - Social Organization and Lexical Culture* (1983); "I have Spoken: Indianisms in Current English," in *English Language Notes* (March 1992); and "Hostile Language: Bias in Historical Writing about American Indian Resistance," by Robert H. Keller, Jr., in the *Journal of American Culture - Studies of a Civilization* (Winter 1986).

[*142]

Petitioners made of record a substantial number of writings, including, *inter alia*, excerpts from newspapers and other publications, encyclopedias, and dictionaries, evidencing the use of the word "redskin(s)" from the late 1800's through the first half of this century. As agreed by both parties' linguistics experts, the vast majority of newspaper headlines, newspaper articles, and excerpts from books and periodicals from the late 1800's and early 1900's, which include the word "redskin(s)" as a reference to Native Americans, clearly portray Native Americans in a derogatory or otherwise negative manner. n116 For example, the newspaper articles in evidence from the late 1800's reflect a view by Anglo-American society of Native Americans as the savage enemy and the events reported are armed conflicts. n117 The entry for "North American Indian" in the *Encyclopedia Britannica* (11<th> edition, 1910) clearly refers to "the aboriginal people of North America" as "primitive" people, and includes a detailed table describing the degree to which individual tribes have been "civilized" or remain "wild and indolent." An excerpt from a book entitled *Making the Movies*, by Ernest Dench [*143] (MacMillan Company, 1919), includes a chapter entitled "The Dangers of Employing Redskins as Movie Actors," which states: "The Red Indians ... are paid a salary that keeps them well provided with tobacco and their worshipped 'firewater,'" and "It might be thought that this would civilise (*sic*) them completely, but it has had a quite reverse effect, for the work affords them an opportunity to live their savage days over again ... ."

n116 One of respondent's linguistics experts, Mr. Barnhart, challenges this conclusion and points to a number of historical references to Native Americans as "redskin(s)" that he concludes are neutral, if not positive. We disagree with Mr. Barnhart's conclusion and find the specified references to Native Americans to be, in fact, negative. However, even if we agreed with Mr. Barnhart's conclusions about these specified statements, we find these few references to be inconsequential in comparison to the substantial number of undisputedly negative historical references to Native Americans as "redskin(s)" in newspapers and other writings in the record.

n117 Interestingly, the word "Indian" is primarily used to refer to Native Americans in the text of these newspaper articles, whereas the word "redskin(s)" appears almost exclusively in the headlines. This would appear to indicate a distinction between the connotations of the two words, although neither party's linguistics experts discuss this point.

[*144]

Writings in evidence from the 1930's through the late 1940's, which include the word "redskin(s)" as a reference to Native Americans, reflect a slightly less disdainful, but still condescending, view of Native Americans. For example, an article entitled "Redskin Revival - High Birthrate Gives Congress a New Overproduction Headache," in *Newsweek*, February 20, 1939, while complaining about the financial and

administrative burden of "caring" for Native Americans, recognizes that the inequities suffered by Native Americans are a result of actions by the U.S. government.

From the 1950's forward, the evidence shows, and neither party disputes, that there are minimal examples of uses of the word "redskin(s)" as a reference to Native Americans. Most such occurrences are in a small number of writings about the character of the word itself, or in writings where we find that "redskin(s)" is used in a metaphorical sense juxtaposed with "white man" or "paleface." Both parties agree that, during this same time period, the record reflects significant occurrences of the word "redskin(s)" as a reference to respondent's football team.

We agree with respondent's conclusion that the pejorative [*145] nature of "redskin(s)" in the early historical writings of record comes from the overall negative viewpoints of the writings. However, this does not lead us to the conclusion that, as respondent contends, "redskin(s)" is an informal term for Native Americans that is neutral in connotation. n118 Rather, we conclude from the evidence of record that the word "redskin(s)" does not appear during the second half of this century in written or spoken language, formal or informal, as a synonym for "Indian" or "Native American" because it is, and has been since at least the 1960's, perceived by the general population, which includes Native Americans, as a pejorative term for Native Americans.

n118 We agree with petitioners that, although the evidence shows that the word "Indian" became an acceptable term of reference for Native Americans, we cannot conclude from this fact alone that the same is true for the word "redskin(s)."

We find the context provided by Dr. Hoxie's historical account, which respondent does not dispute, of the often acrimonious Anglo-American/Native American relations from the early Colonial period to the present n119 to provide a useful historical perspective from [*146] which to view the writings, cartoons and other references to Native Americans in evidence from the late 19<th> century and throughout this century.

n119 As Dr. Hoxie recounts, the policies of, first, the colonial government and, then, the U.S. government towards Native Americans reflect the general views of Anglo-Americans towards Native Americans at each point in history.

Finally, we note petitioners' telephone survey, as described herein, purporting to measure the views, at the time of the survey in 1996, of the general population and, separately, of Native Americans towards the word "redskin" as a reference to Native Americans. When read a list of seven words referring to Native Americans, 46.2% of participants in the general population sample (139 of 301 participants) and 36.6% of participants in the Native American sample (131 of 358 participants) indicated that they

found the word "redskin" offensive as a reference to Native Americans. We have discussed, *supra*, several of the flaws in the survey that limit its probative value. Additionally, the survey is of limited applicability to the issues in this case as it sought to measure the participants' views only as of 1996, [*147] when the survey was conducted, and its scope is limited to the connotation of the word "redskin" as a term for Native Americans, without any reference to respondent's football team. However, considering these limitations, we find that the percentage of participants in each sample who responded positively, *i.e.*, stated they were offended by the word "redskin(s)" for Native Americans, to be significant. n120 While the survey polls a relatively small sample and the positive results reflect less than a majority of that sample, we find these results supportive of the other evidence in the record indicating the derogatory nature of the word "redskin(s)" for the entire period from, at least, the mid-1960's to the present, to substantial composites of both the general population and the Native American population. n121

n120 We note that in cases considering other trademark issues, such as likelihood of confusion or secondary meaning, the courts have found that, respectively, confusion or recognition by an "appreciable number of customers" may be much less than a majority. *See, McCarthy on Trademarks and Unfair Competition*, 4<th> ed. (West Group, 1998), Vol. 5, Section 32.185.

n121 Respondent has presented no evidence suggesting that, as a term identifying Native Americans, the perception of the derogatory nature of the word "redskin(s)" by any segment of the general population, including Native Americans, changed significantly during this time period. To the contrary, the evidence of record suggests that, as a term identifying Native Americans, "redskin(s)" has been perceived consistently, by both the general population and Native Americans as a derogatory term since, at least, the 1960's.

[*148]

The evidence we have discussed so far pertains, generally, to the word "redskin(s)" as it refers to Native Americans. From this evidence we have concluded, *supra*, that the word "redskin(s)" has been considered by a substantial composite of the general population, including by inference Native Americans, a derogatory term of reference for Native Americans during the time period of relevance herein. We have also concluded, *supra*, that the word "Redskins" in respondent's marks in the challenged registrations, identifies respondent's football team and carries the allusion to Native Americans inherent in the original definition of the word. Evidence of respondent's use of the subject marks in the 1940's and 1950's shows a disparaging portrayal of Native Americans in connection with the word "Redskin(s)" that is more egregious than uses of the subject marks in the record from approximately the mid-1960's to the present. However, such a finding does not lead us to the conclusion that the subject marks, as used in connection with the identified

services during the relevant time periods, are not still disparaging of and to Native Americans under Section 2 (a) of the Act. The character [*149] of respondent's allusions to Native Americans in its use of the subject marks is consistent with the general views towards Native Americans held by the society from approximately the 1940's forward.

In particular, the evidence herein shows a portrayal in various media of Native Americans, unrelated to respondent's football team, as uncivilized and, often, buffoon-like characters from, at least, the beginning of this century through the middle to late 1950's. As we move through the 1960's to the present, the evidence shows an increasingly respectful portrayal of Native Americans. This is reflected, also, in the decreased use of "redskin(s)," as a term of reference for Native Americans, as society in general became aware of, and sensitive to, the disparaging nature of that word as so used.

The evidence herein shows a parallel development of respondent's portrayal of Native Americans in connection with its services. For example, various covers of respondent's game program guides and other promotional efforts, including public relations stunts presenting players in Native American headdresses, from the 1940's through the middle to late 1950's show caricature-like portrayals of Native [*150] Americans as, usually, either savage aggressors or buffoons. Similarly, for the same time period, the costumes and antics of the team, the Redskins Marching Band, and the "Redskinettes" cheerleaders reflect a less than respectful portrayal of Native Americans. n122

n122 See petitioners' Exhibits Nos. 12 and 29. We note that the record clearly establishes a relationship between respondent and both the "Redskinettes" cheerleader organization and the Redskins Band organization warranting attribution of their respective uses of the subject marks and Native American imagery to respondent.

During the late 1950's and early 1960's, the evidence shows respondent's game program covers with realistic portraits of actual Native American individuals, reflecting society's increased respect for, and interest in, Native American culture and history. During the 1960's through to the present, the evidence establishes that respondent has largely substituted football imagery for Native American imagery on its game program covers; that it has modified the lyrics of its theme song, "Hail to the Redskins" and modified its cheerleaders' uniforms; and Mr. Cooke testified that respondent has, for several [*151] years, had a strict policy mandating a restrained and "tasteful" portrayal of Native American imagery by its licensees. Of course, the allusion to Native Americans in connection with respondent's team has continued unabated, for example, in respondent's name, its trademarks, and through the use of Native American imagery such as the headdresses worn for many years by the Redskins Band.

Both parties have submitted voluminous excerpts from newspapers, including cartoons, headlines, editorials and articles, from the 1940's to the

present, that refer to respondent's football team in the context of stories and writings about the game of football. These excerpts show that, despite respondent's more restrained use of its Native American imagery over time, the media has used Native American imagery in connection with respondent's team, throughout this entire time period, in a manner that often portrays Native Americans as either aggressive savages or buffoons. For example, many headlines refer to the "Redskins" team, players or managers "scalping" opponents, seeking "revenge," "on the warpath," and holding "pow wows"; or use pidgin English, such as "Big Chief Choo Choo - He Ponder." n123 [*152] Similarly, petitioners have submitted evidence, both excerpts from newspapers and video excerpts of games, showing respondent's team's fans dressed in costumes and engaging in antics that clearly poke fun at Native American culture and portray Native Americans as savages and buffoons. n124 As we have already stated, we agree with respondent that it is not responsible for the actions of the media or fans; however, the actions of the media and fans are probative of the general public's perception of the word "redskin(s)" as it appears in respondent's marks herein. As such, this evidence reinforces our conclusion that the word "redskin(s)" retains its derogatory character as part of the subject marks and as used in connection with respondent's football team.

n123 See, for example, petitioners' Exhibit 12, notice of reliance.

n124 See, for example, petitioners' Exhibit 13, notice of reliance.

Regarding the views of Native Americans in particular, the record contains the testimony of petitioners themselves stating that they have been seriously offended by respondent's use of the word "redskin(s)" as part of its marks in connection with its identified services. The record includes [*153] resolutions indicating a present objection to the use of this word in respondent's marks from the NCAI, which the record adequately establishes as a broad-based organization of Native American tribes and individuals; from the Oneida tribe; and from Unity 94, an organization including Native Americans. Additionally, petitioners have submitted a substantial number of news articles, from various time periods, including from 1969-1970, 1979, 1988-1989, and 1991-1992, reporting about Native American objections, and activities in relation thereto, to the word "Redskins" in respondent's team's name. These articles establish the public's exposure to the existence of a controversy spanning a long period of time. Also with respect to Native American protests, we note, in particular, the testimony of Mr. Gross regarding his 1972 letter, in his role as director of the Indian Legal Information Development Service, to Mr. Williams, then-owner of the Washington Redskins, urging that the name of the team be changed; and regarding his 1972 meeting with Mr. Williams, along with colleagues from several other Native American organizations. Mr. Gross testified that the individuals representing the Native [*154] American organizations expressed their views to Mr. Williams that the team name, "Washington Redskins," is disparaging, insulting

and degrading to Native Americans. This evidence reinforces the conclusion that a substantial composite of Native Americans have held these views for a significant period of time which encompasses the relevant time periods herein.

We are not convinced otherwise by respondent's contentions, argued in its brief, that Native Americans support respondent's use of the name "Washington Redskins"; and that Native Americans regularly employ the term "redskin" within their communities. Respondent has presented no credible evidence in support of either contention. In particular, respondent submitted, by notice of reliance, *inter alia*, letters from fans in support of the team name n125; several letters and resolutions purported to be from Native American tribal chiefs expressing their support for respondent's team name "Washington Redskins"; n126 and unidentified photographs purported to have been taken on Indian reservations. n127

n125 Respondent's case includes no testimony by the authors of these letters to establish any foundation for the letters. Thus, this evidence has not been considered for the truth of the statements contained therein. Even if we were to accept these letters for the truth of the statements contained therein, which we do not, the vast majority of letters are from non-Native Americans, some of whom report the views of Native Americans with whom they are acquainted. The contents of the letters are, themselves, hearsay, and the

reports by the letter-writers of third-party opinions are also hearsay.

n126 Respondent's case includes no testimony by the authors of these letters and resolutions to establish any foundation for the letters and resolutions. Further, the lack of testimony about the letters and resolutions makes it impossible to determine the extent to which the views contained therein speak for a group of Native Americans or just for the authors, or what is the basis for the views expressed. Thus, this evidence has not been considered for the truth of the statements contained therein. Further, this small number of letters would not change our determination herein even if we were to so consider this evidence.

n127 There is no testimony in the record establishing a foundation for consideration of these photographs. Respondent's counsel referred to the photographs primarily during cross examination of petitioners' witnesses, none of whom professed any knowledge regarding the subject matter of the photographs. Any information about the photographs herein consists merely of the statements of respondent's counsel. Respondent's witness, Mr. Cooke, indicated during his testimony a general awareness of other teams with the word "redskin(s)" as part of their names; however, he presented no specific testimony about such teams. Thus, we find no probative value in the photographs and counsel's statements in connection therewith,

and little probative value to Mr. Cooke's vague statement.

[*155]

Finally, we note that both parties' briefs have made and debated, and we have considered additional arguments, the majority of which we find irrelevant and all of which we find unnecessary to discuss.

Thus, we conclude that the evidence of record establishes that, within the relevant time periods, the derogatory connotation of the word "redskin(s)" in connection with Native Americans extends to the term "Redskins," as used in respondent's marks in connection with the identified services, such that respondent's marks may be disparaging of Native Americans to a substantial composite of this group of people.

Contempt or Disrepute

We incorporate by reference our preceding analysis, discussion of the facts, and conclusions with respect to disparagement. As we have indicated, *supra*, the guidelines for determining whether matter in the marks in the challenged registrations may be disparaging to Native Americans are equally applicable to determining whether such matter brings Native Americans into contempt or disrepute. Thus, we conclude that the marks in each of the challenged registrations consist of or comprise matter, namely, the word or root word, "Redskin," which may bring [*156] Native Americans into contempt or disrepute.

Scandalousness

As we have indicated, *supra*, determining whether matter is scandalous involves, essentially, a two-step process. First, the Court or Board determines the likely meaning of the matter in question and, second, whether, in view of the likely meaning, the matter is scandalous to a substantial composite of the general public. Regarding the conclusions drawn with respect to disparagement, we incorporate by reference our discussion and conclusion that the meaning of the matter in question, namely, the word or root word "Redskin," as used by respondent in connection with its professional football team and entertainment services and as it appears in the marks herein, clearly carries the allusion to Native Americans; and that this allusion to Native Americans is reinforced by the design elements in the registered marks incorporating the profile of a Native American and a Native American spear. However, while we incorporate by reference the analysis of the facts in the discussion, *supra*, of whether the matter in question may disparage Native Americans, as well as the conclusions reached therein regarding the design elements [*157] in the subject marks, n128 we reach a different conclusion with respect to the alleged scandalousness of the "Redskin" portions of the marks in respondent's challenged registrations.

n128 We found, *supra*, that petitioners have not established that these designs are disparaging to Native Americans. Similarly, we find that these design elements, as shown in

> the subject marks and as used in connection with the identified services, are not scandalous as of any of the relevant time periods.

In particular, we find that, based on the record in this case, petitioners have not established by a preponderance of the evidence that the marks in respondent's challenged registrations consist of or comprise scandalous matter. We find that the evidence, as discussed above, *does* establish that, during the relevant time periods, a substantial composite of the general population would find the word "redskin(s)," as it appears in the marks herein in connection with the identified services, to be a derogatory term of reference for Native Americans. But the evidence *does not* establish that, during the relevant time periods, the appearance of the word "redskin(s)," in the marks herein [*158] and in connection with the identified services, would be "shocking to the sense of truth, decency, or propriety" to, or "give offense to the conscience or moral feelings [of,] excite reprobation, [or] call out for condemnation" by, a substantial composite of the general population. *See, In re Mavety Media Group Ltd., supra at 1925.*

The record reflects the clear acceptance by a substantial composite of the general population of the use of the word "Redskins" as part of the name of respondent's football team and in connection with its entertainment services, regardless of the derogatory nature of the word vis-a-vis Native Americans. This evidence includes the voluminous number of references, in both letters n129 and news articles, to respondent's football team by a substantial number of fans and the media over a long period of time

from, at least, the 1940's to the present. Such continuous renown in the sport of football and acceptance of the word "Redskin(s)" in connection with respondent's football team is inconsistent with the sense of outrage by a substantial composite of the general population that would be necessary to find this word scandalous in the context [*159] of the subject marks and the identified services.

n129 We consider the letters in this regard, not for their content, but for the fact that they evidence knowledge by the writers about the team and the use of the word "Redskins" in the team's name.

J. D. Sams

R. F. Cissel

C. E. Walters

Administrative Trademark Judges, Trademark Trial and Appeal Board

Legal Topics:

For related research and practice materials, see the following legal topics:

Trademark LawProtection of RightsRegistrationGeneral OverviewTrademark

LawU.S. Trademark Trial & Appeal Board ProceedingsCancellationsGeneral Overview

GRAPHIC:

Illustrations 1 through 3, no caption

United States Court of Appeals

FOR THE DISTRICT OF COLUMBIA CIRCUIT

No. 03-7162 September Term, 2005

99cv01385

Filed On: September 9, 2005

[917571]

Pro Football, Inc.,

Appellee

v.

Suzan S. Harjo, et al.,

Appellants

BEFORE: Sentelle, Randolph, and Tatel, Circuit Judges

O R D E R

Upon consideration of appellee's petition for rehearing filed August 15, 2005, it is

ORDERED that the petition be denied.

Per Curiam
FOR THE COURT:
Mark J. Langer, Clerk
BY:
Michael C. McGrail
Deputy Clerk

United States Court of Appeals

FOR THE DISTRICT OF COLUMBIA CIRCUIT

No. 03-7162 September Term, 2005

99cv01385

Filed On: September 9, 2005

[917570]

Pro Football, Inc.,

Appellee

v.

Suzan S. Harjo, et al.,

Appellants

BEFORE: Ginsburg, Chief Judge, and Edwards,* Sentelle, Henderson,

Randolph, Rogers, Tatel, Garland,* Roberts,* Brown and

Griffith, Circuit Judges

O R D E R

Upon consideration of appellee's petition for rehearing en banc, and the absence of a request by any member of the court for a vote, it is

ORDERED that the petition be denied.

Per Curiam
FOR THE COURT:
Mark J. Langer, Clerk
BY:
Michael C. McGrail
Deputy Clerk

* Circuit Judges Edwards, Garland, and Roberts did not participate in this matter.

LEXSTAT 15 U.S.C. 1052

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*** CURRENT THROUGH PL 111-62, APPROVED 08/19/2009 ***

TITLE 15. COMMERCE AND TRADE
CHAPTER 22. TRADEMARKS
THE PRINCIPAL REGISTER

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15 USCS ß 1052

ß 1052. Trademarks registrable on the principal register; concurrent registration

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it--

(a) Consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute; or a geo-

graphical indication which, when used on or in connection with wines or spirits, identifies a place other than the origin of the goods and is first used on or in connection with wines or spirits by the applicant on or after one year after the date on which the WTO Agreement (as defined in section 2(9) of the Uruguay Round Agreements Act [*19 USCS β 3501(9)*]) enters into force with respect to the United States.

(b) Consists of or comprises the flag or coat of arms or other insignia of the United States, or of any State or municipality, or of any foreign nation, or any simulation thereof.

(c) Consists of or comprises a name, portrait, or signature identifying a particular living individual except by his written consent, or the name, signature, or portrait of a deceased President of the United States during the life of his widow, if any, except by the written consent of the widow.

(d) Consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive: *Provided*, That if the Director determines that confusion, mistake, or deception is not likely to result from the continued use by more than one person of the same or similar marks under conditions and limitations as to the mode or place of use of the marks or the goods on or in connection with which such marks are used, concurrent registrations may be issued to such persons when they

have become entitled to use such marks as a result of their concurrent lawful use in commerce prior to (1) the earliest of the filing dates of the applications pending or of any registration issued under this Act; (2) July 5, 1947, in the case of registrations previously issued under the Act of March 3, 1881, or February 20, 1905, and continuing in full force and effect on that date; or (3) July 5, 1947, in the case of applications filed under the Act of February 20, 1905, and registered after July 5, 1947. Use prior to the filing date of any pending application or a registration shall not be required when the owner of such application or registration consents to the grant of a concurrent registration to the applicant. Concurrent registrations may also be issued by the Director when a court of competent jurisdiction has finally determined that more than one person is entitled to use the same or similar marks in commerce. In issuing concurrent registrations, the Director shall prescribe conditions and limitations as to the mode or place of use of the mark or the goods on or in connection with which such mark is registered to the respective persons.

(e) Consists of a mark which (1) when used on or in connection with the goods of the applicant is merely descriptive or deceptively misdescriptive of them, (2) when used on or in connection with the goods of the applicant is primarily geographically descriptive of them, except as indications of regional origin may be registrable under section 4 [*15 USCS β 1054*], (3) when used on or in connection with the goods of the applicant is primarily geographically deceptively misdescriptive of them, (4) is primarily merely a

surname, or (5) comprises any matter that, as a whole, is functional.

(f) Except as expressly excluded in subsections (a), (b), (c), (d), (e)(3), and (e)(5) of this section, nothing herein shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods in commerce. The Director may accept as prima facie evidence that the mark has become distinctive, as used on or in connection with the applicant's goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years before the date on which the claim of distinctiveness is made. Nothing in this section shall prevent the registration of a mark which, when used on or in connection with the goods of the applicant, is primarily geographically deceptively misdescriptive of them, and which became distinctive of the applicant's goods in commerce before the date of the enactment of the North American Free Trade Agreement Implementation Act [enacted Dec. 8, 1993]. A mark which would be likely to cause dilution by blurring or dilution by tarnishment under section 43(c) [*15 USCS ß 1125(c)*], may be refused registration only pursuant to a proceeding brought under section 13 [*15 USCS ß 1063*]. A registration for a mark which would be likely to cause dilution by blurring or dilution by tarnishment under section 43(c) [*15 USCS ß 1125(c)*], may be canceled pursuant to a proceeding brought under either section 14 or section 24 [*15 USCS ß 1064* or *1092*]

LEXSTAT 15 USCS ß 1064

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TITLE 15. COMMERCE AND TRADE
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15 USCS ß 1064

Review expert commentary from The National Institute for Trial Advocacy

ß 1064. Cancellation of registration

A petition to cancel a registration of a mark, stating the grounds relied upon, may, upon payment of the prescribed fee, be filed as follows by any person who believes that he is or will be damaged, including as a result of a likelihood of dilution by blurring or dilution by tarnishment under section 43(c) [*15 USCS ß 1125(c)*], by the registration of a mark on the princi-

pal register established by this Act, or under the Act of March 3, 1881, or the Act of February 20, 1905:

(1) Within five years from the date of the registration of the mark under this Act.

(2) Within five years from the date of publication under section 12(c) hereof [*15 USCS β 1062(c)*] of a mark registered under the Act of March 3, 1881, or the Act of February 20, 1905.

(3) At any time if the registered mark becomes the generic name for the goods or services, or a portion thereof, for which it is registered, or is functional, or has been abandoned, or its registration was obtained fraudulently or contrary to the provisions of section 4 [*15 USCS β 1054*] or of subsection (a), (b), or (c) of section 2 [*15 USCS β 1052*] for a registration under this Act, or contrary to similar prohibitory provisions of such prior Acts for a registration under such Acts, or if the registered mark is being used by, or with the permission of, the registrant so as to misrepresent the source of the goods or services on or in connection with which the mark is used. If the registered mark becomes the generic name for less than all of the goods or services for which it is registered, a petition to cancel the registration for only those goods or services may be filed. A registered mark shall not be deemed to be the generic name of goods or services solely because such mark is also used as a name of or to identify a unique product or service. The primary significance of the registered mark to the relevant public rather than purchaser motivation shall be the test for determining whether the registered mark has become the generic name of goods or

services on or in connection with which it has been used.

(4) At any time if the mark is registered under the Act of March 3, 1881, or the Act of February 20, 1905, and has not been published under the provisions of subsection (c) of section 12 of this Act [*15 USCS ß 1062*].

(5) At any time in the case of a certification mark on the ground that the registrant (A) does not control, or is not able legitimately to exercise control over, the use of such mark, or (B) engages in the production or marketing of any goods or services to which the certification mark is applied, or (C) permits the use of the certification mark for purposes other than to certify, or (D) discriminately refuses to certify or to continue to certify the goods or services of any person who maintains the standards or conditions which such mark certifies:

Provided, That the Federal Trade Commission may apply to cancel on the grounds specified in paragraphs (3) and (5) of this section any mark registered on the principal register established by this Act, and the prescribed fee shall not be required. Nothing in paragraph (5) shall be deemed to prohibit the registrant from using its certification mark in advertising or promoting recognition of the certification program or of the goods or services meeting the certification standards of the registrant. Such uses of the certification mark shall not be grounds for cancellation under paragraph (5), so long as the registrant does not itself produce, manufacture, or sell any of the

certified goods or services to which its identical certification mark is applied.

LEXSTAT 15 USCS ß 1069

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TITLE 15. COMMERCE AND TRADE
CHAPTER 22. TRADEMARKS
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15 USCS ß 1069

ß 1069. Application of equitable principles in inter partes proceedings

In all inter partes proceedings equitable principles of laches, estoppel, and acquiescence, where applicable may be considered and applied.

LEXSEE 245 F.3D 1359

BRIDGESTONE/FIRESTONE RESEARCH, INC., Appellant, v. AUTOMOBILE CLUB DE L'OUEST DE LA FRANCE, Appellee.

00-1036

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

245 F.3d 1359*; *2001 U.S. App. LEXIS 5687*; *58 U.S.P.Q.2D (BNA) 1460

April 6, 2001, Decided

PRIOR HISTORY: [**1] Appealed from: Patent and Trademark Office, Trademark Trial & Appeal Board. (Cancellation No. 19,683).

DISPOSITION: REVERSED.

COUNSEL: Peter G. Mack, Foley & Lardner, of Washington, DC, argued for appellant. Of counsel was John H. Hornickel, Bridgestone/Firestone, Inc., of Akron, Ohio.

Michael J. Striker, of Huntington, New York, argued for appellee.

JUDGES: Before NEWMAN, MICHEL, and LOURIE, Circuit Judges.

OPINION BY: NEWMAN

OPINION

[*1360] NEWMAN, Circuit Judge.

Bridgestone/Firestone Research, Inc. ("Bridgestone") is the owner of Trademark Registration No. 756,436 for the mark LEMANS for "pneumatic rubber tires" on the principal register, issued on September 10, 1963. The United States Patent and Trademark Office Trademark Trial and Appeal Board granted the petition of Automobile Club de l'Ouest de la France ("Automobile Club") to cancel the registration. [1] We reverse the Board's decision.

1 Bridgestone/Firestone Research, Inc. v. Automobile Club de l'Ouest de la France, Cancellation No. 19,683 (TTAB July 21, 1999).

[**2] BACKGROUND

The Automobile Club, a French entity, manages an automobile race in the city of Le Mans, France, called "Les 24 Heures du Mans." The Le Mans race was first run in 1923, and is internationally known. In 1986 the Automobile Club was granted United States Trademark Registration No. 1,386,349 on the supplemental register, for the mark LE MANS for "automobile tires." In 1991, Bridgestone filed a petition to cancel the Automobile Club's registration, based on Bridgestone's 1963 registration of LEMANS for tires. That cancellation petition was granted, and is not appealed.

The Automobile Club counterclaimed for cancellation of Bridgestone's registration, on the ground that Bridgestone's trademark use of LEMANS falsely suggested a connection with the Automobile Club and its sponsorship of the Le Mans race, in violation of § 2(a) of the Lanham Act:

> ***15 U.S.C. § 1052(a).*** No trademark . . . shall be refused registration on the principal register on account of its nature unless it . . . falsely suggests a connection with persons, living or dead, institutions, beliefs, or national symbols.

Bridgestone denied the charge and raised, inter [**3] alia, the defense of laches based on the passage of twenty-seven years between issuance of its LEMANS registration and the Automobile Club's cancellation petition.

The Board granted the cancellation petition, holding that "the term LEMANS points uniquely

and unmistakably to the Automobile Club, and that the Automobile Club's race is of sufficient fame or reputation that when Bridgestone's mark LEMANS is used on tires, a connection with the Automobile Club would be presumed." The Board rejected the laches defense, ruling that Bridgestone had not provided adequate evidence of its reliance on the [*1361] Automobile Club's twenty-seven years of silence.

Bridgestone appeals, arguing that the Board incorrectly applied the criteria of laches, that the Board misapplied the law of § 2(a) false suggestion of connection, and that the Automobile Club does not have a protectible § 2(a) interest in the LEMANS trademark.

DISCUSSION

Rulings of PTO tribunals are reviewed by the Federal Circuit in accordance with the standards of the Administrative Procedure Act. See *Dickinson v. Zurko, 527 U.S. 150, 152, 50 U.S.P.Q.2D (BNA) 1930, 1931-32, 144 L. Ed. 2d 143, 119 S. Ct. 1816 (1999)*. [**4] Laches is an equitable defense, and the Board's rulings on this issue are reviewed on the standard of abuse of discretion. Abuse of discretion will lie when the tribunal's decision rests on an error of law or on erroneous findings of fact, or if the decision manifests an unreasonable exercise of judgment in weighing relevant factors. See *A.C. Aukerman Co. v. R.L. Chaides Constr. Co., 960 F.2d 1020, 1028, 1039, 22 U.S.P.Q.2D (BNA) 1321, 1325, 1333 (Fed. Cir. 1992) (en banc)*. We give plenary review to the Board's legal conclusions, see *In re The Boston Beer Co. Ltd. P'ship, 198 F.3d 1370, 1373, 53 U.S.P.Q.2D (BNA) 1056, 1058 (Fed. Cir. 1999)*, and

uphold the Board's factual findings unless they are arbitrary, capricious, or unsupported by substantial evidence. See *On-Line Careline, Inc. v. America Online, Inc., 229 F.3d 1080, 1085, 56 U.S.P.Q.2D (BNA) 1471, 1475 (Fed. Cir. 2000).*

A

By statute, the defense of laches is available in trademark proceedings. See *15 U.S.C. § 1069* ("In all inter partes proceedings equitable principles of laches, estoppel, and acquiescence, where applicable may be considered and applied."). Bridgestone, [**5] as the party raising the affirmative defense of laches, bears the burden of proof. See *Fed. R. Civ. P. 8(c)* (characterizing laches as an affirmative defense); *Cornetta v. United States, 851 F.2d 1372, 1380 (Fed. Cir. 1988).*

To prevail on its affirmative defense, Bridgestone was required to establish that there was undue or unreasonable delay by the Automobile Club in asserting its rights, and prejudice to Bridgestone resulting from the delay. See *Lincoln Logs Ltd. v. Lincoln Pre-cut Log Homes, Inc., 971 F.2d 732, 734, 23 U.S.P.Q.2D (BNA) 1701, 1703 (Fed. Cir. 1992).* The Board rejected Bridgestone's defense of laches with the following explanation:

> n.5 The only affirmative defenses maintained by Bridgestone in its brief were "laches" and "estoppel by laches." The record does not reflect evidence on these defenses; and in Bridgestone's brief, it stated only very general information about its alleged reliance on the Automobile Club's delay in seeking

> cancellation of Bridgestone's registration. For example, Bridgestone stated that ". . . in reliance on the lack of any objection for so many decades, Firestone has designed, marketed, and sold many tires [**6] under the name LEMANS"; and "Firestone would obviously not have invested so much time and money in its LEMANS tires had [the Automobile Club's] objections been timely raised . . . ."
>
> Bridgestone provided absolutely no specific information regarding its alleged reliance on the Automobile Club's alleged silence. While it is clear that there has been a delay in seeking cancellation of Bridgestone's registration, Bridgestone has not proven the elements of the affirmative defenses of laches and estoppel by laches.

Bridgestone, slip op. at 5 n.5.

Undue Delay

In determining whether a party has too long "slept on its rights" it is [*1362] necessary to show that the party knew or should have known that it had a right of action, yet did not act to assert or protect its rights. Cf. *A.C. Aukerman Co., 960 F.2d at 1032, 22 U.S.P.Q.2D (BNA) at 1328* (to invoke the defense of laches against a charge of patent infringement the defendant must show that the plaintiff knew or reasonably should have known of the infringement). The Automobile Club states that it did not know of Bridgestone's LEMANS

registration until 1991, when Bridgestone sought cancellation of the Automobile [**7] Club's LE MANS registration, and thus that the period of delay should be measured only from 1991. Bridgestone responds that the statutory constructive notice of ownership and its conspicuous and widespread use of the LEMANS mark for decades placed a duty of inquiry on the Automobile Club. See *Johnston v. Standard Mining Co., 148 U.S. 360, 370, 37 L. Ed. 480, 13 S. Ct. 585 (1893)* (placing the duty of inquiry "upon a man of ordinary intelligence").

The Trademark Act establishes various events in the life of a registered trademark which impact upon an adverse claimant, from which events action could be taken and thus from which the period of delay may be measured. Thus *15 U.S.C. § 1072* provides that registration on the principal register is constructive notice of the registrant's claim of ownership of the trademark; *§ 1065* states the conditions of incontestability of the registrant's right to use the trademark; and *§ 1115* provides that registration is evidence of the registrant's exclusive right to use the trademark. All of these events, including constructive notice, widespread commercial use (knowledge of which is not denied [**8] by the Automobile Club), and the passing of twenty-seven years after registration, accompanied by the absence of a reasonable excuse by the Automobile Club for its inaction, require that the Automobile Club be charged with undue delay in seeking cancellation of Bridgestone's trademark registration. See *National Cable Television Ass'n, Inc. v. American Cinema Editors, Inc., 937 F.2d 1572, 1581, 19 U.S.P.Q.2D (BNA) 1424, 1432 (Fed. Cir. 1991)* (laches runs from the time from which

action could be taken against the trademark rights inhering upon registration).

Prejudice

Laches is "principally a question of the inequity of permitting the claim to be enforced -- an inequity founded upon some change in the condition or relations of the property or the parties." *Galliher v. Cadwell, 145 U.S. 368, 373, 36 L. Ed. 738, 12 S. Ct. 873 (1892).* Mere delay in asserting a trademark-related right does not necessarily result in changed conditions sufficient to support the defense of laches. There must also have been some detriment due to the delay. See *Advanced Cardiovascular Sys. v. Scimed Life Sys., 988 F.2d 1157, 1161, 26 U.S.P.Q.2D (BNA) 1038, 1041 (Fed. Cir. 1993).* [**9] The Board held that Bridgestone had not proven prejudice, stating that "Bridgestone provided absolutely no specific information regarding its alleged reliance on the Automobile Club's alleged silence."

Two general categories of prejudice may flow from an unreasonable delay: prejudice at trial due to loss of evidence or memory of witnesses, and economic prejudice based on loss of time or money or foregone opportunity. See *A.C. Aukerman Co., 960 F.2d at 1033, 22 U.S.P.Q.2D (BNA) at 1328-29; Cornetta, 851 F.2d at 1378.* Bridgestone asserted economic prejudice, presenting evidence of its longstanding investment in and promotion of the LEMANS brand of tires, including use of the mark on at least four types of tires manufactured by Bridgestone: LEMANS SR, LEMANS Metric, LEMANS Touring, and LEMANS All Terrain. Bridgestone presented testimony on the advertising

of the LEMANS brand and the role of the [*1363] LEMANS brand in Bridgestone's marketing structure. Bridgestone's evidence of the commercial use of the mark was not challenged. It was undisputed that Bridgestone invested in and promoted the LEMANS brand tires over this lengthy period, during which the Automobile Club [**10] was silent.

The Board's requirement of "specific" evidence of "reliance" on the Automobile Club's silence could relate to proof of estoppel, but it does not apply to laches. When there has been an unreasonable period of delay by a plaintiff, economic prejudice to the defendant may ensue whether or not the plaintiff overtly lulled the defendant into believing that the plaintiff would not act, or whether or not the defendant believed that the plaintiff would have grounds for action. See *A.C. Aukerman Co., 960 F.2d at 1042, 22 U.S.P.Q.2D (BNA) at 1336* ("reliance is not a requirement of laches but is essential to equitable estoppel"). Economic prejudice arises from investment in and development of the trademark, and the continued commercial use and economic promotion of a mark over a prolonged period adds weight to the evidence of prejudice. See *Hot Wax, Inc. v. Turtle Wax, Inc., 191 F.3d 813, 821, 52 U.S.P.Q.2D (BNA) 1065, 1072 (7th Cir. 1999)* (the longer the use and the lengthier the period of delay, the lighter the burden of showing economic prejudice in support of the defense of laches).

Bridgestone's evidence of undue delay and prejudice was uncontroverted by the Automobile [**11] Club. The Board's ruling rested on an erroneous interpretation of the law of laches, leading to an unreasonable exercise of judgment. Thus the

Board's rejection of the defense of laches was an abuse of discretion. That ruling is reversed.

B

The Automobile Club contends that laches is not an available defense to the § 2(a) ground of "false suggestion of a connection," because "false suggestion" involves the public interest in avoiding deception as to the origin or sponsorship of a product. However, the rights protected under the § 2(a) false suggestion provision are not designed primarily to protect the public, but to protect persons and institutions from exploitation of their persona. See *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc., 703 F.2d 1372, 1376, 217 U.S.P.Q. (BNA) 505, 508-09 (Fed. Cir. 1983)* ("It appears that the drafters sought by § 2(a) to embrace concepts of the right to privacy," even in the absence of likelihood of confusion.). This protection of rights of personal privacy and publicity distinguishes the § 2(a) false suggestion of connection provision from the § 2(d) likelihood of confusion provision. [**12] See generally *Opryland USA Inc. v. The Great American Music Show, Inc., 970 F.2d 847, 853, 23 U.S.P.Q.2D (BNA) 1471, 1475 (Fed. Cir. 1992)*; *Treadwell's Drifters, Inc. v. Marshak, 18 U.S.P.Q.2D (BNA) 1318, 1320-21 (TTAB 1991)*. Although the Automobile Club cites cases brought under § 2(d), whereby a continuing and inevitable likelihood of confusion led the court to permit tardy challenge to a registered mark, see *Ultra-White Co. v. Johnson Chem. Indus., Inc., 59 C.C.P.A. 1251, 465 F.2d 891, 893-94, 175 U.S.P.Q. (BNA) 166, 167 (CCPA 1972)*; *Chun King Corp. v. Genii Plant Line, Inc., 56 C.C.P.A. 740, 403 F.2d 274, 276, 159 U.S.P.Q. (BNA) 649, 651 (CCPA 1968)*, the

equitable defenses of laches and estoppel are not barred in § 2(a) false suggestion cases, absent misrepresentation or deceit. See, e.g., *Hot Wax, 191 F.3d at 827, 52 U.S.P.Q.2D (BNA) at 1074.* There was no evidence that Bridgestone's use of the LEMANS mark for tires entailed misrepresentation or that the public was deceived. Thus Bridgestone may avail itself of the defense of laches.

[*1364] C

The Automobile Club also argues that laches can not apply to its § 2(a) [**13] claim because Bridgestone's trademark use of LEMANS is a "continuing wrong" for which every use is a new injury. However, when the obligation arises to assert an objection to a trademark registration, that obligation is not postponed by continued use of the trademark. Indeed, as was observed in *Hot Wax, 191 F.3d at 821, 52 U.S.P.Q.2D (BNA) at 1069-70*, the notion of a "continuing wrong" is a strong justification for application of the doctrine of laches, for a party aggrieved by a trademark use could delay filing suit indefinitely, while prejudice to the trademark user increases.

We conclude that the theory of "continuing wrong" does not shelter the Automobile Club from the defense of laches.

Conclusion

The Automobile Club's cancellation petition is barred by laches. The decision of cancellation of Bridgestone's registration of LEMANS for tires is

REVERSED.

LEXSEE 240 F.3D 184

LARRY MARSHAK, Appellant v. FAYE TREADWELL; TREADWELL DRIFTERS, INC; THE DRIFTERS, INC.; BOWEN AGENCY LTD/ADMIRAL TALENT

No: 99-5614

UNITED STATES COURT OF APPEALS FOR THE THIRD CIRCUIT

240 F.3d 184; 2001 U.S. App. LEXIS 2211; 57 U.S.P.Q.2D (BNA) 1764

January 13, 2000, Argued
February 9, 2001, Filed

SUBSEQUENT HISTORY: Related proceeding at *Singer Mgmt. Consultants, Inc. v. Pinkney, 2007 TTAB LEXIS 28 (Trademark Trial & App. Bd., Feb. 9, 2007)*
Motion granted by, in part, Motion denied by, in part, Sanctions allowed by, Motion denied by *Marshak v. Treadwell, 2007 U.S. Dist. LEXIS 66622 (D.N.J., Sept. 7, 2007)*

PRIOR HISTORY: [**1] On Appeal from the United States District Court for the District of New Jersey. Dist. Ct. No. 95-cv-03794. District Court Judge: The Honorable Nicholas H. Politan.
Marshak v. Treadwell, 58 F. Supp. 2d 551, 1999 U.S. Dist. LEXIS 11930 (D.N.J., 1999)

COUNSEL: Stephen B. Judlowe, Esq. (argued), Lisa M. Ferri, Esq., Eve Kunen, Esq., Vincent A. Sireci, Esq., Hopgood, Calimafde, Kalil & Judlowe, LLP, New York, New York. Kenneth D. McPherson, Jr., Esq., Mark J. Ingber, Esq., Waters, McPherson, McNeill, Secaucus, New Jersey, Attorneys for Appellant.

James P. Flynn, Esq. (argued), Epstein Becker & Green, P.C., Newark, New Jersey. Joshua Levine, Law Office of Ira Levine, Fair Lawn, New Jersey, Attorneys for Appellees.

JUDGES: Before: ALITO and BARRY, Circuit Judges, and ALDISERT, Senior Circuit Judge.

OPINION BY: ALITO

OPINION

[*187] OPINION OF THE COURT

ALITO, *Circuit Judge:*

This is an appeal from orders entered by the District Court after a trial concerning the right to use the mark "The Drifters" for a singing group. Larry Marshak, who acquired a federally registered service mark for "The Drifters" name in 1978, brought this action against Faye Treadwell and others, claiming that they were infringing his mark. The defendants contended that Marshak's federally registered [**2] mark had been procured by fraud and that Marshak was infringing senior common-law rights. After a trial and post-trial motions, the District Court ordered that Marshak's federally registered mark be canceled, permanently enjoined Marshak from using the mark in commerce, and required an accounting of all profits received by Marshak since he began using the mark. Marshak then took this appeal. We affirm in part and dismiss in part for lack of appellate jurisdiction.

I.

The Drifters were one of the classic popular singing groups of the 1950s and early 1960s. Among their well-known hits were "Under the Boardwalk," "On Broadway," and "Save the Last Dance for Me."

The Drifters first appeared in 1953 and came under the management of George Treadwell the following year. From then until his death in 1967, George Treadwell managed the group through The Drifters, Inc., a New York corporation that he formed. George Treadwell hired and paid salaries to

the members of the group, who changed continually over the years. He also scheduled the group's performances, negotiated their recording contracts, and chose their music and arrangements.

[*188] In 1959, George Treadwell released all of the then-current [**3] members of the group and signed the former members of a group called the Five Crowns to perform as The Drifters. The new members included Charlie Thomas, Elsbeary Hobbs, and Dock Green. Like all other members of the Drifters, Thomas, Hobbs, and Green signed contracts that provided in pertinent part as follows:

> The Artist agrees that the name THE DRIFTERS belongs exclusively to the employer and that he will not at any time use the name of The Drifters or any name similar thereto or any name incorporating The Drifters. In the event the employee leaves the employ of The Drifters he will not in any way advertise or attempt to publicize the fact that he had been a member of a singing group known as The Drifters and will not associate his name in any manner with The Drifters; and he further acknowledges that the name, The Drifters, is a valuable property and any violation of this paragraph could not be adequately compensated by money damages and he therefore agrees that the employer shall be entitled to an injunction in any Court of competent jurisdiction to enjoin any violation or threatened violation of the contract by the Artist.

App. at 1264.

When George Treadwell died, [**4] his wife, Faye Treadwell, whom he married in 1955, became the sole shareholder of The Drifters, Inc., and she took over the management of the group. She later formed Treadwell's Drifters, Inc., a New Jersey corporation, and all of the assets and contractual rights of The Drifters, Inc. were transferred to the new corporation.

By the time of George Treadwell's death, Hobbs and Green had already left the group. Charlie Thomas left shortly thereafter, but other members continued to perform under Treadwell's direction. By the late 1960s, however, the popularity of "The Drifters" and similar groups had waned in this country, and Treadwell focused her efforts on Europe, where the group remained popular. After 1970, the Drifters made few live appearances in this country, but the group's classic recordings continued to be played on the radio, and Atlantic Records continued to pay royalties to The Drifters, Inc. or Treadwell's Drifters, Inc. *See* App. at 720.

Larry Marshak's involvement with The Drifters began in 1969. CBS radio had recently changed from a contemporary to an "oldies" format. To generate enthusiasm for its format change, CBS approached *Rock* Magazine and proposed a partnership [**5] to reunite old singing groups to perform live concerts. Marshak, who was an editor at *Rock* Magazine, was given the task of reuniting some of these groups for the first revival concert at the New York Academy of Music. Among the groups that Marshak attempted to reunite was "The Drifters." Marshak contacted

several former members of the group,° including Thomas, Hobbs, and Green, all of whom agreed to perform for Marshak. The revival concerts were a success, and the reunited members agreed to continue performing under "The Drifters" name. In 1972, Thomas, Hobbs, and Green signed an exclusive management contract with Marshak.

Soon after the revival group began performing, Marshak received a letter from Treadwell's attorney asserting that Marshak was infringing her right to use the group's name. App. at 244. The letter pointed out that the former members of the group had signed contracts with The Drifters, Inc. in which they had given up any right to use the group name. *Id.* Despite this warning, Marshak persisted in his efforts to promote and market his group.

In 1971, Treadwell brought an action against Marshak in state court in New York. Treadwell's request for a preliminary [**6] injunction to prevent Marshak and his group from using "The Drifters" name was denied, and the suit was eventually [*189] dismissed in 1973 because Treadwell "willfully defaulted and failed to answer interrogatories propounded by defendants." App. at 1245. At the trial in the current case, Treadwell testified that she and her group stopped performing in the United States in part because she did not have the financial resources to defend her mark against Marshak through extended litigation. *See* App. at 598.

Marshak, in contrast, benefitted from a renewed interest in "The Drifters" in the United States that had resulted from a wave of nostalgia for the early days of rock and roll. Throughout the 1970s,

Marshak's group made recordings, appeared on television, and gave live performances.

Marshak began to litigate against other groups that used the name "The Drifters" or a variant. In 1976, Marshak learned that "The Platters," another revived 1950s singing group, had been successful in preventing others from using their name by registering their service mark, and Marshak urged Thomas, Hobbs, and Green to do the same. Marshak convinced the trio that if they agreed to assign their rights to [**7] the name to him, he would continue as their manager and prevent others groups from using "The Drifters" name. In December 1976, Thomas, Hobbs, and Green, acting as a partnership, filed an application with the United States Patent & Trademark Office (PTO) to register "The Drifters" as a service mark for a singing group, and they assigned their rights to Marshak. *See* App. at 1267. In their registration application, Thomas, Hobbs, and Green each attested that

> no other person, firm, corporation, or association, to the best of his knowledge and belief, has the right to use such mark in commerce either in the identical form thereof or in such near resemblance thereto as to be likely, when applied to the goods of such other person, to cause confusion, or to cause mistake, or deceive.

See 15 U.S.C. § 1051 (1976).

Marshak filed the present action in 1995, following the publication of Faye Treadwell's book, *Save the Last Dance for Me*, in which Treadwell

claimed to be the sole owner of the Drifters mark. *See* App. at 875. Named as defendants were Faye Treadwell, The Drifters, Inc., Treadwell's Drifters, Inc., and a booking company. Marshak [**8] alleged that the defendants had infringed his mark and had threatened to continue to do so by offering Treadwell's book for sale and by engaging a group to perform as The Drifters. He asserted a claim under Section 32 of the Lanham Act, *15 U.S.C. § 1114(a)*, for infringement of his federally registered mark, as well as a claim under Section 43(a), *15 U.S.C. § 1125(a)*, and under the statutes of New York for violation of his common-law rights. He sought declaratory and injunctive relief and treble and punitive damages.

In their answer, the defendants claimed that Treadwell's Drifters had a superior common-law right to the mark, and they asserted as an affirmative defense that Marshak's federal registration had been procured by fraud. As a counterclaim, Treadwell's Drifters repeated the allegation of fraudulent procurement. In addition, alleging that Marshak had infringed and continued to infringe its common-law right to the mark, Treadwell's Drifters asserted a claim under Section 43(a) of the Lanham Act and a state-law claim for unfair competition. The counterclaim sought, among other things, cancellation of Marshak's mark, declaratory [**9] and injunctive relief, and an accounting of Marshak's profits.

The case was tried before a jury, which found that Marshak or his assignors had perpetrated a fraud on the PTO in 1976. *See* App. at 1562. In accordance with this finding, the District Court ordered the PTO to cancel Marshak's federal

registration. The jury also found, however, that Treadwell and her corporation had abandoned their common-law right to "The Drifters" mark by 1976. Moreover, the [*190] jury found that Marshak had established protectable common-law rights in the name by that time.

On cross post-trial motions, the District Court upheld the jury's verdict regarding Marshak's fraud on the PTO, but the Court vacated the jury verdict insofar as it found that Treadwell had abandoned her rights in 1976. Instead, the Court held that the continuous stream of royalty revenues collected by Treadwell since the 1960s was sufficient to defeat Marshak's claim of abandonment. *See Marshak v. Treadwell, 58 F. Supp. 2d 551 (D.N.J. 1999)*. After additional briefing regarding appropriate remedies, the Court molded the judgment to reflect that Marshak had infringed Treadwell's Drifters' common law rights. The Court [**10] then permanently enjoined Marshak from further use of the "The Drifters" mark in commerce and ordered an accounting of Marshak's profits for the entire period of his infringement -- *viz.*, from 1970 to 1998. Marshak appealed.

II.

We begin by examining our jurisdiction to review the various orders challenged on appeal. Under *28 U.S.C. § 1292(a)(1)*, we plainly have jurisdiction to review the permanent injunction prohibiting Marshak from using The Drifters mark. Under *Santana Products, Inc. v. Compression Polymers, Inc., 8 F.3d 152 (3d Cir. 1993)*, the order requiring cancellation of Marshak's federally registered mark, standing alone, is not appealable under *§ 1292(a)(1)*,

but *Santana Products* did not reach the question whether an order of cancellation may be reviewed pursuant to *§ 1292(a)(1)* when a district court also issues an injunction against the use of the mark, as occurred here. *8 F.3d at 155* & n.3.

When we have jurisdiction to review an order relating to an injunction under *§ 1292(a)(1)*, our jurisdiction extends to matters inextricably linked to the appealable order. *See S.E.C. v. Black, 163 F.3d 188, 194 (3d Cir. 1998).* [**11] In this case, the ground on which cancellation of the federally registered mark was ordered -- fraud on the PTO -- was also asserted by Treadwell as a defense to Marshak's claim that she was infringing his incontestable mark. All of the arguments raised by Marshak on appeal in connection with the cancellation order apply as well to that defense. Under these circumstances, the link between the order of cancellation and the injunctive order is close enough to permit review of the order of cancellation at this time. *See Wrist-Rocket Mfg. Co. v. Saunders Archery Co., 516 F.2d 846, 849 (8th Cir. 1975)* (court has jurisdiction under *28 U.S.C. § 1292(a)(1)*, to examine the merits of order granting a permanent injunction and ordering the cancellation of registration).

By contrast, we lack jurisdiction to review the portion of the District Court order requiring an accounting of Marshak's profits. Marshak contends that we have jurisdiction under the final order rule of *28 U.S.C. § 1291*, but we do not agree. A final order is one that "leaves nothing for the court to do but execute the judgment." *Catlin v. United States, 324 U.S. 229, 233, 89 L. Ed. 911, 65 S. Ct. 631 (1945).* [**12] A finding of liability that does not also

specify damages is not a final decision. *See, e.g., Liberty Mut. Ins. Co. v. Wetzel, 424 U.S. 737, 744, 47 L. Ed. 2d 435, 96 S. Ct. 1202 (1976)*; *Sun Shipbldg. & Dry Dock Co. v. Benefits Rev. Bd., 535 F.2d 758, 760 (3d Cir. 1976)*. Although the practical finality rule, also known as the *Forgay-Conrad* doctrine, permits appellate review of an order that is not technically final but resolves all issues that are not purely ministerial, *see Forgay v. Conrad, 47 U.S. (6 How.) 201, 204-05, 12 L. Ed. 404 (1848)*; *Cromaglass Corp. v. Ferm, 500 F.2d 601, 605 (3d Cir. 1974)* (en banc), the accounting at issue in this case does not come within that rule.

Our decision in *Apex Fountain Sales, Inc. v. Kleinfeld, 27 F.3d 931 (3d Cir. 1994)*, [*191] a trademark infringement case, is apposite. In *Apex Fountain Sales*, the District Court entered a contempt order that, among other things, ordered an accounting of the net profits realized from sale of the infringing items. We held that the order was not reviewable under the *Forgay Conrad* doctrine because the determination of net [**13] profits would not be easily reached. *See id. at 936*.

In *Goodman v. Lee, 988 F.2d 619 (5th Cir. 1993)*, the Fifth Circuit addressed circumstances similar to those with which we are confronted. In that case, Shirley Goodman sued the heirs of her former recording partner, Audrey Lee, for copyright ownership rights to their 1956 hit song, "Let the Good Times Roll." The jury found in favor of Goodman, and the District Court ordered the registrar of copyrights to correct the records of the copyright office to reflect Goodman's ownership. Furthermore, the Court ordered Lee's heirs to account to Goodman for one-half of all royalties paid

over the 29-year period between the time of the song's release and the date of the judgment. The District Court did not reduce the award to a certain sum.

On appeal, the Fifth Circuit acknowledged a line of cases in which appeal had been permitted prior to a final accounting because the accounting was viewed as "purely 'ministerial' and/or 'mechanical.'" *Id. at 626* (citing *Winston Network v. Indiana Harbor Belt R. Co., 944 F.2d 1351 (7th Cir. 1991)*; *Parks v. Pavkovic, 753 F.2d 1397 (7th Cir. 1985)*). [**14] However, the *Goodman* Court concluded that the accounting in the case before it would not be purely ministerial:

> The award contemplates identifying royalties paid on one particular song to songwriter now dead and thereafter to his heirs over an almost thirty (30) year period. . . . Clearly, the amount to be divided is not known, was not identified in the extensive district court experience and must be reconstructed requiring factual determinations by the district court.

988 F.2d at 627. Therefore, the Court held that the judgment was not within the *Forgay-Conrad* rule and was not an appealable final order. *Id.*

A similar result was reached in *Zwack v. Kraus Bros & Co., 237 F.2d 255 (2d Cir. 1956)*. There, a Hungarian firm sought injunctive relief against its United States distributor to enforce its trademark, as well as damages and an accounting of profits. The

District Court held the distributor liable but referred the matter to a special master for an accounting of profits. The Second Circuit held that the reference to the special master to determine damages rendered the entire order interlocutory. *See id. at 261.*

In this [**15] case, as in the cases noted above, the accounting cannot reasonably be characterized as merely ministerial. The District Court ordered Marshak "to account to Treadwell for the profits he earned in each year, beginning with the first act of infringement in 1970 and ending with the first day of trial testimony in this case." App. at 87. As in *Apex Fountain Sales,* the parties here have a long history of contentious litigation, and there is a substantial likelihood that "one or both parties will dispute the ultimate amount of damages awarded, leading to a second appeal. This would be contrary to the federal judiciary's general policy against piecemeal litigation." *Apex Fountain Sales, 27 F.3d at 935.*

We are aware that the District Court, in denying Treadwell's request that a special master be appointed, expressed the opinion that "the accounting will not be complicated or exceptional," App. at 1687 n.2, but that statement was made in a notably different context. An accounting may seem simple enough to persuade a District Court that the appointment of a special master is not necessary and still be far from ministerial in the sense relevant here. We must therefore dismiss [**16] Marshak's appeal insofar as it contests the portion of [*192] the district court order requiring an accounting. [1]

1 We are thus unable to express our view as to whether any accounting should have been

> limited to the period of the appropriate statute of limitations. If on remand the District Court goes forward with the accounting, consideration of the propriety of that remedy will have to await the completion of the accounting and the entry of a final order. We recognize that this procedure may result in a considerable waste of time and resources in connection with the accounting, but the scope of our appellate jurisdiction leaves no alternative.

III.

Turning to the merits of the issues over which we have jurisdiction, we first consider Marshak's arguments relating to Treadwell's fraudulent procurement defense and counterclaim.

A.

Marshak argues that the fraudulent procurement defense and counterclaim are time-barred. Relying chiefly on our decision in *Beauty Time, Inc. v. VU Skin Sys., Inc., 118 F.3d 140, 143 (3d Cir. 1997)*, [**17] Marshak maintains that the Lanham Act does not specify the time within which a claim of fraudulent procurement may be asserted, that it is therefore appropriate to borrow the most analogous state statute of limitations, and that under the most analogous state statute -- either the New York or the New Jersey six-year statute of limitations for actions sounding in fraud -- Treadwell's claim is barred. We reject this argument based on the plain language of the Lanham Act.

Treadwell's counterclaim was brought under Section 14 of the Lanham Act, *15 U.S.C. § 1064*,

which specifies in detail the time limits for petitioning to cancel a mark on various grounds. This provision states in relevant part:

> *A petition to cancel a registration of a mark,* stating the grounds relied upon, *may,* upon payment of the prescribed fee, *be filed as follows* by any person who believes that he is or will be damaged . . . by the registration of a mark on the principal register established by this chapter . . .
>
> * * *
>
> (1) Within five years from the date of the registration of the mark under this chapter.
>
> (2) Within five years from the date of publication [**18] under section 1062(c) of this title of a mark registered under the Act of March 3, 1881, or the Act of February 20, 1905.
>
> (3) ***At any time*** *if* the registered mark becomes the generic name for the goods or services, or a portion thereof, for which it is registered, or has been abandoned, or its *registration was obtained fraudulently* or contrary to the provisions of section 1054 of this title or of subsection (a), (b), or (c) of section 1052 of this

> title for a registration under this chapter.

Lanham Act § 14, *15 U.S.C. § 1064* (emphasis added).

The first step in interpreting a statute is to determine "whether the language at issue has a plain and unambiguous meaning with regard to the particular dispute in the case." *Robinson v. Shell Oil Co., 519 U.S. 337, 340, 136 L. Ed. 2d 808, 117 S. Ct. 843 (1997). See also, e.g., Michael C. v. Radnor Township Sch. Dist., 202 F.3d 642, 648-49 (3d Cir. 2000); Deane v. Pocono Med. Ctr., 142 F.3d 138, 146 (3d Cir. 1998)* (en banc). "The plainness or ambiguity of statutory language is determined by reference to the language itself, the specific [**19] context in which that language is used, and the broader context of the statute as a whole." *Robinson, 519 U.S. at 341.* Where we find that the statutory language has a clear meaning, we need not look further. *Id. at 340.*

Here, the meaning of the phrase "at any time" in Section 14 (3) is clear even if that [*193] particular subsection is viewed in isolation. Moreover, the contrast between the five-year time limits imposed in subsections (1) and (2) and the use of the phrase "at any time" in subsection (3) reinforces the point that the language of subsection (3) means what it says: a petition falling within subsection (3), including a petition seeking cancellation based on fraud, is not subject to any time limit but may be filed "at any time." We note that the Supreme Court has recognized that the predecessor of the current

Section 14(3) "allows cancellation of an incontestable mark at any time . . . *if it was obtained fraudulently.*" *Park 'n Fly, Inc. v. Dollar Park and Fly, Inc., 469 U.S. 189, 195, 83 L. Ed. 2d 582, 105 S. Ct. 658 (1985)* (emphasis added). [2]

> 2 We also note that the PTO has consistently held that the phrase "at any time" precludes a laches defense to a cancellation action premised on fraudulent procurement. *See Harjo v. Pro Football, Inc., 1994 TTAB LEXIS 9, 30 U.S.P.Q.2D (BNA) 1828, 1831 (T.T.A.B. 1994)*; *TBC Corp. v. Grand Prix Ltd., 1989 TTAB LEXIS 22, 12 U.S.P.Q.2D (BNA) 1311, 1313 (T.T.A.B. 1989)*; *Bausch & Lomb, Inc. v. Leupold & Stevens, Inc., 1 U.S.P.Q.2D (BNA) 1497, 1499-1500 (T.T.A.B. 1986)*.

[**20] We recognize that Section 14(3) itself applies to a petition filed with the Patent and Trademark Office, rather than a claim asserted in court, but Section 37 of the Lanham Act, *15 U.S.C. § 1119*, [3] gives federal courts concurrent authority to cancel registered marks when the validity of the mark is called into question in a judicial proceeding. *See Ditri v. Coldwell Banker Residential Affiliates, Inc., 954 F.2d 869, 873 (3d Cir. 1992)*; *Simmonds Aerocessories, Ltd. v. Elastic Stop Nut Corp., 257 F.2d 485, 491 (3d Cir. 1958)*. As we explained in *Ditri*, "Although a petition to the Patent and Trademarks Office is the primary means of securing a cancellation, the district court has concurrent power to order cancellation as well for the obvious reason that an entire controversy may thus be expediently resolved in one forum." *954 F.2d at 873*. We see no reason why Congress would have wanted

to allow a petition for cancellation under Section 14(3) to be filed with the PTO "at any time" but to subject an identical request, when entertained by a District Court pursuant to its concurrent power under Section 37, to a state statute [**21] of limitations. Such a regime would prevent a case like the one before us from being "expediently resolved in one forum." *Id.*

3 Section 37 provides:

> In any action involving a registered mark the court may determine the right to registration, order the cancellation of registrations, and otherwise rectify the register with respect to the registrations of any party to the action. Decrees and orders shall be certified by the court to the Director, who shall make appropriate entry upon the records of the Patent and Trademark Office, and shall be controlled thereby.

15 U.S.C. § 1119.

The language of the Lanham Act also makes it clear that there is no time limit on the assertion of fraudulent procurement as a defense to an infringement claim brought by the holder of a mark that has become incontestable. Under Section 15 of the Lanham Act, *15 U.S.C. § 1065*, an otherwise incontestable mark may be attacked "on a ground for which application to cancel [**22] may be filed at

any time under paragraphs (3) and (5) of *section 1064* of this title." Accordingly, the language of the Lanham Act makes it clear that a claim for cancellation of a mark based on fraudulent procurement and a defense to an otherwise incontestable mark on a similar ground may be asserted at any time. [4]

4 The origins of the "at any time" language of Section 14(3) support this conclusion. This language derives from Section 13 of the Trademark Act of 1905, 15 U.S.C. § 93. That section provided that "whenever any person shall deem himself injured by the registration of a trade-mark in the Patent Office he may *at any time* apply to the Commissioner of Patents to cancel the registration." (emphasis added). The accepted meaning of the phrase "at any time" under the 1905 Act was that it excluded the defense of laches in a cancellation proceeding. See *Dwinell-Wright Co. v. National Fruit Prod. Co., 129 F.2d 848, 853 (1st Cir. 1942)*; *White House Milk Prods. Co. v. Dwinell-Wright Co., 27 C.C.P.A. 1194, 111 F.2d 490, 493 (C.C.P.A. 1940)*; *Cluett, Peabody & Co. v. Hartogensis, 17 C.C.P.A. 1166, 41 F.2d 94, 97 (C.C.P.A. 1930)*. The language in the 1905 Act, in turn, was derived from a line of Supreme Court precedent holding that laches would not bar an injunction against future infringement, but only an accounting for past profits. *See Saxlehner v. Eisner & Mendelson Co., 179 U.S. 19, 45 L. Ed. 60, 21 S. Ct. 7 (1900)*; *Menendez v. Holt, 128 U.S. 514, 32 L. Ed. 526, 9 S. Ct. 143 (1888)*; *McLean v. Fleming, 96 U.S. (6 Otto.)*

> *245, 24 L. Ed. 828 (1877).* It is telling that although the Lanham Act now specifically provides that an infringement action is subject to equitable defenses, *see 15 U.S.C. § 1125*, the statute continues to provide that a mark is vulnerable to a cancellation proceeding "at any time."

[**23] [*194] The reason for this rule is quite simple--the interest vindicated by Section 14 is not just the injury to the challenging party, but the integrity of the register. Where the interest at issue is the integrity of the federal register, a statute of limitations should not operate to frustrate that interest. *See Harjo v. Pro Football, Inc., 1994 TTAB LEXIS 9, 30 U.S.P.Q.2D (BNA) 1828, 1831 (T.T.A.B. 1994)* ("The Board has held that the equitable defenses of laches and estoppel are not available against claims of fraud and abandonment because there exists a broader interest--a 'public policy' interest--in addition to a private interest in removing from the register those registrations procured or maintained by fraud and those registrations for marks that have been abandoned."); *TBC Corp. v. Grand Prix Ltd., 1989 TTAB LEXIS 22, 12 U.S.P.Q.2D (BNA) 1311, 1313 (T.T.A.B. 1989)* ("Where the proposed ground for cancellation is abandonment, equitable defenses should be unavailable for the same reason they have been held unavailable when the ground asserted is descriptiveness or fraud. It is in the public interest to remove abandoned registrations from the register. We therefore [**24] hold that the prior registration defense is unavailable in a proceeding where the issue is abandonment."). Accordingly, we hold that

Treadwell's fraudulent procurement defense and counterclaim were not time-barred.

Marshak's only attempt to address the language of the Lanham Act permitting fraudulent procurement to be asserted in these contexts "at any time" appears in his reply brief, where he argues that this language merely reflects the fact that the grounds for cancellation covered by Section 14(3), such as a mark's becoming generic, "are of a type in which the *right* to bring cancellation may arise 'at any time', i.e., some years (very possibly more that the five years of *Section 1064(1)*) after trademark registration." Reply Br. at 4 (emphasis in original). Marshak suggests that once a plaintiff has become aware of the necessary predicate for bringing a cancellation proceeding, the plaintiff should be required to do so within the limitations period specified by the most analogous state statute.

Marshak's argument cannot be reconciled with the plain language of Section 14(3), which, as noted, provides unambiguously that a petition seeking cancellation based on fraudulent procurement [**25] "may . . . be filed" "at any time." Marshak would read Section 14(3) as essentially a tolling provision, but the drafters of this provision would surely have selected different language if that is what they had intended. For all these reasons, we hold that Treadwell's counterclaim and defense are not time-barred.

This holding is entirely consistent with our decision in *Beauty Time*, on which Marshak relies. In *Beauty Time*, count XI of the complaint asserted a claim under Section 38 of the Lanham Act, *15 U.S.C. § 1120*, which provides as follows:

> Any person who shall procure registration in the Patent and Trademark Office of a mark by a false or fraudulent declaration or representation, oral or in writing, or by any false means, shall be liable in a civil action by any person injured thereby for any damages sustained in consequence thereof.

A claim for damages brought under Section 38 is not governed by any of the time limits set out in Section 14(3) or any other [*195] provision of the Act specifying a limitations period, and therefore we held that the plaintiff's Section 38 claim for fraud was subject to Pennsylvania's two-year statute of limitations [**26] for actions based on fraud. *118 F.3d at 143-49*. We did not mention Section 14(3) or suggest that a request for cancellation pursuant to that section is subject to a state statute of limitations. Thus, *Beauty Time* does not support Marshak's argument here. [5]

> 5 Marshak also relies (see Appellant's Br. at 33, Reply Br. at 2) on the statement in 5 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 31:59, at 31-108 (4th ed. 2000), that "when fraud is used as a basis for challenging the validity of an incontestable registration, the claim must be asserted within the relevant statute of limitations." On its face, this statement supports Marshak's argument, but we decline to follow it in the particular context here, i.e., where Section 14(3) applies.

> The treatise does not attempt to explain how this sweeping statement can be reconciled with the language of Section 14(3), and elsewhere the treatise recognizes that a request to cancel based on fraud may be filed at any time. 5 McCarthy, *supra*, § 31:80. Furthermore, the authority cited by the treatise in support of this statement, *Calzaturificio Rangoni S.p.A. v. United States Shoe Corp., 868 F. Supp. 1414 (S.D.N.Y 1994)*, is unconvincing. Borrowing a state statute of limitations, the District Court in that case relied solely on a prior District Court decision that had applied a state statute to a false advertising claim brought under Section 43(a) of the Lanham Act. *See 868 F. Supp. at 1420* (relying on *PepsiCo., Inc. v. Dunlop Tire & Rubber Corp., 578 F. Supp. 196, 198 (S.D.N.Y. 1984)*). A false advertising claim under Section 43(a), however, is quite different from a request for cancellation under Section 14(3). Assuming that it is appropriate to apply a state statute to such a Section 43(a) claim, it does not follow that all other Lanham Act claims or defenses relating to fraud must be treated similarly even if the language of the Act expressly addresses the question of the time within which those claims or defense may be asserted.

[**27] B.

Marshak argues that Treadwell's fraudulent procurement defense and counterclaim were barred by principles of collateral estoppel. In the District Court, Marshak relied on several prior adjudications, but on appeal he focuses on *Marshak v. Sheppard, 666 F. Supp. 590 (S.D.N.Y. 1987)*, a

Lanham Act action brought by Marshak against, among others, a performer who appeared with a group called "Rick Sheppard and the Drifters." [6] In that case, Sheppard unsuccessfully sought cancellation of Marshak's registered mark on grounds very similar to those asserted by Treadwell in this case, and Marshak contends that Treadwell is bound by the judgment in that case. Marshak acknowledges that Treadwell was not a party in *Marshak v. Sheppard*, but he maintains that she is bound on the ground that she wielded a "laboring oar" on behalf of the defendants. Appellant's Br. at 49.

> 6 The section of Marshak's brief concerning collateral estoppel (Appellant's Br. at 48-49) does not refer to the dismissal of Treadwell's 1971 action in New York state court. As noted, that case was dismissed because Treadwell did not comply with discovery. The District Court held that, under New York law, such a dismissal was without prejudice. *See Marshak, 58 F. Supp. 2d at 562 n.17* (citing *Maitland v. Trojan Elec. & Mach. Co., 65 N.Y.2d 614, 480 N.E.2d 736, 737, 491 N.Y.S.2d 147 (N.Y. 1985))*. Because Marshak does not rely on this dismissal as a basis for his collateral estoppel argument, we need not consider that issue here.

[**28] The principle on which Marshak relies is aptly stated as follows in the *Restatement (Second) of Judgments § 39*:

> A person who is not a party to an action but who controls or substantially

> participates in the control of the presentation on behalf of a party is bound by the determination of issues decided as though he were a party.

Comment c. adds:

> To have control of litigation requires that a person have effective choice as to the legal theories and proofs to be advanced in behalf of the party to the action. He must also have control over the opportunity to obtain review.

[*196] Cf. *Collins v. E.I. DuPont de Nemours & Co., 34 F.3d 172, 176 (3d Cir. 1994)* (New Jersey law).

Here, Marshak has not pointed to any direct evidence that Treadwell exercised any control over the prior litigation. Indeed, his brief notes only two concrete facts that are relevant: Treadwell testified in the prior case and had an interest in the outcome (in the sense that she would have benefitted if Marshak's federally registered mark had been ordered canceled). Appellant's Br. at 49. Without more, these facts are plainly insufficient to permit a reasonable inference [**29] that she exercised any control over litigation decisions or strategy. Marshak's collateral estoppel argument must therefore be rejected.

C.

Marshak contends that the jury's finding of fraud was based on an erroneous jury instruction, which

stated that fraud on the PTO could be shown by proof that the applicants "should have known" about Treadwell's superior right to "The Drifters" name. Although we agree with Marshak that this instruction was erroneous, we are convinced that the error was harmless.

Most of the District Court's lengthy instruction on fraudulent intent is unobjectionable, [7] but at several points, the Court told the jury that "the defense of fraud will turn upon whether you believe that the persons who registered the mark knew or reasonably *should have known* that someone else had legal rights to the name The Drifters.'" App. at 1482-83 (emphasis added). Marshak objects that the "should have known" language misstates the nature of the PTO oath and the requisite measure of proof.

> 7 Much of the charge is set forth in the District Court's opinion. *See Marshak, 58 F. Supp. 2d at 566-67.*

[**30] At the time when Thomas, Hobbs, and Green submitted their declaration, an applicant was required to state that

> no other person, firm, corporation, or association, *to the best of his knowledge and belief,* has the right to use such mark in commerce either in the identical form thereof or in such near resemblance thereto as to be likely, when applied to the goods of such other person, to cause confusion, or to cause mistake, or deceive.

15 U.S.C. § 1051 (1976) (emphasis added). Thus, applicants attested only to their own subjective knowledge and belief.

To demonstrate that a federal registration was fraudulently procured, therefore, a challenging party must adduce evidence that the registrant actually knew or believed that someone else had a right to the mark. *See Metro Traffic Control, Inc. v. Shadow Network Inc., 104 F.3d 336, 340 (Fed. Cir. 1997)*; *see also* 5 McCarthy *supra*, § 31:76. Accordingly the instruction given by the District Court was not entirely correct. [8]

8 In support of its instruction, the District Court relied on *G.H. Mumm & CIE v. Desnoes & Geddes, Ltd., 917 F.2d 1292, 1296 (Fed. Cir. 1990)*, and *Torres v. Cantine Torresella S.r.l, 808 F.2d 46, 49 (Fed. Cir. 1986)*. In both of those cases, the Court stated that an applicant knowingly attempts to mislead the PTO if the applicant files a renewal application stating that its mark is currently in use in interstate commerce but the applicant "knows or should know" that this is not true. Neither case involved a jury instruction, and we do not interpret those cases as taking the position that proof of subjective bad faith is unnecessary in order to prove fraud on the PTO. On the contrary, *Torres* emphasizes that an applicant must act "knowingly" in order to commit such a fraud. *808 F.2d at 48*. We understand these opinions to mean simply that in the particular context presented there -- where the representation related to a matter about which the applicant almost certainly had subjective

knowledge, i.e., whether the applicant's own company was using the mark in commerce -- proof that the applicant should have known was ample to prove actual knowledge. We note that the Federal Circuit has subsequently held that proof of actual knowledge or belief is necessary in the context of fraudulent procurement. *See Metro Traffic Control, 104 F.3d at 340.* We also note that even Treadwell's brief seems to give *G.H. Mumm* and *Torres* a similarly narrow interpretation. See Appellee's Br. at 48-49 & n. 12.

[**31] [*197]

The error, however, was harmless because "'it is highly probable that [it] did not affect the outcome of the case.'" *West v. Philadelphia Elec. Co., 45 F.3d 744, 752 (3d Cir. 1995).* The "should have known" language used by the District Court could have affected the verdict only if a properly instructed jury would have found that the applicants had an actual but unreasonable belief that no one else had a right to use "The Drifters" name. However, based on the evidence in this case, we are convinced that a properly instructed jury would not have made such a finding. Marshak has not called to our attention any appreciable evidence that the applicants had a sincere belief that no one else had a right to the mark, and there was very strong evidence to the contrary. Marshak's cross-examination, in which excerpts of Thomas' deposition were read, essentially produced the admission that George Treadwell had been "the true owner of the Drifters' name," that George Treadwell "had rights to the name," and that Thomas had simply been "an employee." App. 470. Similarly, when Marshak was asked whether a

member of "The Drifters" during the George Treadwell era "would have had [**32] the right to use the name Drifters," Marshak responded that "the only person who has the right to the name is the person that develops it and keeps it in the public's eye." App. 510. Marshak also testified that a member of "The Drifters" was simply an "employee" and that an employee of a group that provides entertainment cannot "go around saying he is [the group]." *See* App. 1662. In view of the evidence, we are convinced that the mistake in the jury instruction was harmless.

D.

Marshak's final argument concerning fraudulent procurement is that there was insufficient evidence to support the jury's finding. The jury's verdict must be sustained if it is rationally supported, *see Starceski v. Westinghouse Elec. Corp., 54 F.3d 1089, 1098 (3d Cir. 1995)*, and the verdict here has ample support. In addition to the direct evidence just mentioned regarding the applicants' and Marshak's subjective knowledge and belief, there was substantial circumstantial evidence from which such knowledge or belief could be inferred. As noted, the applicants had signed contracts acknowledging that the name "The Drifters" belonged exclusively to their employer and that they had no right [**33] to that name. Under those contracts, if they left the group, they could not even publicize the fact that they had been members.

In arguing that the evidence was insufficient, Marshak relies on the 1971 ruling of the New York state court denying Treadwell's request for a preliminary injunction and opining that Treadwell had not established that Marshak or the members of

his group "had been infringing upon [her] good name and good will." App. 724. This was certainly evidence for the jury to consider, but it is insufficient to overturn the jury's verdict. [9] We thus hold that fraud in the procurement of the federal mark was properly proven and that cancellation was justified.

> 9 The evidence regarding the 1971 state court ruling does not undermine our conclusion that the error in the jury instruction discussed in part III.C, *supra,* was harmless. The jury instruction error related to the question of subjective knowledge or belief, but the evidence concerning the 1971 state court ruling is evidence of objective reasonableness, not the applicants' subjective state of mind. As the District Court noted, "Marshak has cited no testimony or other evidence that he or his assignors subjectively believed that the dismissal of Treadwell's 1971 lawsuit constituted a final adjudication of their trademark rights," *58 F. Supp. 2d at 562,* and thus established that Treadwell had no right to the use of "The Drifters" name.

[**34] IV.

We now consider Marshak's arguments relating to Treadwell's claim that [*198] Marshak was infringing upon her superior common-law right. As previously noted, the counterclaim of Treadwell's Drifters asserted a claim under Section 43(a) of the Lanham Act, *15 U.S.C. § 1125(a),* based on Marshak's alleged infringement of their common law right to "The Drifters" mark. In order to prove this claim, the counterclaimant was required to show

that "(1) the mark [was] valid and legally protectable; (2) the mark [was] owned by the plaintiff; and (3) [Marshak's] use of the mark to identify goods or services [was] likely to create confusion concerning the origin of the goods or services." *Fisons Horticulture, Inc. v. Vigoro Indus., Inc., 30 F.3d 466, 472 (3d Cir. 1994).* The jury did not find that the counterclaimant had established these elements. On the contrary, the jury found that Treadwell and her companies had abandoned their common law rights and that Marshak had not used "The Drifters" name in such a way as to misrepresent the source of his goods or services or to falsely suggest a connection between those services and Treadwell's Drifters. [**35] App. at 1562. The District Court, however, explicitly granted judgment as a matter of law in favor of the counterclaimant on the issue of abandonment and, in effect, did the same thing with respect to the entire Section 43(a) counterclaim. On appeal, Marshak challenges this disposition on several grounds.

A.

Marshak contends that the District Court erred in entering judgment as a matter of law against him on the issue of abandonment. [10] We do not agree.

10 Even if the jury had sustained Marshak's federal registration, it would still be necessary to consider the question of abandonment. Even if a junior user's mark has attained incontestable status, such status does not cut off the rights of a senior user. *See Natural Footware Ltd. v. Hart, Schaffner & Marx, 760 F.2d 1383, 1395 (3d Cir. 1985)* ("[A] federal registrant is still subject to the defense of a

prior user of the mark who has established a market in specific areas notwithstanding that senior user's failure to register."); *see also 815 Tonawanda Street Corp. v. Fay's Drug Co., 842 F.2d 643, 646 (2d Cir. 1988)* ("The plain meaning of the *§ 1065* exception is that if a party has acquired common-law trademark rights continuing since before the publication of the federal registration, then to that extent the registration will not be incontestable.") (citations omitted)); *Cuban Cigar Brands N.V. v. Upmann Int'l, Inc., 457 F. Supp. 1090, 1100 (S.D.N.Y. 1978)* ("Defendant's marks are not incontestable as against that of plaintiff for, since defendant's use infringes plaintiff's valid common law rights obtained long prior to defendant's registration, it has no shield of incontestability in a suit by plaintiff to enforce that mark."). Since Marshak has used "The Drifters" continuously since 1970, his ability to enjoin Treadwell's use depends on whether she abandoned the mark.

[**36]

Section 45 of the Lanham Act, *15 U.S.C. § 1127*, provides that "[a] mark shall be deemed abandoned . . . when its use has been discontinued with intent not to resume use." "To establish the defense of abandonment it is necessary to show not only acts indicating a practical abandonment, but an actual intent to abandon." *Saxlehner v. Eisner & Mendelson Co., 179 U.S. 19, 31, 45 L. Ed. 60, 21 S. Ct. 7 (1900).* "Intent not to resume may be inferred from circumstances," *15 U.S.C. § 1127*, but "abandonment, being in the nature of a forfeiture, must be strictly proved." *United States Jaycees v.*

Philadelphia Jaycees, 639 F.2d 134, 139 (3d Cir. 1981).

Thus, in order to show that there was an abandonment of the common law rights originally acquired by George Treadwell and The Drifters, Inc., Marshak bore the burden of "strickly" proving (a) that use of The Drifters mark had been discontinued in the United States [11] and (b) that the owner of the common law rights had the actual intent to abandon the mark. Marshak could have established a prima facie case of abandonment, however, by proving nonuse in this country [**37] for two [*199] consecutive years. Lanham Act § 45, *15 U.S.C. 1127 (1994).* [12]

11 For purposes of trademark rights in the United States, "use" means use in the United States, not in other nations. *See Rivard v. Linville, 133 F.3d 1446, 1448-49 (Fed. Cir. 1998).*

12 In 1994, the statute was amended to provide that three, not two, years of nonuse were needed to make out a prima facie case of abandonment.

Here, the District Court found that there was no abandonment as a matter of law because "the original Drifters recordings have been played on the radio and sold in record stores, without interruption, for the past 40 years." *Marshak, 58 F. Supp. 2d at 575.* The District Court adopted the reasoning of *The Kingsmen v. K-Tel Int'l, Ltd., 557 F. Supp. 178, 183 (S.D.N.Y. 1983),* in which the court held that a mark designating a disbanded singing group remained in use because the group's recordings were played and

the group continued to collect [**38] royalties. The court wrote:

> We find that defendants have failed to show either nonuse or intent to abandon. Even though plaintiffs disbanded their group in 1967 and ceased recording new material, there is no evidence suggesting that they failed to use the name Kingsmen during the period from 1967 to the present to promote their previously recorded albums. Moreover, the fact that these individuals continue to receive royalties for Kingsmen recordings flies in the face of any suggestion of intent to abandon use of the name Kingsmen. These plaintiffs have no more abandoned their right to protect the name of Kingsmen than have The Beatles, The Supremes or any other group that has disbanded and ceased performing and recording, but continues to collect royalties from the sale of previously recorded material. We must reject defendants' contentions that the name Kingsmen has been abandoned to the public domain.

Id.

We concur with this reasoning, and we also agree with the District Court that it mandates the entry of judgment as a matter of law against Marshak. As the District Court put it, "[a] successful musical group does not abandon its mark unless there is

proof [**39] that the owner ceased to commercially exploit the mark's secondary meaning in the music industry." *Marshak, 58 F. Supp. 2d at 575*; *see also Robi v. Reed, 173 F.3d 736 (9th Cir. 1999)*; *HEC Enters., Ltd. v. Deep Purple, Inc., 1980 U.S. Dist. LEXIS 17054, 213 U.S.P.Q. 991 (C.D. Cal. 1980)*.

Marshak bore the burden of proving non-use and actual intent to abandon. *United States Jaycees v. Philadelphia Jaycees, 639 F.2d at 139*. Treadwell's Drifters were entitled to judgment as a matter of law on the issue of abandonment because, even giving Marshak the benefit of all reasonable inferences, *Barna v. City of Perth Amboy, 42 F.3d 809, 813 n.5 (3d Cir. 1994)*, the evidence was insufficient to establish those elements. *Motter v. Everest & Jennings, Inc., 883 F.2d 1223, 1228-29 (3d Cir. 1989)*.

Marshak did not prove non-use, i.e., that the classic recordings of "The Drifters" were not played and that the resulting royalties were not paid. On the contrary, the parties stipulated that "The Drifters" records and albums continue to be played and sold in the United States and that many of their songs [**40] have now been recorded on compact disk and re-released. App. at 110. In addition, Treadwell testified that The Drifters, Inc. and Treadwell Drifters, Inc. have continuously received royalties from Atlantic Records for the sale of Drifters records in the *United States. App. at 720*. Likewise, Marshak failed to prove an actual intent to abandon. The continuous use of the mark in connection with the commercial exploitation of the group's recordings in this country gave rise to a strong inference of an intent not to abandon the mark.

In arguing that judgment as a matter of law was improper, Marshak relies on the following evidence. First, Treadwell dropped her 1971 action against Marshak in New York state court after the court denied her application for a preliminary injunction and issued an unfavorable opinion. Second, Treadwell did not oppose the federal registration of Marshak's mark or [*200] previously seek to have it canceled. Third, Treadwell failed to challenge numerous violations of "The Drifters" name, whereas Marshak stopped those uses through legal action. Fourth, Treadwell left for England in 1972. Fifth, Treadwell's English recording contracts did not provide for distribution in [**41] the United States. However, once it is recognized that the commercial exploitation of classic Drifters recordings in this country constitutes use, it is apparent that the evidence that Marshak cites is insufficient to show either the non-use and or the actual intent to abandon that are necessary for a finding of abandonment.

B.

Marshak argues that the District Court erred in holding that he infringed the common-law rights held by Treadwell's Drifters. We conclude, however, that Treadwell's Drifters were entitled to judgment as a matter of law on their infringement claim.

As previously noted, Treadwell's Drifters were required to show (1) that their mark was valid and legally protectable; (2) that they owned the mark; and (3) that Marshak's use of the mark to identify his group was likely to create confusion concerning their origin. *Fisons Horticulture, Inc., 30 F.3d at 472*. In view of our holding regarding abandonment,

there can be no question regarding elements one and two, and we do not understand Marshak to contest those elements on any other ground.

With regard to the third element, Marshak argues that the District Court should not have disturbed the jury's [**42] finding that Marshak had not used "The Drifters" name in such a way as to misrepresent the source of his goods or services or to falsely suggest a connection between those services and Treadwell's Drifters. App. at 1562. We agree with the District Court, however, that a reasonable factfinder could not fail to find a likelihood of confusion on the facts of this case. As the District Court wrote, "Marshak's group performs under the name 'The Drifters' and sings the same hit songs that were recorded and made famous by the original Drifters in the fifties and sixties. There is surely a likelihood of confusion because the public is misled to believe that Marshak's singers and the famous Drifters records originate from the same source." App. at 1681-82. Although infringement is generally a question for the jury, the evidence here mandated judgment for the counterclaimant and justified the entry of the permanent injunction barring Marshak from using the Drifters mark. We have considered all of Marshak's arguments, and we find no basis for reversal of the portions of the District Court's orders that are properly before us.

V.

For these reasons, we affirm the orders of the District Court [**43] insofar as they order cancellation of Marshak's federal registration and permanently enjoin Marshak from using The Drifters name in commerce. We dismiss the appeal

insofar as it contests the order for an accounting of profits.